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Speaking with a Forked Tongue in the Global Debate on Traditional Knowledge and Genetic Resources: Is U.S. Intellectual Property Law and Policy Really Aimed at Meaningful Protection for Native American Cultures?

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ARTICLE

Speaking with a Forked Tongue in the Global Debate on Traditional Knowledge and Genetic Resources: Is U.S. Intellectual Property Law and Policy Really Aimed at Meaningful Protection for Native American Cultures?

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[†] Portions of this article originally appeared in the March 24, 2003 issue of Legal Times IP ("They Thought It First: Indigenous Peoples Push to Protect Their Traditional Knowledge, Genetic Resources, and Folklore," Page 14).

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INTRODUCTION

In recent years, effective protection for the traditional knowledge, genetic resources, and folklore (“TKGRF”) of indigenous societies has emerged as a major controversy in intellectual property law.¹ One approach is to view TKGRF as mere variants of the commonly accepted forms of intellectual property (“IP”), necessitating the same manner of protection as other qualifying material. Alternatively, some IP scholars argue that TKGRF are inherently different and require new types of legal protection. A third approach, held by a small minority working in the TKGRF area, advises that with so many indigenous societies producing infinite variations of TKGRF, one category of laws will not suffice.

To use an image originating from Native American cultures, are U.S. officials “speaking with a forked tongue” in international forums when they profess the United States’ special concern for protecting indigenous TKGRF? Do current U.S. laws, poorly implemented and often spawned for reasons unrelated to TKGRF protection, merely pay lip service to indigenous TKGRF preservation, while actually protecting corporate commercial

¹ See Daniel J. Gervais, *The Internationalization of Intellectual Property: New Challenges from the Very Old and the Very New*, 12 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 929, 955–56 (2002). One reason for the increased interest in TKGRF is that many countries are “rich with traditional knowledge, especially genetic resources and folklore,” but do not benefit from “traditional forms of intellectual property.” *Id.* at 956. Additionally, aboriginal communities have been gaining political clout in many countries. *Id.*

interests? Or are these inconsistencies between stated policy and actual implementation—even if factually indisputable—merely benign examples of the normal bureaucratic shortcomings that commonly riddle the U.S.'s cumbersome and complex democracy?

In the global debate on TKGRF, many U.S. and foreign government officials and legal scholars assert that TKGRF are regulated most appropriately within the traditional categories of well-established Western intellectual property law, i.e., the standard bodies of copyright, patent, trademark, trade secret, and unfair competition law.² Even if TKGRF do not fit any of these categories, they would benefit most from the stable and predictable protections that these existing, well-defined bodies of law provide.³

However, some legal scholars recognize that TKGRF have unique attributes not addressed by the standard IP categories.⁴ Unlike common IP materials, TKGRF have amorphous characteristics that would have to be defined to achieve effective

² But see Graham Dutfield, *TRIPs-Related Aspects of Traditional Knowledge*, 33 CASE W. RES. J. INT'L L. 233 (2001). For convenience of reference only, the author uses the terms "Western intellectual property law" or "Western legal system" to mean the national legal system of a recognized government in any country in the world, without regard to whether such country might properly be labeled "Western" or "industrialized" in another context (geographical, cultural, political, etc.). These terms are, in the context of this paper, interchangeable with "national legal systems of industrialized societies," although this expression would not, of course, withstand careful scrutiny when referring to the national legal system of a largely agrarian or nomadic society, such as Cameroon or Mongolia, since neither is particularly industrialized or Western *per se*. This rough terminology, is not intended to convey any greater or higher value to Western legal systems. Rather, "Western" is used to distinguish the national common and civil law systems in use today by majority populations and national legislatures from those systems of customary law still traditionally employed in indigenous societies to govern their own internal affairs. While some participants in the TKGRF debate have made this distinction based on whether or not a national legal system stems directly from European colonization, the author believes such an approach to be both unnecessarily pejorative and indeterminate.

³ Symposium, *The Law and Policy of Protecting Folklore, Traditional Knowledge, and Genetic Resources*, 12 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 753, 785 (2002). For a discussion regarding the usefulness but also the inherent limitations of traditional intellectual property law in protecting traditional knowledge, see generally David R. Downes, *How Intellectual Property Could Be a Tool to Protect Traditional Knowledge*, 25 COLUM. J. ENVTL. L. 253 (2000).

⁴ See Dutfield, *supra* note 2, at 240.

legal protection.⁵ These scholars' proposed solution for substantial protection of TKGRF includes: clearly delineating the nature of its unique attributes, locating the specific coverage voids that exist in traditional intellectual property law, and formulating *sui generis* laws designed to address those unique attributes and legal voids.⁶ This approach could entail creating national laws or an international treaty to protect TKGRF outside the established intellectual property regimes, similar to the *sui generis* laws adopted in many countries to protect semiconductor chips or computer programs.⁷

A third, far smaller group suggests that TKGRF material has exceedingly diverse properties and cannot be defined clearly. Since TKGRF have developed holistically, usually within many small communities dependent upon their natural environments, TKGRF are subject to nearly infinite variation.⁸ Thus, any attempt to define TKGRF *per se* and to determine a single substantive governing law will undoubtedly fail.⁹ Within this group of thinkers, some advocate that effective regulation of TKGRF lies in developing a flexible legal mechanism that integrates Western and customary law with the ideas of both Western and indigenous legal scholars.¹⁰ Appropriate management of any given use, publication,

⁵ For example, the traditional tribal communal ownership of art is not recognized by U.S. intellectual property schemes. See Amina Para Matlon, *Safeguarding Native American Sacred Art by Partnering Tribal Law and Equity: An Exploratory Case Study Applying the Bulun Bulun Equity to Navajo Sandpainting*, 27 COLUM.-VLA J.L. & ARTS 211, 213–14 (2004).

⁶ See generally *Elements of a Sui Generis System for the Protection of Traditional Knowledge*, WIPO, Intergovernmental Comm. on Intell. Prop. & Genetic Resources, Trad. Knowledge & Folklore, WIPO/GRTKF/IC/4/8 (Sept. 30, 2002) [hereinafter *Elements*], http://www.wipo.int/documents/en/meetings/2002/igc/pdf/grtkf_ic_4_8.pdf (last visited Nov. 5, 2004).

⁷ Gervais, *supra* note 1, at 951–52.

⁸ See *Elements*, *supra* note 6, at 12–13.

⁹ *Id.* at 11–13.

¹⁰ This approach has been most clearly and convincingly articulated in a variety of forums by Mr. Antony Taubman, currently Acting Director and Head of the Traditional Knowledge Division, Genetic Resources and Folklore at the World Intellectual Property Organization in Geneva, Switzerland. I am very grateful to Mr. Taubman for all of his invaluable insights into this area of law, as well as for his unerring kindness to me and patience with my attempts over the last two years to understand this complex and fascinating area of law. See also Michael F. Brown, WHO OWNS NATIVE CULTURE 242–45 (Harvard Univ. Press 2002).

or dispute involving TKGRF could be determined in a forum consisting of both indigenous elders familiar with applicable customary law and experts in Western intellectual property concepts. This would facilitate allowing for consideration of the diverse combination of human and environmental factors inevitably operating in any given TKGRF scenario.

Within each of these three schools of thought, there are proponents of formal recognition of TKGRF as distinct and valuable forms of intellectual property needing regulation by international treaty in the near future.¹¹ However, other members from each of these groups believe that TKGRF protection should instead evolve mainly out of national legislation, as other forms of intellectual property have historically developed.¹²

The global legal debate surrounding indigenous TKGRF has, to date, been eclipsed in the United States by other intellectual property topics of greater commercial concern. While legal questions relating to the patenting of genes and genetic sequences have received much attention in the U.S. legal community in recent years,¹³ other aspects of intellectual property law relating to genetic material have been less prominent.¹⁴ The U.S. legal community has ignored questions involving the ownership, control, and access to genetic material husbanded by indigenous people; the traditional knowledge often associated with such

¹¹ See *Traditional Knowledge, Traditional Cultural Expressions and Genetic Resources: The International Dimension*, at 14–15, WIPO, Intergovernmental Comm. on Intell. Prop. & Genetic Resources, Trad. Knowledge & Folklore, WIPO/GRTKF/IC/6/6 (Nov. 30, 2003) [hereinafter *International Dimension*], http://www.wipo.int/documents/en/meetings/2004/igc/pdf/grtkf_ic_6_6.pdf (last visited Nov. 5, 2004).

¹² Such national legislation would be subject to each country's distinctive jurisprudence, societal norms, and needs. Brown, *supra* note 10, at 55 (chronicling the history of copyright law in Great Britain and the United States).

¹³ Ironically, in developing countries, where most indigenous TKGRF originate, the larger question of whether to allow patenting of genetic resources is far from settled. See, e.g., *Freedom from IPR: Towards a Convergence of Movements*, SEEDLING, Oct. 2004, <http://www.grain.org/seedling/?id=301> (last visited Nov. 5, 2004).

¹⁴ See, e.g., Donna M. Gitter, *International Conflicts over Patenting Human DNA Sequences in the United States and the European Union: An Argument for Compulsory Licensing and a Fair-Use Exemption*, 76 N.Y.U. L. REV. 1623 (2001).

genetic material; and the traditional cultural expressions which are often vehicles for collecting and relaying such knowledge.¹⁵

United States officials claim that the U.S. strongly supports legal protection of TKGRF and cite several tools of federal law that ostensibly give special protection to Native American creative material.¹⁶ On an international level, the U.S. advocates implementing protective legislation for TKGRF on a nation-by-nation basis only, strictly within the traditional limits of existing intellectual property law and eschewing establishment of any binding international guidelines or *sui generis* laws.¹⁷ Yet the domestic legal tools that U.S. officials regularly cite abroad as evidence of undivided support for domestic TKGRF protection have not been implemented in meaningful ways, and some actions taken by domestic agencies in TKGRF regulation seem inconsistent with stated policy values.¹⁸

Against a background of fragmented international discussion, this Article examines the official U.S. policy position on TKGRF, as reflected in selected intellectual property laws. This Article also addresses whether present U.S. law and policy offer tangible, meaningful protection for the TKGRF of Native Americans and other indigenous groups in the United States, or whether such protection exists in theory only.

To facilitate understanding of this law and policy discussion, Part I of this Article presents an overview of TKGRF, starting with the many difficulties of defining, conceptualizing, and working with TKGRF as distinct intellectual property forms. It then

¹⁵ In 1999, WIPO's Working Group on Biotechnology began gathering information on intellectual property and biotechnology from 57 countries. Their data illustrates the varied responses to protection. See *Information Provided by WIPO Member States Concerning Practices Related to the Protection of Biological Inventions*, WIPO, Intergovernmental Comm. on Intell. Prop. & Genetic Resources, Trad. Knowledge & Folklore, WIPO/IP/GR/00/2 (Apr. 6, 2001), http://www.wipo.int/documents/en/meetings-/2001/igc/pdf/grtkfic1_6.pdf (last visited Nov. 5, 2004).

¹⁶ See U.S. Dep't of State, U.S. Intervention on Article XX, Intellectual Property Rights of the Organization of American States ("OAS"), "Draft American Declaration on the Rights of Indigenous Peoples" [hereinafter U.S. OAS Statement], at <http://www.state.gov/p/wha/rt/oas/20827pf.htm> (Feb. 25, 2003).

¹⁷ Dutfield, *supra* note 2, at 273.

¹⁸ See *infra* Part II.B (discussing U.S. policy).

examines why effective legal protection for TKGRF within presently available regimes of intellectual property law may be problematic. As an illustration, the article considers the wide variety of TKGRF controversies that have arisen in recent years and summarizes the various solutions being tested by international courts and legislatures. Part II gives a brief overview of the genesis and development of the ongoing TKGRF debates at the World Intellectual Property Organization (“WIPO”), introduces the divergent opinions among delegates to those talks, and summarizes the U.S. policy articulated in that forum.

Part III examines some of the U.S. legal tools most commonly cited by U.S. officials as examples of U.S. protection for indigenous TKGRF. These include the Indian Arts and Crafts Act of 1990,¹⁹ the indigenous handicraft certification scheme embodied in the Alaska Silver Hand Program,²⁰ and the Federal Trade Commission Act.²¹ Another frequently cited tool is the Database of Native American Tribal Insignia maintained by the United States Patent and Trademark Office (“USPTO”).²² With respect to each of these, the Article considers the motivation for creation, whether the law functions as was originally intended, and whether it gives meaningful protection to indigenous TKGRF.

Part IV suggests several ways in which U.S. domestic intellectual property laws could be amended or expanded to provide further TKGRF protection, while still remaining within established regimes of Western intellectual property law. Proposed changes include expanding the use of certification and collective marks to incorporate indigenous creations, expanding federal and state moral rights laws, and establishing a prospective U.S. system of geographical indications law for TKGRF. This

¹⁹ Pub. L. No. 101-644, 104 Stat. 4662 (1990) (codified as amended in scattered sections of 18 U.S.C., 20 U.S.C., 25 U.S.C., 42 U.S.C.). For an interesting—albeit somewhat outdated—discussion of potential shortcomings of the Act, see generally Jon Keith Parsley, *Regulation of Counterfeit Indian Arts and Crafts: An Analysis of the Indian Arts and Crafts Act of 1990*, 18 AM. INDIAN L. REV. 487 (1993).

²⁰ ALASKA STAT. § 45.65.010-070 (Michie 2000).

²¹ 15 U.S.C. § 45(a) (1994).

²² To access the database, see USPTO, *Frequently Asked Questions about the Database of Native American Tribal Insignia*, at <http://www.uspto.gov/web/offices/tac-tribalfaq.htm> (last modified Nov. 16, 2003) [hereinafter USPTO, *FAQ*].

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Article advocates prompt ratification of the Convention on Biological Diversity, repair of existing, defective, federal legislation, and widespread education campaigns, in an effort to create national awareness of all IP laws, including TKGRF. The Article also suggests immediate judicial recognition of a clear link between patent enforceability and source disclosure in patent applications for TKGRF-related inventions. Moreover, state and federal laws should be passed to ensure minimum contracting safeguards in TKGRF ventures including, prior informed consent of indigenous participants, access to properly qualified legal counsel, and appropriate benefit-sharing among all parties. This Article proposes removal of USPTO officials as the main *de facto* spokespeople and policymakers for the U.S., and replacing them with either an autonomous group of intellectual property counsel or an autonomous body of such counsel and officials within the Solicitor General's office.

Finally, Part V questions whether the TKGRF debate is really just a minor, sub-issue in the evolution of intellectual property law or whether it may have greater repercussions on the field than is presently realized in the U.S. The Article argues the latter, suggesting some areas in which those repercussions may soon be felt, and urges a more genuine participation by the United States in the search for understanding and protecting TKGRF. Greater U.S. openness to new ideas and to concepts originating in other legal systems, including customary law, will offer a more realistic chance of solving the TKGRF dilemma in the near future. This Article hypothesizes that such a shift in approach to TKGRF might also provide the U.S. with new models to solve other legal interface and IP problems, including in cyberspace.

I. AN OVERVIEW: WHAT IS TKGRF, HOW DOES IT DIFFER FROM OTHER INTELLECTUAL PROPERTY, AND WHAT ARE SOME OF THE TKGRF-RELATED LEGAL CONTROVERSIES AND PROPOSED SOLUTIONS THAT HAVE ARISEN IN RECENT YEARS?

A. *Defining and Differentiating TKGRF*

The lack of agreed legal definitions for “traditional knowledge,” “folklore,” or “genetic resources”²³ has presented problems for many international groups and non-governmental organizations (“NGOs”) examining the TKGRF protection issue in recent years.²⁴ Some groups believe definitional clarity is a precondition to substantive discussion and have spent a great deal of time examining the limits of terminology. Others have bypassed the definitional issue altogether, only to find that formulating solutions is impossible when the objects of protection remain indeterminate. WIPO takes a more pragmatic approach: it continuously develops and refines definitions of TKGRF, while simultaneously exploring potential protection mechanisms.²⁵

²³ See generally *Intellectual Property and Genetic Resources, Traditional Knowledge, and Folklore*, at http://www.wipo.int/about-ip/en/studies/publications/genetic_resources.htm (last visited Nov. 5, 2004). “While ‘genetic resources’ are defined under several international instruments, there is to date no universally recognized definition for traditional knowledge as such.” *Id.*

²⁴ See *Comparative Summary of Sui Generis Legislation for the Protection of Traditional Cultural Expressions*, WIPO, Intergovernmental Comm. on Intell. Prop. & Genetic Resources, WIPO/GRTKF/IC/5/INF/3 (Apr. 28, 2003) [hereinafter *Comparative Summary*], http://www.wipo.int/documents/en/meetings/2003/igc/pdf/grtkf_ic_5_inf_3.pdf (last visited Nov. 12, 2004).

²⁵ *Matters Concerning Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore*, at 5–6, WIPO General Assembly, WO/GA/26/6 (Aug. 25, 2000) [hereinafter *Matters Concerning IP*], http://www.wipo.int/documents/en/document/govbody/wo_gb_ga/pdf/ga26_6.pdf (last visited Nov. 5, 2004); *Preliminary Systematic Analysis of National Experiences with the Legal Protection of Expressions of Folklore*, at 6–8, WIPO, Intergovernmental Comm. on Intell. Prop. & Genetic Resources, Trad. Knowledge & Folklore, WIPO/GRTKF/IC/4/3 (Oct. 20, 2002) [hereinafter *Systematic Analysis*], http://www.wipo.int/documents/en/meetings/2002/igc/pdf/grtkf_ic_4_3.pdf (last visited Nov. 5, 2004). For a discussion of terminology issues, see *Traditional Knowledge—Operational Terms and Definitions*, WIPO, Intergovernmental Comm. on Intell. Prop. & Genetic Resources, Trad. Knowledge & Folklore, WIPO/GRTKF/IC/3/9 (May 20, 2002) [hereinafter *Operational Terms*], http://www.wipo.int/documents/en/meetings/2002/igc/pdf/grtkf3_9.pdf (last visited Nov. 5, 2004).

Proposed definitions and potential protections are works in progress, continually adjusted as understanding of the relevant concepts grow.²⁶

For the purposes of this Article, “genetic resources” refers to plant, animal, and human genetic material owned, cultivated, or otherwise arising out of the custodianship of individuals or collective groups within an indigenous society. Though genetic material may be the most easily definable category of TKGRF, it recently has engendered numerous ownership and use controversies.²⁷ For example, several disputes have arisen surrounding patent applications filed by the U.S. National Institutes of Health for T-cell lines used to combat leukemia and hepatitis.²⁸ Some of these cell lines were originally developed from blood samples taken from Papua New Guineans, Solomon Islanders, and Pandilla tribespeople.²⁹ Many of the original donors have alleged that their prior informed consent was not obtained before the U.S. government used and patented—for its exclusive benefit—derivatives from their genetic material.³⁰ Similarly, agricultural germplasm banks, many of which were established to support food crop experimentation by indigenous farmers,³¹ have generated controversy.³² Agribusinesses have become embroiled in a variety of patent infringement and licensing disputes involving indigenous farmers’ seed storage and reuse, as well as contractual disputes concerning required farmer repurchase of genetically modified seed.³³ At the heart of many agriculture-related conflicts

²⁶ *Systematic Analysis*, *supra* note 25, at 8.

²⁷ DARRELL A. POSEY & GRAHAM DUTFIELD, BEYOND INTELLECTUAL PROPERTY: TOWARD TRADITIONAL RESOURCE RIGHTS FOR INDIGENOUS PEOPLES AND LOCAL COMMUNITIES 26–27 (International Development Research Centre, 1996).

²⁸ *Id.* These cases are discussed further in this paper. *See infra* Part I.B.2.b.

²⁹ *Id.*

³⁰ *See, e.g., id.*

³¹ *Id.* at 22.

³² *Id.* at 36–37.

³³ *See generally* ETC group—action group on Erosion, Tech. & Concentration, at <http://www.etcgroup.org> (last visited Nov. 5, 2004) (The ETC group was formerly known as the Rural Advancement Foundation International [RAFI]); Food and Agriculture Org. (FAO) Comm’n on Genetic Res. for Food & Agric., *International Undertaking on Plant Genetic Resources for Food and Agriculture*, at <http://www.fao.org/ag/cgrfa/IU.htm> (last visited Nov. 5, 2004); Inst. for Agric. & Trade Policy, at <http://www.iatp.org> (last visited Nov. 5, 2004).

lies the fact that often the newly patented plant material involved was developed directly from landraces husbanded by indigenous farmers for hundreds, and sometimes thousands, of years.³⁴

The definition of “traditional knowledge” is somewhat more problematic than “genetic resources,” and controversies surrounding its appropriate use are even more numerous.³⁵ In this Article, “traditional knowledge” means those systems of tradition-based knowledge developed over time by indigenous peoples or local communities in any sphere of scientific or artistic application, regardless of whether such knowledge is collected and conveyed through written, oral, or other form.³⁶ This could apply to indigenous peoples’ inventions, discoveries (such as plant usage, for example), designs, symbols, and secret or sacred knowledge, but it is not by any means limited only to these areas.³⁷ Often, traditional knowledge has scientific or practical application, such as knowledge about the healing properties of medicinal plants or the growth and reproductive habit of food plants.³⁸ It extends, for example, to such matters as the particular suitability of certain types of animal pelts for human clothing, such as the waterproof properties of seal intestine for rain gear or the frost-resistant properties of wolverine fur for lining the facial openings of winter parkas.³⁹

There is no commonly accepted definition of “traditional knowledge,” in part because it covers such a diverse body of

³⁴ POSEY & DUTFIELD, *supra* note 27, at 15, 17.

³⁵ See *infra* Part II.B.2.

³⁶ This is the author’s own current working definition, but many other definitions have been proposed by international organizations, research institutions, indigenous groups, and NGOs. See generally, George Hobson, *Traditional Knowledge is Science*, 20 NORTHERN PERSP. (Summer 1992), <http://www.carc.org/pubs/v20no1/science.htm> (last visited Nov. 5, 2004).

³⁷ See also *Operational Terms*, *supra* note 25, at 11; see generally Hobson, *supra* note 36.

³⁸ See Hobson, *supra* note 36.

³⁹ For information on the waterproof qualities of seal intestines, see Nat’l Museum of Natural History, *Looking Both Ways: Heritage and Identity of the Alutiiq People of Southern Alaska*, at <http://www.mnh.si.edu/lookingbothways/text/living.html> (last visited Nov. 5, 2004). For information on the frost-resistant wolverine fur, see Alaska Dep’t of Fish & Game, *Wolverine: Wildlife Notebook Series*, at <http://www.adfg.state.ak.us/pubs/notebook/furbear/wolverin.php> (last visited Nov. 5, 2004).

information and in part because traditional knowledge tends to be holistic by nature.⁴⁰ It is often intimately tied not just to the material object of the knowledge itself, but also to the larger environmental context of the knowledge.⁴¹ Traditional knowledge also is often deeply interwoven with spiritual or sacred concepts, and it is regularly expressed and preserved via ritualistic or artistic traditions that, unlike Western artistic habit, may be executed and passed down through generations only within firmly fixed parameters of expression.⁴²

It is this holistic quality of traditional knowledge that defies its neat categorization into any distinct body of Western intellectual property law and invites reconsideration of some of the basic Western definitions of intellectual property.⁴³ In TKGRF, many of the legal concepts involved are novel and not yet well-understood in any sophisticated way by anyone other than the members of the relevant indigenous societies.⁴⁴ Such concepts may not be easily reduced to a few clear and succinct legal principles.⁴⁵ Thus it is not surprising that many of the qualities embodied in traditional knowledge cannot be effectively protected within the present reach of established intellectual property law in the industrialized Western world.⁴⁶

Some of the more subtle and original legal thinking concerning the nature of traditional knowledge is surfacing at WIPO.⁴⁷ In a seminar last year, one leading scholar asked his audience members

⁴⁰ Dutfield, *supra* note 2, at 240–41.

⁴¹ *Id.*

⁴² To obtain a sense of these general precepts within the specific context of Australian aboriginal visual art, see Christine Haight Farley, *Protecting Folklore of Indigenous Peoples: Is Intellectual Property the Answer?*, 30 CONN. L. REV. 1, 10 (Fall 1997).

⁴³ *See id.* at 2.

⁴⁴ *Id.* at 10.

⁴⁵ *Id.* at 10–11.

⁴⁶ *Id.* at 2, 30–31, 41; *see also id.* at 7, for a discussion of *Milpururru v. Indofurn Pty. Ltd.*, (1994) 54 F.C.R. 240, 244 (Austl.). This case discusses how Western copyright protection would fall short of protecting sacred Australian Aboriginal images used without permission on carpets.

⁴⁷ WIPO is a United Nations specialized agency and administers twenty-three international treaties relating to intellectual property protection. As of Sept. 2004, some 181 nations were member states. For extensive information on WIPO's general mission, *see General Information*, at <http://www.wipo.int/about-wipo/en/gib.htm> (last visited Nov. 5, 2004).

to consider the inherent nature of traditional knowledge by asking themselves a series of questions:⁴⁸ What characteristics, if any, make traditional knowledge different from other known forms of intellectual property?⁴⁹ Might the legal means to protect it be *sui generis*?⁵⁰ Or is this type of knowledge itself *sui generis*?⁵¹ If so, what makes it that way—its epistemological nature, or something else?⁵² Is it “intellectual?”⁵³ What makes it “knowledge?”⁵⁴ Is it actually a completely different knowledge system—cosmological, for example?⁵⁵

If defining traditional knowledge is difficult, establishing the legal parameters of “folklore” or “traditional cultural expression” is at least equally challenging.⁵⁶ Just as with traditional knowledge, the parameters of folkloric terminology are frequently under discussion in a wide variety of international forums.⁵⁷

⁴⁸ For more information on WIPO’s work in TKGRF specifically, see Antony Taubman, Seminar sponsored by the American Association for the Advancement of Science (“AAAS”) to consider a draft version of the AAAS’s proposed handbook on protecting intellectual property of traditional ecological knowledge holders, Geneva, Switz. (Dec. 14, 2002) [hereinafter TAUBMAN PRESENTATION] (notes of discussion on file with author). The AAAS is an international federation of scientific and engineering societies and is headquartered in Washington, D.C. It holds accredited non-governmental organization status at the WIPO IGC. See generally AAAS, at <http://www.aaas.org> (last visited Nov. 5, 2004); *The AAAS Project on Traditional Ecological Knowledge*, at <http://shr.aaas.org/tek/handbook> (last visited Nov. 5, 2004).

⁴⁹ *Id.* All of the questions in this paragraph were presented by Mr. Taubman to seminar attendees.

⁵⁰ *Id.*

⁵¹ *Id.*

⁵² *Id.*

⁵³ *Id.*

⁵⁴ *Id.*

⁵⁵ *Id.*

⁵⁶ While this paper uses the term “folklore” for convenience, “traditional cultural expression” seems to be the increasingly preferred terminology. See *Traditional Cultural Expressions/Expressions of Folklore Legal and Policy Options*, at 6–7, WIPO, Intergovernmental Comm. on Intell. Prop. & Genetic Resources, Trad. Knowledge & Folklore, WIPO/GRTKF/IC/6/3 (Dec. 1, 2003), http://www.wipo.int/documents/en/meetings/2004/igc/pdf/grtkf_ic_6_3.pdf (last visited Nov. 5, 2004).

⁵⁷ See, e.g., United Nations Educ., Cult., & Soc. Org. (“UNESCO”), Convention for the Safeguarding of the Intangible Cultural Heritage, at 2, http://portal.unesco.org/culture/en/ev.php-URL_ID=15782&URL_DO=DO_TOPIC&URL_SECTION=201.html (last visited Nov. 5, 2004) (wherein UNESCO unanimously adopted a related legal definition for “tangible cultural heritage”).

WIPO has not settled on a definition yet, but WIPO experts explain that any definition of traditional cultural expression would have to cover all works characteristic of an indigenous society or local community that reflect its own social and cultural experiences, using the vehicle of its own particular artistic expectations and habits.⁵⁸ This would include, but would not be limited to, works of art, handicraft, and design; written and oral verbal works, including songs, poetry, stories, and riddles; music; and works expressed through action, such as dances, rituals, and plays. Increasingly, as WIPO notes, traditional cultural expressions are viewed as a subset of the larger concept of traditional knowledge, and these folkloric expressions often consist of both tangible and intangible components.⁵⁹

For example, a largely unpublicized but typical case of cultural encroachment worldwide involves the Tuareg nomads of Saharan Africa, whose traditional range spans several countries and who possess rich folkloric traditions that are currently under siege.⁶⁰ Distinctive Tuareg tribal jewelry has been repeatedly copied, allegedly without authorization, for sale to tourists in North and West Africa by Japanese and Senegalese entrepreneurs.⁶¹ Tuareg traditional music has similarly been recorded and produced in CDs widely sold in Europe and the United States.⁶² Since national patent and copyright systems are often not developed enough to provide any protection for the Tuareg, and because the U.N. Declaration of Human Rights gives only the broadest of IP protection guarantees, they, like other citizens of third-world

⁵⁸ See *Systematic Analysis*, *supra* note 25, at 6–7.

⁵⁹ *Id.* at 8.

⁶⁰ See, e.g., Press Release, Mary Robinson, High Commissioner for Human Rights, United Nations (May 13, 2002), <http://www.un.org/news/briefings/docs/2002-IPFbrf.doc.htm> (last visited Nov. 5, 2004).

⁶¹ Interview with Saoudata Aboubacrine, representative of Tin-Hinan, a nongovernmental organization from Burkina Faso, at the 4th Session of the WIPO Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (“IGC”), in Geneva, Switz. (Dec. 12, 2002) [hereinafter Aboubacrine Interview] (on file with author). For an example of Japanese sale of Tuareg jewelry, see *Indigenous People Collection*, <http://www.morita.ne.jp/hikkigu/delta/tuareg.htm> (last visited Nov. 5, 2004).

⁶² See, e.g., HOGGAR, VOCAL AND INSTRUMENTAL MUSIC OF THE TAUREG (Le Chant Du Monde 1994).

countries, now feel that WIPO is the only realistic forum in which they can petition for help.⁶³

How to define TKGRF and identify its unique attributes, then, are two threshold questions facing legal scholars in this field. Western lawmakers and legal scholars should widely discuss these issues with as many indigenous community representatives as possible, so that nonindigenous thinkers can begin to understand more about the true nature of TKGRF. Constructing a flexible legal interface between established intellectual property law and customary law might then become possible—a tool that is vitally important if this creative material is not to be either permanently lost or so far removed from its original context that it loses its meaning and usefulness.

B. Summary of the Legal Issues and Disputes to Date in TKGRF

Like the definitional difficulties, the legal and social issues relating to TKGRF are extremely complex and diverse.⁶⁴ Disputes are rapidly arising in a variety of venues.⁶⁵ As a result, national legislatures, private businesses, trade associations, international organizations, and, increasingly, indigenous groups themselves, are all experimenting with a variety of potential solutions.⁶⁶

1. Complexity of TKGRF Legal Issues

A statement given on behalf of the Saami⁶⁷ Council at a recent WIPO conference illustrates the complexity of legal issues common to TKGRF discussions.⁶⁸ The speaker, from the border

⁶³ See Aboubacrine Interview, *supra* note 61.

⁶⁴ See, e.g., AJEET MATHUR, *MISSING MARKET IN WORLD TRADE: THE CASE FOR 'SUI GENERIS' PROTECTION OF TRADITIONAL KNOWLEDGE* (Indian Council for Research on Int'l Econ. Relations, Working Paper No. 141, Aug. 2004), <http://www.icrier.res.in/wp141.pdf> (last visited Nov. 5, 2004).

⁶⁵ *Id.*

⁶⁶ *Id.*

⁶⁷ See Frank Horn, *National Minorities of Finland*, Virtual Finland, at <http://virtual.finland.fi/finfo/english/minorit3.html> (2004) (“The Sámi are an indigenous people living in Finland, Sweden, Norway and Russia. Known widely in the past as Lapps, the term ‘Lapp’ is now considered derogatory by many Sámi.”).

⁶⁸ See *Report*, at 19, WIPO, Intergovernmental Comm. on Intell. Prop. & Genetic Resources, Trad. Knowledge & Folklore, WIPO/GRTKF/IC/4/15 (Dec. 17, 2002)

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area of Finland and Norway, addressed various troubling aspects of the exploitation of traditional Saami culture by other, non-Saami Scandinavians.⁶⁹ One example of this exploitation occurs when outsiders inaccurately copy and wear the distinctive Saami national dress, usually for commercial reasons.⁷⁰ When authentically designed and appropriately worn, this clothing is used within Saami culture to convey extensive and specific nonverbal information about the wearer's family of origin, clan, geographic location, marital status, and other identity factors.⁷¹ When inappropriately worn and inauthentically designed by outsiders, it is robbed of the communication characteristics integral to its design and use in the indigenous society in which it originates.⁷² Many members of Saami society find this offensive, but are unsure how to remedy the situation.⁷³

Similarly, Saamis view emulation of their customs and religious rites by non-Saami travel agencies as demeaning and disrespectful of their culture.⁷⁴ They are concerned not only about unauthorized and handicraft counterfeiting and the loss of tourist income to genuine Saamis, but about the impact of these cultural abuses on young Saamis.⁷⁵ The Saamis are typical of growing indigenous populations searching for self-determination and for protection of their traditional cultures (part of which constitutes

(statement of Piia Nuorgam, representative of the Saami Council), http://www.wipo.int/documents/en/meetings/2002/igc/doc/grtkf_ic_4_15.doc (last visited Nov. 5, 2004).

⁶⁹ *Id.* at 31–32.

⁷⁰ *Id.* at 31. This national costume, traditionally designed in royal blue material with extensive and intricate red trim, is well-known around the world and clearly inherently distinctive. See Bata Shoe Museum, *Lapland/Saami*, at <http://www.batashoemuseum.ca/shoesections/lapland.html> (last visited Nov. 5, 2004).

⁷¹ See Report, *supra* note 68, at 31.

⁷² See *Consolidated Analysis of the Legal Protection of Traditional Cultural Expressions*, at 22, WIPO, Intergovernmental Comm. on Intell. Prop. & Genetic Resources, Traditional Knowledge & Folklore, WIPO/GRTKF/IC/5/3 (May 2, 2003), http://www.wipo.int/documents/en/meetings/2003/igc/doc/grtkf_ic_5_3.doc (last visited Nov. 5, 2004).

⁷³ *Id.*

⁷⁴ *Id.*

⁷⁵ See Kati Eriksen, Address at the Meeting on Youth Policy in the Arctic (Sept. 14, 2001), <http://www.arctic-council.org/files/sahkavuorru-140901/sahkavuorru-140901.pdf> (last visited Nov. 5, 2004).

intellectual property) from widespread adaptation and unauthorized use.⁷⁶

Many isolated ethnic communities have developed unique and complex visual art, music, and storytelling cultures that have been recently “discovered” by the outside world.⁷⁷ Allegedly, indigenous cultural creations, like so many other artistic and musical works, are regularly being illegally copied and resold by commercial entities, often via new technologies such as digital sampling.⁷⁸ Researchers commonly misuse (perhaps unwittingly) and improperly disseminate material gleaned from indigenous cultural traditions.⁷⁹ Labor-intensive local textiles, jewelry, and cultural artifacts are commonly copied and passed off as the work of indigenous craftspeople by entrepreneurs with access to capital and labor-saving machinery, and the duplicates are usually mass-produced and of poor quality.⁸⁰ When cheap knockoffs flood local and export markets, the original artisans may cease working altogether.⁸¹ Traditional skills, methods, and designs, as well as the cultures they reflect, are thus permanently lost.⁸²

A more widely publicized example of the same problem involves pharmaceutical and agribusinesses’ “bioprospecting” among indigenous societies for unfamiliar genetic material and associated traditional knowledge. This practice, now commonplace, has alarmingly and destructively invaded the world of traditional medical knowledge and indigenous local plants.⁸³

⁷⁶ See Tebtebba, *The Kimberly Declaration—International Indigenous Peoples Summit on Sustainable Development*, http://www.tebtebba.org/tebtebba_files/wssd/ipsummitdec.html (Aug. 28, 2002).

⁷⁷ See *Systematic Analysis*, *supra* note 25, at 10; see also Mrs. P.V. Valsala G. Kutty, *National Experiences with the Protection of Expressions of Folklore/Traditional Cultural Expressions: India, Indonesia and the Philippines* 1 (Nov. 25, 2002), at <http://www.wipo.int/tk/en/studies/cultural/expressions/study/kutty.pdf> (last visited Nov. 8, 2004).

⁷⁸ See *Systematic Analysis*, *supra* note 25, at 10; Kutty, *supra* note 77, at 2.

⁷⁹ See *Systematic Analysis*, *supra* note 25, at 34–37.

⁸⁰ *Id.* at 11.

⁸¹ *Id.*

⁸² *Id.*

⁸³ See generally POSEY & DUTFIELD, *supra* note 27; MARK J. PLOTKIN, *TALES OF A SHAMAN’S APPRENTICE* (Penguin Books 1994); BIODIVERSITY AND TRADITIONAL KNOWLEDGE: EQUITABLE PARTNERSHIPS IN PRACTICE (Sarah A. Laird ed., 2002) [hereinafter BIODIVERSITY AND TRADITIONAL KNOWLEDGE].

Bioprospecting activity, legitimate and otherwise, is now a routine and widely accepted industrial practice and is pursued aggressively by private, and occasionally public, actors all over the world.⁸⁴ Illegal acquisition activity is also increasing, occasionally including the outright stealing of genetic material and knowledge; the term “biopiracy” was thus coined to refer to the illegitimate appropriation and commercialization of human, plant, and other genetic material without the informed consent of its owners or traditional custodians.⁸⁵

TKGRF, and the diverse legal questions they entail, are inextricably intertwined with a larger debate over whether intellectual property law contributes positively to economic development in poor countries, or whether it predominantly protects the interests of developed countries.⁸⁶ Contentious debate about TKGRF is underway, not only at WIPO, but in a variety of international forums, including the World Trade Organization (“WTO”), the Food and Agriculture Organization (“FAO”), the UN Working Group on Indigenous Peoples (“UN Working Group”), United Nations Educational, Cultural, and Social Organization (“UNESCO”), the Organization of American States (“OAS”), and the Convention on Biological Diversity (“CBD”).⁸⁷

Among legal scholars and economists, the long-held assumption that strong intellectual property laws inherently facilitate the transfer of technology and wealth from industrialized

⁸⁴ See BIODIVERSITY AND TRADITIONAL KNOWLEDGE, *supra* note 83, at 285; *see also* Telephone Interview with Eric Wilson, Deputy Director for the Office of American Indian Tribes, U.S. Department of the Interior (Dec. 2, 2002) [hereinafter Wilson Interview 2002] (on file with author) (“Company researchers are out every day, searching the Internet, combing libraries for information, and dispersing themselves among indigenous communities to inquire about material that might lead [to profitable patents].”).

⁸⁵ See BIODIVERSITY AND TRADITIONAL KNOWLEDGE, *supra* note 83, at 7–8.

⁸⁶ See generally Comm’n on Intell. Prop. Rights, *Integrating Intellectual Property Rights and Development Policy* (Sept. 2002) [hereinafter *Integrating IP Rights*], http://www.iprcommission.org/graphic/documents/final_report.htm (last visited Nov. 9, 2004); *Patently Problematic*, THE ECONOMIST, Sept. 14, 2002, at 75 [hereinafter *Patently Problematic*]; W. Lesser, *The Effects of TRIPS-Mandated Intellectual Property Rights on Economic Activities in Developing Countries* (Apr. 17, 2001), http://www.wipo.int/about-ip/en/studies/pdf/ssa_lesser_trips.pdf (last visited Nov. 9, 2004).

⁸⁷ See generally UNCTAD, *Seminar on Traditional Knowledge*, at http://r0.unctad.org/trade_env/test1/meetings/delhi.htm (last visited Nov. 9, 2004).

countries to less developed countries may be falling into disfavor.⁸⁸ In fact, the limited empirical evidence available suggests that strong intellectual property laws can actually inhibit such transfers and reinforce existing income and development disparities.⁸⁹ While few scholars in the developing world would question the need for a predictable intellectual property law system conforming to well-established international norms, they legitimately doubt the ability of a developing economy lacking its own technological base to develop efficiently while in direct competition with foreign technology owners who hold monopoly powers under local patent and copyright laws.⁹⁰ At least in the short run, intellectual property laws tend mainly to protect the interests of current intellectual property owners, and in the developing world, these consist overwhelmingly of foreign enterprises from industrialized countries.⁹¹ This realization, of course, runs contrary to the interests of entrenched political and economic actors in industrialized countries, including the United States.⁹² In the TKGRF debate, analogous arguments can be made against the research and development transfer practices of many bioprospecting companies across pharmaceutical, agricultural, horticultural, and ethnobotanical sectors.⁹³

The TKGRF debate is also affected by the increasing polarization among member states at WIPO and the WTO on patentability and protection standards for plants, animals, and biological processes.⁹⁴ Not surprisingly, developed countries seek

⁸⁸ See *Integrating IP Rights*, *supra* note 86, at 23.

⁸⁹ *Id.* at 23–24.

⁹⁰ *Id.* at 24–25.

⁹¹ *Id.* at 21.

⁹² See Dutfield, *supra* note 2.

⁹³ See generally Padmashree Gehl Sampath & Richard G. Tarasofsky, *Study on the Inter-Relations between Intellectual Property Rights Regimes and the Conservation of Genetic Resources*, Ecologic-Institute for International and European Environmental Policy (Dec. 31, 2002), <http://www.biodiv.org/doc/meetings/abs/abswg-02/information-/abswg-02-inf-ext-en.pdf> (last visited Nov. 9, 2004).

⁹⁴ See Agreement on Trade-Related Aspects of Intellectual Property, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization [hereinafter WTO Agreement], Annex 1C, LEGAL INSTRUMENTS—RESULTS OF THE URUGUAY ROUND art. 27.3(b), 33 I.L.M. 1197 (1994) [hereinafter TRIPS Agreement] (providing that “plants, animals other than micro-organisms, and biological processes for producing these may be excluded from patentability, but Member States shall protect plant varieties, either

to strengthen intellectual property protection in these areas, while developing countries want to broaden the flexibility of applicable treaty standards.⁹⁵ Indigenous TKGRF holders have a direct interest in the progress and outcome of this debate, but they are often not represented at these discussions.⁹⁶

This altered perception of the role of intellectual property rights in economic development, together with increased awareness of TKGRF as a potentially valuable component of IP rights, is causing many less-developed nations to reconsider the Agreement on Trade-Related Aspects of Intellectual Property ("TRIPS").⁹⁷ TRIPS was negotiated as part of the Uruguay Round trade negotiations, which also produced the General Agreement on Tariffs and Trade of 1994 and established the WTO.⁹⁸ TRIPS sets up guidelines⁹⁹ and timetables¹⁰⁰ within which all members must implement national legislation establishing internationally agreed upon minimum standards for intellectual property protection.¹⁰¹ It provides an international mechanism for settling trade-related intellectual property disputes.¹⁰²

TRIPS resulted from a powerful lobbying effort led by the United States, mainly at the joint behest of corporate copyright owners (who were concerned about rampant global piracy in computer software and digitized music and films) and pharmaceutical patent holders (who were interested in maintaining patent drug exclusivity and in limiting compulsory licensing.)¹⁰³

through patents, an effective *sui generis* system, or a combination thereof"), available at http://www.wto.org/english/docs_e/legal_e/legal_e.htm. Interpretation and application of this provision is the subject of considerable debate and study within the WTO at present. For information on Article 27.3(b) and the issues it raises, see *TRIPS: Reviews, Article 27.3(b) and Related Issues*, http://www.wto.org/english/tratop_e/trips_e/art27_3b_background_e.htm (last visited Nov. 9, 2004).

⁹⁵ See Sampath & Tarasofsky, *supra* note 93, at 15.

⁹⁶ See Dutfield, *supra* note 2, at 238.

⁹⁷ See TRIPS Agreement, *supra* note 94, art. 27.3(b), 33 I.L.M. 1197; Sampath & Tarasofsky, *supra* note 93, at 16.

⁹⁸ See generally WTO Agreement, *supra* note 94.

⁹⁹ See generally TRIPS Agreement, *supra* note 94.

¹⁰⁰ *Id.* at arts. 65–67.

¹⁰¹ See generally *id.*

¹⁰² *Id.* at art. 64.

¹⁰³ Susan K. Sell, *TRIPS and the Access to Medicines Campaign*, 20 WIS. INT'L L.J. 481, 481–89 (2002). (examining TRIPS history from the context of the U.S. pharmaceutical

Apparently, the developing countries, viewing TRIPS as part of a larger trade package, found it was to their advantage to make concessions to the United States and the European Union on intellectual property issues, in exchange for their promised reduction of agricultural export subsidies, a phasing-out of textile import quotas, and extension of trade concessions on tropical products.¹⁰⁴ But many developing countries now feel that, while they have made costly concessions on intellectual property issues, some of the promised changes from the industrialized countries have not been forthcoming, especially the lowering of soaring U.S. and E.U. agricultural subsidies.¹⁰⁵ This state of affairs undoubtedly contributed to the September 2003 breakdown in negotiations at the WTO Ministers' Summit in Cancún, Mexico.¹⁰⁶

Given this contentious international climate, great significance attaches to the debate on TKGRF. Developing countries realize that intellectual property laws, however distasteful, are now an unavoidable part of the international trade landscape; instead of objecting to them, they increasingly believe they must use the system to their benefit, by seeking intellectual property protection for TKGRF.¹⁰⁷ For this to occur, TKGRF need global recognition as legitimate forms of intellectual property, and its custodians need clear and enforceable means by which to protect their ownership and development interests.¹⁰⁸

Undoubtedly the most important single event relating to widespread recognition of these interests and to formal legal protection of TKGRF was the creation and signature of the

industry interests in patented drugs and compulsory licensing, and explaining the motives behind many developing countries' acceptance of TRIPS).

¹⁰⁴ *Id.* at 520; see also *Special Report on Patents and the Poor: The Right to Good Ideas*, THE ECONOMIST, June 23, 2001, at 22.

¹⁰⁵ See Sell, *supra* note 103, at 520.

¹⁰⁶ See Claire Melamed, *The Collapse of the WTO Talks* (Sept., 16, 2003), at <http://www.christianaid.org.uk/cancun/030916feature.htm> (At the summit, "[t]he governments of developing countries were demanding that the WTO guarantee their rights to help farmers facing impossible competition from cheap imports, while rich countries were demanding that developing countries throw open their borders as the price of any reduction in agricultural subsidies.").

¹⁰⁷ See *Patently Problematic*, *supra* note 86, at 76.

¹⁰⁸ *Id.*

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Convention on Biological Diversity (“CBD”) in 1992.¹⁰⁹ The United States signed the CBD a number of years ago, but it has not been ratified by the Senate, primarily due to opposition from biotechnology and agrochemical industries.¹¹⁰

The CBD demonstrates international recognition of the need to protect and preserve the global natural environment through the conservation and preservation of biological diversity and through the use of environmentally sustainable methods of development.¹¹¹ In particular, Article 8(j) expresses the vital importance of traditional knowledge and resources held by indigenous peoples, and it emphasizes the need for indigenous peoples’ active involvement towards reaching these goals.¹¹² Obtaining prior informed consent from indigenous custodians before using their traditional knowledge or genetic resources is mandatory for contracting parties under the CBD, and users are required to share any resultant benefits with the relevant source communities, including economic benefits arising from commercialization.¹¹³ A set of working guidelines for implementing these requirements, known as the “Bonn Guidelines,” has been drafted and approved for member use.¹¹⁴ These guidelines recommend that each member state establish a national “clearing-house mechanism” to oversee and ensure compliance with CBD terms for all contractual relationships involving access to, use, and commercialization of genetic material in the custodianship of indigenous communities.¹¹⁵

Effective TKGRF legal protection involves many complicating factors in addition to the incendiary economic

¹⁰⁹ See Convention on Biological Diversity, *Convention Text*, at <http://www.biodiv.org/convention/articles.asp> (last updated Dec. 6, 2003).

¹¹⁰ Rosemary Coombe, *The Recognition of Indigenous Peoples’ and Community Traditional Knowledge in International Law*, 14 ST. THOMAS L. REV. 275, 276 (2001) [hereinafter Coombe, *Recognition*].

¹¹¹ See Convention on Biological Diversity, *Sustaining Life on Earth 2* (Apr. 2000), <http://www.biodiv.org/doc/publications/cbd-sustain-en.pdf>.

¹¹² *Id.* at 6.

¹¹³ *Id.* at 9.

¹¹⁴ Convention on Biological Diversity, Decision VI/24, *Access and Benefit-Sharing as Related to Genetic Resources*, Apr. 2002, <http://www.biodiv.org/decisions/?m=cop-06>.

¹¹⁵ *Id.* at Annex, art. II.A., ¶ 13.

development backdrop.¹¹⁶ For one thing, the sheer diversity of cultural traditions, variety of creative and genetic material, and number of distinct groups of people involved are nearly overwhelming.¹¹⁷ A “one-size-fits-all” legal solution, whether in treaty or other form, seems far more likely to compound current conflict than to clarify issues and delineate responsibilities. Many ethnic groups seeking TKGRF protection live and tend their crops in territory that overlaps several national, and thus legal, boundaries.¹¹⁸ Then, too, national intellectual property regimes already vary enormously from country to country. Disparities among TKGRF legal protections will likely increase, at least in the near term, as some legislatures begin to experiment with regulation, and others do not.

In addition, some of the basic concepts inherent in intellectual property law are directly at odds with the goals of some indigenous people.¹¹⁹ Many indigenous societies seek perpetual and exclusive possession of their communities’ cultural expressions and traditional knowledge.¹²⁰ Some factions within indigenous societies want certain kinds of knowledge, usually those that are sacred or relate to the spiritual realm, to remain completely secret and forbidden from any use by the outside world.¹²¹ By contrast, many intellectual property laws are, of course, aimed at the eventual dissemination of information.¹²² Neither copyright nor patent law are designed to give any creator a permanent monopoly over his creation; one of the main objectives underlying limited term protection is to ensure a perpetual injection of new material into the public domain to stimulate further innovation.¹²³ Whether or not modern patent or, especially, copyright systems function effectively in this way today may be debatable, but outright

¹¹⁶ See generally *Integrating IP Rights*, *supra* note 86.

¹¹⁷ See, e.g., *Systematic Analysis*, *supra* note 25.

¹¹⁸ See, e.g., Horn, *supra* note 67.

¹¹⁹ Farley, *supra* note 42, at 54. Ms. Farley’s discussion of the variance between normative values in traditional indigenous societies and the economics-driven values of Western intellectual property regimes is a particularly clear illumination of this commonly-discussed issue. See generally *id.*

¹²⁰ *Id.* at 14–15.

¹²¹ *Id.* at 54–55.

¹²² *Id.* at 55.

¹²³ *Id.*

monopolistic grants of unlimited duration to specific groups of people would not only greatly deter the continuing evolution and development of their cultures and knowledge,¹²⁴ but might also noticeably increase inter-ethnic tension and logjams in court systems around the world. And while trademark and trade secrets laws can, at least theoretically, give protection for “unlimited times,” these areas of law, like the broader U.S. law of unfair competition, traditionally have been defined and developed on a strictly local basis, so lack of uniformity in protection might be substantial.¹²⁵

Even for indigenous stakeholders interested in allowing outside use or commercialization of their TKGRF, established intellectual property regimes are rife with other problems.¹²⁶ Copyright law in many countries, for example, requires identification of one or more specific authors of a work and does not allow for the type of collective authorship common in folkloric works.¹²⁷ Traditional folkloric works may also not be considered “original” in the copyright sense, because they are products of the cultural public domain, are developed incrementally over time, and are often executed according to strictly observed rules to which each successive generation of authors is bound.¹²⁸ Some countries, including the United States, require fixation of a work before copyright protection can exist,¹²⁹ which can be problematic in TKGRF because some of the most common methods for expressing, preserving, and disseminating knowledge in

¹²⁴ *Id.*

¹²⁵ *Id.* at 50–54 (discussing the applicability and limitations of the law of unfair competition and trade secrets in the context of traditional art).

¹²⁶ *Id.* at 17–40 (discussing the problems that indigenous stakeholders face, including the duration of the rights, the originality requirement, the fixation requirement, group rights, and the fair use exception).

¹²⁷ *Id.* at 29–30.

¹²⁸ *Id.* at 18–22.

¹²⁹ 17 U.S.C. § 102(a) (2004). “[C]opyright protection subsists in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. . . .” *Id.* In the U.S., categories of copyrightable works of authorship include literary, musical, and dramatic works, pantomimes and choreographic works, pictorial, graphic, and sculptural works, motion pictures and other audiovisual works, sound recordings, and architectural works. *Id.*

indigenous societies include storytelling, riddles, songs, and other oral traditions.¹³⁰

From a TKGRF perspective, patent protection can be equally problematic. Patenting centuries-old traditional knowledge is often unavailable to indigenous owners because of the novelty and nonobviousness requirements of most patent regimes.¹³¹ Time bars for public use or sale¹³² would also operate against indigenous communities who might otherwise apply today for patents incorporating such knowledge considered new by the larger world, yet long used within the confines of the traditional community.¹³³ Laws in some developing countries may not allow any patent protection for genetic material from plants, animals, and microorganisms, while comparable laws in the United States and other industrialized countries do often allow such patents.¹³⁴ This disparity can enable those who are able to obtain expensive patents in industrialized countries to collect monopoly rents for “discovering” material and knowledge originating with indigenous communities, who may themselves be unable to patent their TKGRF at home and who may have neither the sophistication nor the financial resources to protect it abroad in their own name.¹³⁵ Also, while much traditional knowledge presently is codified only in oral traditions, some countries’ patent examination procedures sometimes recognize only written prior art,¹³⁶ further increasing the chances that patent protection may be granted to usurping third parties for “inventions” long known among local traditional communities.¹³⁷

¹³⁰ Farley, *supra* note 42, at 27–28; *see also Systematic Analysis*, *supra* note 25, at 8.

¹³¹ In the U.S., these requirements are found at 35 U.S.C. §§ 102–03 (2004). Similar requirements exist in most national laws and international patent regimes. *See also* European Patent Convention, art. 54, <http://www.european-patent-office.org/legal/epc/e/ar54.html> (last updated Mar. 2004).

¹³² *See, e.g.*, 35 U.S.C. § 102.

¹³³ *See* Heinz Goddar, *Biotech Patents and Indigenous Knowledge* (July 20, 2002), at <http://www.law.washington.edu/casrip/Symposium/Number8> (last updated Oct. 4, 2004).

¹³⁴ *See* 35 U.S.C. § 102; *see generally* European Patent Convention, <http://www.european-patent-office.org> (last visited Nov. 9, 2004).

¹³⁵ For a more in-depth discussion of this concept, *see* Dutfield, *supra* note 2, at 255–56.

¹³⁶ The United States, for example, limits consideration of prior art to the available, printed, material during its examination proceedings. *See* 35 U.S.C. § 102.

¹³⁷ Dutfield, *supra* note 2, at 256.

2. Representative Sampling of TKGRF Disputes

A number of interesting and unusual copyright and patent disputes have arisen over the last decade relating to TKGRF, and courts and government agencies have begun to grapple with these conflicts, sometimes in creative and interesting ways.

a) Copyright Disputes

A recent Australian copyright case involved the importation into Australia of printed fabric using unauthorized designs derived from a local Aboriginal artist's painting, "Magpie Geese and Water Lilies at the Waterhole."¹³⁸ Both the painter and his tribe's representative separately sued the foreign textile manufacturer for copyright infringement in 1996.¹³⁹ The Federal Court of Australia for the Northern Territory District examined customary Aboriginal law to determine the factual nature of the relationship between the painter and his tribe, as well as the painter's authority to use sacred information and designs belonging to the tribe in making his painting.¹⁴⁰ The court determined that under Australian law the painter had a fiduciary duty to the tribe to ensure that his artistic work would not be exploited in a manner contrary to tribal law and custom.¹⁴¹ Since the painter had successfully brought an infringement action against the textile manufacturer, however, he had appropriately discharged his fiduciary obligations to the tribe, and the tribe thus had no right to any further cause of action against the manufacturer.¹⁴²

In another landmark case, an Australian federal judge determined that an award of collective damages to a group of Aboriginal artists was appropriate redress for "cultural harm"

¹³⁸ *Bulun Bulun v. R&T Textiles Pty. Ltd.*, 157 A.L.R. 193 (1998), available at <http://www.austlii.edu.au/cgi-bin/disp.pl/au/cases/cth/federal%5fct/1998/1082.html?query=%5e+bulun> (last modified Sept. 8, 1998).

¹³⁹ *Id.* at 246.

¹⁴⁰ *Id.* at 247.

¹⁴¹ *Id.* at 264.

¹⁴² *Id.*

caused by a Vietnamese carpets importer who was found to have infringed the artists' copyrighted painting designs.¹⁴³

In an earlier case, *Yumbulul v. Reserve Bank of Australia*,¹⁴⁴ an Aboriginal artist created a Morning Star Pole, which is a sculptural work generally created for and used in Aboriginal ceremonies memorializing the death of important tribe members.¹⁴⁵ The artist in this case was authorized by his tribe to create the work, and he held a valid copyright in the work.¹⁴⁶ When the Bank of Australia reproduced an image of the work on its ten-pound note, however, the artist sued the bank, claiming he had no authority from his tribe to allow reproduction not in accordance with customary law.¹⁴⁷ In addressing the juncture of customary law and Australian copyright law, the court ultimately found that the latter does not recognize protection of artistic works that are communal in origin.¹⁴⁸

b) Patent Disputes

In the patent arena, patents and patent applications for derivations (developments from, or processes relating to, genetic material originating with indigenous custodians) have sparked increasingly frequent disputes. Most commonly, these have involved plant substances that have been long used by traditional societies for healing and other properties, but are new to the industrialized world, where they are subsequently patented by third parties who profess to have "discovered" them.¹⁴⁹

¹⁴³ See *Milpururru v. Indofurn Pty. Ltd.*, 54 F.C.R. 240 (1993), available at <http://www.austlii.edu.au/cgi-bin/disp.pl/au/journals/AILR/1996/backup/20.html?query=%5e+milpururru> (last visited Nov. 9, 2004).

¹⁴⁴ *Yumbulul v. Reserve Bank of Australia*, 21 I.P.R. 481 (1991), available at <http://www.austlii.edu.au/cgi-bin/disp.pl/au/cases/cth/federal%5fct/unrep4955.html?query=%5e+yumbulul> (last visited Nov. 9, 2004).

¹⁴⁵ Terri Janke, *Minding Culture: Case Studies on Intellectual Property and Traditional Cultural Expressions*, Dec. 2, 2002, at Case Study 3, p. 61 n.45 and accompanying text, <http://wipo.int/tk/en/studies/cultural/minding-culture/studies/finalstudy.pdf>.

¹⁴⁶ *Id.* at 61.

¹⁴⁷ *Id.*

¹⁴⁸ See *id.*

¹⁴⁹ Srividhya Ragavan, *Protection of Traditional Knowledge*, 2 MINN. INTELL. PROP. REV. 1, 11 (2001) (citing Estelle Doris Long & Antony D'Amato, INTERNATIONAL INTELLECTUAL PROPERTY 1056-57 (West Group 2000)).

Probably the most famous example of this to date occurred in 1995, when the USPTO issued a U.S. patent for turmeric,¹⁵⁰ a cooking and healing substance used for these purposes for centuries in India.¹⁵¹ The Indian Council for Scientific and Industrial Research opposed the patent, claiming prior art based on an ancient Sanskrit text and an Indian Medical Association paper published in 1953.¹⁵² The controversy resulted eventually in the revocation of the patent by the USPTO,¹⁵³ but the “turmeric incident” has become a celebrated instance of TKGRF misuse and has contributed to widespread criticism of U.S. patent examination procedures.¹⁵⁴

Presently, over 400 patents based on various uses of turmeric can now be found in the USPTO patent database, including some for such age-old uses as breath-fresheners,¹⁵⁵ for curing warts,¹⁵⁶ and as a nutritional supplement for fending off colds and sore throats¹⁵⁷—uses that would be unlikely to surprise any householder in India. Questioning the novelty and nonobviousness of such products and uses by those long familiar with them is certainly legitimate, as is the inquiry concerning whether such products and uses should be given monopoly commercial status in any country. These inquiries seem particularly legitimate when no disclosure is made in the patent application regarding the existence or source of the traditional knowledge lying at the heart of the patent in question, and where the patent holder does not share any of the eventual commercial benefits with the original knowledge-holding community.

Another plant, neem, has been the subject of numerous patents and extensive global dissent, including establishment of a generalized anti-patent campaign by one Indian research foundation.¹⁵⁸ Neem has also been widely used in Indian healing

¹⁵⁰ *Id.*

¹⁵¹ *Id.*

¹⁵² *Id.*

¹⁵³ *Id.*

¹⁵⁴ Coombe, *Recognition*, *supra* note 110, at 281.

¹⁵⁵ U.S. Patent No. 6,511,679 (issued Jan. 28, 2003).

¹⁵⁶ U.S. Patent No. 6,593,371 (issued July 15, 2003).

¹⁵⁷ U.S. Patent No. 6,596,313 (issued July 22, 2003).

¹⁵⁸ Ragavan, *supra* note 149, at 12.

and agriculture for centuries.¹⁵⁹ Despite this, one much-publicized incident involved a neem extract patented by W.R. Grace Inc. in the U.S. for its storage stability properties.¹⁶⁰ Although the Indian government filed a complaint with the USPTO, the patent has not been revoked.¹⁶¹ However, another patent held by the same company, using neem as an anti-fungal agent, was revoked six years after issuance by the European Union Patent Office, based on testimony of an employee at an Indian agricultural business that they had been using the same substance for this purpose several years before the filing of the European application.¹⁶² Other patents based on neem derivatives for pesticidal uses also have been issued in the U.S., despite the fact that these properties of the plant are well-known in Indian agriculture.¹⁶³ At least one patent holder has applied for similar patent registrations in Latin America and Europe.¹⁶⁴

Another particularly celebrated plant patent controversy surrounded the issuance of U.S. patents to Loren Miller, owner of the International Plant Medicine Corporation, for processing and commercialization of ayahuasca, a plant sacred to many Amazonian peoples for ritual use.¹⁶⁵ There is neither evidence that Mr. Miller obtained permission from the Ecuadorian government to remove the original plant sample upon which his patent claims were eventually based, nor evidence that the sample was taken with the prior informed consent of the indigenous community on whose land holdings it was grown.¹⁶⁶ According to the Coordinating Secretariat of Organizations of Indigenous Peoples from the Amazon ("COICA"), the supposed new variety of

¹⁵⁹ *Id.*

¹⁶⁰ *Id.*

¹⁶¹ *Id.* at 12.

¹⁶² *Id.*

¹⁶³ *Id.*

¹⁶⁴ *Id.* at 13.

¹⁶⁵ Rosemary Coombe, *Intellectual Property, Human Rights & Sovereignty: New Dilemmas in International Law Posed by the Recognition of Indigenous Knowledge and the Conversation of Biodiversity*, 6 IND. J. GLOBAL LEGAL STUD. 59, 88 (1998) [hereinafter Coombe, *New Dilemmas*].

¹⁶⁶ *Id.* at 89.

ayahuasca that Mr. Miller claims to have “discovered” was actually domesticated locally hundreds of years ago.¹⁶⁷

A recent TKGRF controversy that has captured widespread international media attention involves hoodia, a cactus eaten by South African San tribesmen to stave off thirst and hunger during extended travel.¹⁶⁸ Traditional knowledge holders revealed their knowledge of this plant’s properties to South African government researchers at the Council for Scientific and Industrial Research (“CSIR”), a public agency charged with helping local communities develop natural resources into commercial products.¹⁶⁹ CSIR isolated and patented the appetite suppressant in the plant and then licensed it to a small British company, which in turn sublicensed it to Pfizer for expected commercialization into a blockbuster diet pill.¹⁷⁰ The British company claimed that CSIR said that the original inventors had long since disappeared; CSIR claimed it had planned to divulge the resulting patenting and commercialization plans to the San, once regulatory approval was obtained.¹⁷¹ Since this often occurs a decade or more after initial isolation of the active chemistry of a medicinal plant, CSIR did not want to raise unwarranted San expectations of profits.¹⁷² When publicity concerning the Pfizer deal surfaced, the San became aware of the situation and hired counsel to protect their interests.¹⁷³ CSIR was widely condemned for failing to earmark any of the projected royalties for either general conservation efforts or for the San.¹⁷⁴ Recently, CSIR reached an agreement with the San concerning an appropriate benefit-sharing scheme.¹⁷⁵

Closer to home, several plant patent issues are being contested by Native Americans and by small producers of long-established

¹⁶⁷ *Id.*

¹⁶⁸ Julia Finch, *Bushmen Aim for Cactus Rich Pickings*, *Guardian Unlimited* (Nov. 10, 2001), at <http://www.guardian.co.uk/Archive/Article/0,4273,4296262,00.html>.

¹⁶⁹ *Id.*

¹⁷⁰ *Id.*

¹⁷¹ *Id.*

¹⁷² *Id.*

¹⁷³ *Id.*

¹⁷⁴ *Id.*

¹⁷⁵ BBC News, *S. African Bushmen Hail Drug Deal* (Mar. 24, 2003), at <http://news.bbc.co.uk/go/pr/fr/-/2/hi/africa/2883087.stm>.

food crop plants.¹⁷⁶ Minnesota's Chippewa Indians have informally contested a plant patent application on a type of wild rice filed by NorCal Wild Rice of Woodland, California, and are asking the company to stop genetic research on the product.¹⁷⁷ The group may file an interference at the USPTO, but NorCal insists the controversy is merely a miscommunication about the nature of its patent and related research.¹⁷⁸ Another recent case involved a patent infringement suit brought by the holder of a Certificate of Protection for a type of yellow bean that others, including the Mexican government and Tutuli Produce, an Arizona company, contend has been in existence and grown by many for years.¹⁷⁹ Sixteen Colorado producers and processors settled the case with the patent holder in 2002, but experts predict that the rights of indigenous peoples in genetic resources will continue to be tested, especially in connection with transgenic (genetically modified) plants.¹⁸⁰

Human genetic material sampled originally from indigenous community donors has given rise to another group of patent dilemmas. One case involved isolation by Western scientists of a gene apparently responsible for resistance to leukemia; it was found in blood sample collected from a woman from the Guaymi tribe in Panama.¹⁸¹ A joint research program between Panamanian scientists and the U.S. National Institutes of Health ("NIH"), sponsored by the Centers for Disease Control (CDC) of the U.S. Dept. of Health and Human Services, led to the development of a T-cell line out of the original blood sample, and NIH promptly filed a patent application.¹⁸² International protest followed, including complaints to the secretariats of the GATT and the Secretariat InterGovernmental Committee on the CBD,¹⁸³ despite the fact that U.S. officials claim the donor gave her informed oral

¹⁷⁶ Victoria Slind-Flor, *Cultivating the Rice Wars*, 3 IP LAW AND BUSINESS 16 (2003).

¹⁷⁷ *Id.*

¹⁷⁸ *Id.*

¹⁷⁹ *Id.*

¹⁸⁰ *Id.*

¹⁸¹ See POSEY & DUTFIELD, *supra* note 27, at 26.

¹⁸² *Id.*

¹⁸³ *Id.*

consent.¹⁸⁴ Some experts question whether her consent, even if given, included a full understanding of the implications of patent applications, and many believe that the NIH eventually bowed to the international outcry when it withdrew the patent application.¹⁸⁵ However, even with the application withdrawn, the cell line may be deposited for a maximum of 30 years under the Budapest Treaty; so far, it has not been returned to the tribe.¹⁸⁶ Some fear that the cell line will ultimately become public domain property, eliminating any possibility for the tribe to share in the benefits of commercialization.¹⁸⁷

At least two other situations involving patent applications filed on cell lines isolated from genetic material donated by indigenous peoples have occurred within the last ten years.¹⁸⁸ Both involved NIH as patentee, and in each case NIH contends that the donors gave their prior informed consent.¹⁸⁹ The NIH view was strongly disputed in both instances: in one of the cases, the government of Papua New Guinea unsuccessfully objected to the U.S. patent, and in the other, the government of the Solomon Islands has asked that the patent application be withdrawn.¹⁹⁰

3. The Current Range of Proposed Solutions to TKGRF Issues

A variety of solutions to TKGRF disputes are currently under consideration and experimentation. These range from regulating private contracting conduct to passing protective *sui generis* national legislation to drafting regional model laws on TKGRF.¹⁹¹ Intermediate forms of management include permitting joint patent ownership, changing patent application disclosures, establishing public database registries for traditional knowledge, and creating a

¹⁸⁴ *Id.*

¹⁸⁵ *Id.*

¹⁸⁶ Ragavan, *supra* note 149, at 11.

¹⁸⁷ *Id.*

¹⁸⁸ POSEY & DUTFIELD, *supra* note 27, at 27.

¹⁸⁹ *Id.*

¹⁹⁰ *Id.*

¹⁹¹ See Farley, *supra* note 42, at 43–46 (discussing model laws for the protection of TKGRF).

flexible legal interface dispute resolution mechanism for TKGRF conflicts.¹⁹²

a) Resolution through Private Contracting

Although many industry representatives do not dispute that bioprospecting has become an accepted and widespread business practice, some question how big a problem biopiracy really is, because no reliable empirical evidence exists on how often it occurs.¹⁹³ There is a lack of statistical information clearly showing evidence of widespread inequities in commercial benefit-sharing,¹⁹⁴ so the perception among some industry and Western patent offices is that the publicity surrounding biopiracy exaggerates the severity of the situation.¹⁹⁵ Some trade spokesmen believe that many corporate entities would be willing to accept reasonable source disclosure and benefit-sharing requirements in patent applications, so long as these legal requirements were clear, unambiguous, and not likely to be arbitrarily or rapidly overturned.¹⁹⁶

To a certain extent, TKGRF issues that may arise in a developing country are indistinguishable from the difficulties inherent in any transnational contracting situation involving large-scale foreign investment in a developing country.¹⁹⁷ The rule of

¹⁹² See *Technical Proposals on Databases and Registries of Traditional Knowledge and Biological/Genetic Resources*, at 5, WIPO, Intergovernmental Comm. on Intell. Prop. & Genetic Resources, Traditional Knowledge & Folklore, WIPO/GRTKF/IC/4/14 (Dec. 6, 2002) [hereinafter *Technical Proposals*], http://www.wipo.int/documents/en/meetings/2002/igc/pdf/grtkf_ic_4_14.pdf (last visited Nov. 9, 2004).

¹⁹³ Telephone Interview with Lila Feisee, Director of Intellectual Property, Biotechnology Information Organization ("BIO") (Jan. 28, 2003) (on file with author). BIO is a U.S.-based trade association of over 1100 research institutions, companies and universities, with members located in all fifty states of the U.S. and in thirty-three foreign countries.

¹⁹⁴ *Id.*

¹⁹⁵ *Id.*; see also Telephone Interview with Linda Lourie, Attorney-Advisor, USPTO (Dec. 4, 2002) [hereinafter *Lourie Interview*] (on file with author).

¹⁹⁶ *Id.*; see also Telephone Interview with Jeff Kushan, Partner, Sidley, Austin, Brown & Wood (Jan. 30, 2003) (on file with author). Mr. Kushan participated on behalf of the USPTO in the 1992 negotiations leading to creation of the CBD; he served at the time of interview as outside counsel to BIO.

¹⁹⁷ This discussion is based on the author's own experience as counsel with a Fortune 100 oil exploration company in Central Africa, but any practitioner who has negotiated

law may not be fully established locally, and laws and implementing regulations governing the transaction may be vague, subject to constant change, or even nonexistent at the time of initial negotiations. Understandably, foreign investors seek a stable investment environment, with clear and predictable rules of law—including intellectual property laws—before committing the enormous sums of money necessary to establish a biotech or large agribusiness venture overseas.

At the same time, however, indigenous communities (and national governments) have a legitimate interest in knowing exactly what their contribution to the venture will be, how it will be used, and how and when they are to be compensated, so that they can determine from the outset whether the economic and cultural costs and benefits justify their participation. In particular, parties entering into a venture based in whole or in part on indigenous TKGRF should consider and negotiate contractual terms with regards to: requiring registration with national and local authorities (via national permit systems) before engaging in research or collection activity, obtaining the prior informed consent of the indigenous groups whose land will be entered and knowledge will be collected, sharing the data and sample collections with host governments and local community participants, and agreeing on how benefits will be shared and source attributions made.¹⁹⁸ But the parties must also recognize that TKGRF-related negotiations are likely to be even more protracted than those earlier experienced in traditional foreign investment sectors, such as the petroleum and timber industries. Similarly, the education process surrounding transactions involving TKGRF is also likely to be more protracted because of the complex interplay of cultural, social, legal, and environmental factors involved.¹⁹⁹

Numerous mechanisms have been suggested to enable a more equitable and transparent contracting process, some of which are

technical contracts in a developing country is likely to find these ideas quite commonplace and unremarkable.

¹⁹⁸ See BIODIVERSITY AND TRADITIONAL KNOWLEDGE, *supra* note 83, at 176.

¹⁹⁹ See World Bank Operational Directive 4.20, Indigenous Peoples and Biodiversity in Latin America: A Survey of Current Information (Aug. 11, 1996) at Tables 2 and 3.

true advances in thinking, and some of which may not be realistic in what are often still, essentially, business negotiations. These include: having the foreign investor pay the indigenous community's legal fees upfront, so that both sides have the benefit of counsel from the start of negotiations;²⁰⁰ having a third-party mediator participate in contract negotiations to ensure that both sides are fully informed of the nature and consequences of their proposed contractual arrangements;²⁰¹ and giving the indigenous or local community party the right to unilaterally discontinue the project at any time,²⁰² presumably even after an agreement is signed and the project is underway.

This last suggestion seems particularly unrealistic, at least in the business context. No responsible investor could be expected to enter into a deal where the other party could cancel at any time without incurring responsibility for the substantial adverse legal and economic consequences. To allow indigenous parties to do this as a matter of standard policy, as advocated by some in the TKGRF field,²⁰³ would be both inequitable and irresponsible. Contractual provisions for free contract cancellation or information use retraction at any time must be seriously questioned, since part of any business deal commonly involves risk—not just with respect to profit realization, but that the actual project realization may not be what the parties envisioned when they entered the contract or that it may entail higher costs (not always economic) and lesser benefits than expected. To a certain extent, these are merely the same risks borne by all parties in every business deal, large or small. Insulating one party completely from the consequences of its own decisions would not further anyone's interests in a responsible manner. If not carefully managed, these kinds of provisions could also have damaging repercussions to the

²⁰⁰ POSEY & DUTFIELD, *supra* note 27, at 157.

²⁰¹ *Id.* at 73–74 (referencing provisions of *The Global Coalition for Biocultural Diversity Covenant on Intellectual, Cultural and Scientific Resources*, <http://users.ox.ac.uk/~wgtrr/gbcd.htm> (last visited Nov. 13, 2004)).

²⁰² Inuit Tapirisat of Canada, *Negotiating Research Relationships in the North*, Programme for Traditional Resource Rights, <http://users.ox.ac.uk/~wgtrr/inuit.htm#top> (last updated May 30, 1996).

²⁰³ *Id.*

host countries, by weakening the host country's reputation for supporting the rule of law and the sanctity of contracts.

However, the motivation behind the suggestion for a late-stage cancellation option for indigenous TKGRF contributor communities is sound. Indeed, what is an indigenous community to do if, as a project progresses, it becomes clear that continued participation is having dangerously destructive and unforeseen effects on the community, on its natural habitat, or on the survival of the contributed TKGRF itself? One solution in this scenario would be to enable the community to halt the project and for the investor to receive compensation for sunk costs and lost profits projected at the time of contracting, perhaps from a national or international fund set up for this purpose. Such funds could also be used to reimburse the foreign investor for the upfront, paid-in costs of indigenous legal fees in completed projects, once profitability occurs and benefits flow to local and national populations.

Ensuring that indigenous communities receive adequate legal representation in these types of business dealings is also a legitimate objective for formulators of TKGRF policy. Local communities should have the benefit of objective and neutral legal expertise and advice (preferably in their own languages), and of business advice and planning as well, so that they are as well-informed as possible about the consequences of entering into any particular project affecting their TKGRF. But repaying cancellation costs might be impossibly high, even if an international or national fund were established for this purpose, and compensation for lost time and manpower to the foreign investor also would be astronomical in many cases. Similarly, the forced introduction of a third party "facilitator" into what is already an extremely complex and time-consuming negotiating process could easily ensnare contracting parties in a political and bureaucratic mire, creating, instead of resolving, problems.

b) Patent Disclosure and Joint Ownership of Patents

Various changes in patent practices are often suggested as a means by which indigenous groups could obtain greater recognition for their TKGRF contributions and a greater share in

associated commercial benefits.²⁰⁴ Among the more frequent proposals are (1) joint ownership of patents developed from indigenous TKGRF, wherein both the indigenous community and the accessing party share the patent as co-owners, and (2) required disclosure of TKGRF-related information on patent applications. The former proposal likely could be resolved through private contracting or through stipulated requirements in national TKGRF contracting guidelines, while the latter probably would have to be formalized either by amending the TRIPS requirements for patentability,²⁰⁵ by changing national patent office application procedures, or by implementing national patent legislation in the country of origin of the indigenous community.

Joint ownership by the investor and the contributor community is one solution often advanced as a way for indigenous groups to achieve some of their goals. This solution, however, may not be realistic in the TKGRF context for the same reason it often proves unrealistic among two parties in the industrialized world: if the parties cannot agree on use of a jointly owned patent, the result may be a complete lack of exploitation. Even worse, joint ownership by disagreeing parties can result in harmful licensing practices. Normally, each owner of a jointly owned patent may grant licenses under the patent without the consent of other owners, and no accounting need be made to them, absent prior agreement to the contrary.²⁰⁶ Co-owners are each entitled to their share of licensing royalties, but nonroyalty interests would not have to be respected,²⁰⁷ and an unwitting indigenous community could find its patent being used in undesirable ways by other, uncontrolled corporate licensees. Since sole ownership of patents by indigenous communities seems highly unlikely in any joint project, a better practice would probably be careful negotiation and drafting of a contractual relationship with a sole corporate owner concerning how the patent can be exploited and licensed. Of course, indigenous community access to counsel with the

²⁰⁴ See Ragavan, *supra* note 149, at 32.

²⁰⁵ TRIPS Agreement, *supra* note 94, art. 27.

²⁰⁶ Brian G. Brunsvold & Dennis P. O'Reilly, DRAFTING PATENT LICENSE AGREEMENTS 10–11 (1998).

²⁰⁷ *Id.*

appropriate specialized expertise would be a prerequisite for this strategy to be successful.

Mandatory disclosure of source information in patent applications for TKGRF-related patents is also regularly urged as another solution in this area.²⁰⁸ Many people advocate amending the current patentability requirements to include information about the geographic source of genetic material from which patent claims derive or are developed, as well as disclosure of the source of any traditional knowledge used in developing patent claims.²⁰⁹ Some even advocate requiring evidence of prior informed consent in patent applications.²¹⁰

Opponents often point out that TRIPS mandates minimum international standards for patentability,²¹¹ and that any change in these standards in national legislation or generally accepted patent office practices would be inconsistent with treaty obligations.²¹² Obviously, amending the TRIPS agreement would solve this problem, but this is not likely to occur anytime in the near future, because many industrialized countries, most importantly the United States, oppose making this a mandatory solution.²¹³ Even if TRIPS were amended, new patent office procedures and national legislation would still be needed to effect conformity with the treaty change and to ensure treatment uniformity.

A more workable solution would be widespread recognition by courts and patent offices—buttressed where necessary by national legislation—of an equitable link between application disclosure and enforceability of a subsequently issued patent.²¹⁴ As one

²⁰⁸ Downes, *supra* note 3, at 274.

²⁰⁹ *Id.*

²¹⁰ *Id.*

²¹¹ TRIPS Agreement, *supra* note 94, § 5, art. 27 (requiring for patentability a showing that an invention is new, involves an inventive step, and is capable of industrial application).

²¹² Linda Lourie, statements and comments in floor discussion on behalf of the United States delegation to the fourth WIPO Intergovernmental Committee (Dec. 12–19, 2002) [hereinafter Lourie Statements] (on file with author).

²¹³ Nuño Pires de Carvalho, *Requiring Disclosure of the Origin of Genetic Resources and Prior Informed Consent in Patent Applications without Infringing the TRIPS Agreement*, 2 WASH. U. J.L. & POL'Y 371 (2000).

²¹⁴ *Id.* at 372.

eminent legal scholar has pointed out, failure to disclose appropriate source information in a patent application could be remedied by judicial refusal to enforce the patent, especially in situations where the patentee acted improperly in deriving an invention directly or indirectly from an abusive act, such as unauthorized acquisition and use of genetic material or traditional knowledge.²¹⁵ Applying the U.S. patent doctrine of fraudulent procurement in this situation would yield a beneficial result and would not require treaty or legislative amendment.²¹⁶ In the U.S., lack of candor in a patent application in nonessential matters can result in non-enforceability of the patent until such time as the patentee corrects the misrepresentation or other inequitable conduct, such as failure to disclose, and thus “cleans his hands.”²¹⁷ This solution seems to offer the considerable advantage of potentially prompt implementation by court systems and equally prompt results for the complaining party, since most patentees are likely to respond immediately to a potential threat of patent unenforceability. Unfortunately, despite its reasonableness, practicality, and consonance with the spirit of TKGRF, this particular solution does not yet appear to have received widespread attention in the TKGRF debate.

Recently, however, at a meeting of the WIPO Working Group on Reform of the Patent Cooperation Treaty (“PCT”), Switzerland made a similar proposal, suggesting that the PCT Regulations be amended to require a declaration of the source of genetic material and associated traditional knowledge for inventions directly based on such material and knowledge.²¹⁸ Such a declaration could be made during or after the international filing phase of the application; member states’ national legislation would be allowed to provide for a halt in processing any application during the national phase until such time as the necessary declaration was

²¹⁵ *Id.* at 395.

²¹⁶ *Id.*

²¹⁷ *Id.* at 397.

²¹⁸ *Proposals by Switzerland Regarding the Declaration of the Source of Genetic Resources and Traditional Knowledge in Patent Applications*, Annex at 1, WIPO, Int’l Patent Cooperation Union, Working Group on Reform of the Patent Cooperation Treaty (PCT), PCT/R/WG/4/13 (May 5, 2003), http://www.wipo.int/pct/en/meetings-/reform_wg/pdf/pct_r_wg_4_13.pdf (last visited Nov. 12, 2004).

provided.²¹⁹ Switzerland also proposed that the Patent Law Treaty be changed to allow its members to pass national legislation requiring such declarations in national patent law applications and punishing the absence of such declarations by invalidating the patent in cases where such absence is due to fraudulent intention.²²⁰

c) Database Registries

Traditional knowledge and cultural expressions, as well as certain genetic material, can be registered in database “libraries” that chronicle indigenous communities’ ownership, use, and husbandry of TKGRF.²²¹ These databases can be used “defensively” to combat third party usurpation of TKGRF by accurately recording ownership and making this information available to patent examiners.²²² Databases can also be used “positively” to record and preserve TKGRF for use by future tribal generations or, where appropriate, for exchange with other indigenous communities to meet a common need.²²³

Numerous projects of this nature are now underway in a variety of bilateral and multilateral forums.²²⁴ One of the earliest and most ambitious of these efforts deals with traditional medicine and is being spearheaded by India, with WIPO assistance. This database will eventually include all known texts on traditional Ayurvedic (Indian) medicine, translated from local languages to ensure the widest possible accessibility.²²⁵ A similar database has been established for Chinese traditional medicine.²²⁶

One expert closely involved in some of the traditional knowledge database registry projects in India estimated in December 2002 that at least 700–800 U.S. patents have been issued that are improperly based on TKGRF, and he had revised

²¹⁹ *Id.*

²²⁰ *Id.* at 2.

²²¹ See *Technical Proposals*, *supra* note 192, at app.

²²² *Id.*

²²³ *Id.*

²²⁴ *Id.*

²²⁵ *Id.* at 3 (referencing Traditional Knowledge Digital Library of Ayurveda).

²²⁶ *Id.* (referencing China Traditional Chinese Medicine (“TCM”) Patents Database).

his estimate substantially upward by June 2003.²²⁷ He and many others believe that much of the foundational knowledge for such patents is taken directly from traditional Sanskrit documentation of the sort now being translated into major world languages and placed in these registries.²²⁸ Registration may help curtail the future proliferation of inappropriate patent applications, particularly those presently filed by scientists or entrepreneurs who are now employed in the West but who have grown up in developing countries where the knowledge originates and where it is viewed as available for use by anyone.

An interesting related project in public/private TKGRF registry is being developed by the Tulalip Tribes in Washington State.²²⁹ This Native American group is working on an innovative computer software program that can provide confidential database protection for such TKGRF as storytelling traditions, knowledge about native plants, and traditional salmon fishery management.²³⁰ The program is readily adaptable for use with many other kinds of TKGRF.²³¹ It operates on a tiered accessibility platform, so that information of various types can be afforded different levels of confidentiality; different groups or individuals within an indigenous society, such as tribal councils or shamans, can control access to higher levels of information.²³² If community members agree, all or part of the files can be made accessible to government patent examiners for defensive searching.²³³ Tribal representatives demonstrated a prototype of the program to the WIPO IGC in June 2002, where it was particularly well-received because it was conceived and developed by indigenous people themselves, independent of government supervision and control.²³⁴

²²⁷ E-mail from V.K. Gupta, Director, National Institute of Science & Information Resources, New Delhi, India, June 8, 2003 (on file with author).

²²⁸ *Id.*

²²⁹ *Technical Proposals*, *supra* note 192, at app.

²³⁰ Julia Gold & Preston Hardison, *Cultural Stories Project: Integrating Traditional Knowledge into a Tribal Information System* (2003) (on file with author).

²³¹ Telephone Interview with Preston Hardison, Tulalip Tribes of Washington State (Mar. 12, 2003) [hereinafter Hardison Interview] (on file with author).

²³² *Id.*

²³³ *Id.*

²³⁴ *Id.*

d) Protective National Legislation for TKGRF

Not surprisingly, the solution that has received the most widespread attention in the search for TKGRF protection is passage of national regulatory legislation.²³⁵ This legislation is quite varied; it includes the collective ownership of copyrights, the right to contest culturally offensive trademark registrations, regional systems of model laws on TKGRF contracting and regulation, and the *sui generis* legislation²³⁶ mentioned earlier.

Panama, Nigeria, Tunisia, and New Zealand are a few examples of the nations that have recently written protective TKGRF legislation using a variety of creative approaches. Panama has introduced a new system of copyright-like rights that allows collective ownership registration in certain creative works.²³⁷ The first such registration was filed by an indigenous tribe, the Kuna, for collective ownership of its popular traditional textile form, the *mola*.²³⁸ Nigeria has criminalized the intentional distortion of expressions of folklore, and it also punishes source misrepresentation when a third party misuses an expression of folklore.²³⁹ Tunisian law provides blanket copyright protection for

²³⁵ This body of law is quite extensive and can only be examined thoroughly on a country-by-country basis. For a brief introduction, see *Systematic Analysis*, *supra* note 25; *Revised Version of Traditional Knowledge: Policy and Legal Options*, WIPO, Intergovernmental Comm. on Intell. Prop. & Genetic Resources, Trad. Knowledge & Folklore, WIPO/GRTKF/IC/6/4 Rev. (Feb. 19, 2004) [hereinafter *Revised Policy*], http://www.wipo.int/documents/en/meetings/2004/igc/pdf/grtkf_ic_6_4_rev.pdf (last visited Nov. 12, 2004).

²³⁶ See *supra* Farley, note 42, at 43–46.

²³⁷ Special Intellectual Property Regime on Collective Rights of Indigenous Peoples for the Protection and Defense of their Cultural Identity and their Traditional Knowledge, Republic of Panama, Law No. 20 of June 26, 2000; see also Provisions on the Protection, Promotion and Development of Handicraft, Republic of Panama, Law No. 27 of July 24, 1997.

²³⁸ *Systematic Analysis*, *supra* note 25, at 11.

²³⁹ *Presentations on National and Regional Experiences with Specific Legislation for the Legal Protection of Traditional Cultural Expressions*, at Annex III, WIPO, Intergovernmental Comm. on Intell. Prop. & Genetic Resources, Trad. Knowledge & Folklore, WIPO/GRTKF/IC/4/INF/2 (Nov. 25, 2002) [hereinafter *Presentation on Experiences*], http://www.wipo.int/documents/en/meetings/2002/igc/pdf/grtkf_ic_4_inf2-.pdf (last visited Nov. 12, 2004).

works of national folklore under a special *sui generis* regime,²⁴⁰ together with state collection of usage fees for public domain cultural works.²⁴¹ By statute, a part of these fees is to be redistributed to the source communities of the relevant folkloric work.²⁴²

New Zealand is currently amending its trademark laws to provide for restrictive registrations based on the ethnic origin of mark design and authenticity of indigenous product origin.²⁴³ If products meet the new statutory criteria, they will be entitled to carry a special “Maori Made” or “Mainly Maori” mark.²⁴⁴ No mark will be granted if its use or registration is likely to offend a significant section of the community, including the Maori.²⁴⁵ This would preclude, for example, issuance of a mark incorporating a sacred Maori design.

Some regional groups, such as the Andean Pact²⁴⁶ and the island nations of the Pacific Community,²⁴⁷ have taken a very assertive stance in TKGRF legal management and have developed extensive new laws for TKGRF protection.²⁴⁸ Regional laws are often based on the earliest model laws relating to TKGRF, which were originally developed jointly by WIPO and UNESCO in

²⁴⁰ Law 94-36 of Feb. 24, 1994 (concerning literary and artistic property); see also *Comparative Summary*, *supra* note 24.

²⁴¹ *Comparative Summary*, *supra* note 24.

²⁴² *Id.*

²⁴³ See Trade Marks Act, cl. 17, 2002 (N.Z.), available at <http://www2.piperpat.co.nz-/tmlaw/s000.html> (last visited Nov. 12, 2004).

²⁴⁴ *Id.*

²⁴⁵ *Id.*

²⁴⁶ The members of the Andean Pact are Bolivia, Colombia, Ecuador, Peru, and Venezuela. See <http://www.comunidadandina.org/ingles/who.htm> (last visited Nov. 12, 2004).

²⁴⁷ The Pacific Community has 27 members: American Samoa, Cook Islands, Federated States of Micronesia, Fiji Islands, French Polynesia, Guam, Kiribati, Marshall Islands, Nauru, New Caledonia, Niue, Commonwealth of the Northern Marianas, Palau, Papua New Guinea, Pitcairn Islands, Samoa, Solomon Islands, Tokelau, Tonga, Tuvalu, Vanuatu, Wallis, Futuna, Australia, France, New Zealand, United Kingdom, and the United States of America. See Secretariat of the Pacific Community, *SPC Members*, at <http://www.sidsnet.org/pacific/spc/members.htm> (last updated Sept. 10, 2002).

²⁴⁸ See, e.g., Grain & Kalpavriksh, *Traditional Knowledge of Biodiversity in Asia-Pacific*, http://www.grain.org/briefings_files/tk-asia-2002-en.pdf (Nov. 2002).

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1982.²⁴⁹ In 1996, the five countries of the Andean Pact passed legislation creating a common legal regime on access to genetic resources.²⁵⁰

Some regional groups are actively lobbying for WIPO's direct assistance in drafting extensive national and regional TKGRF legislation.²⁵¹ U.S. government officials, though, point out that overly aggressive regulatory legislation has resulted in a scientific research moratorium in various ecosystems in the Andes area and in the Philippines, an effect that was largely unforeseen and probably unintended by legislators.²⁵² This is counterproductive for all parties and may even unintentionally undermine the legitimate preservation and conservation objectives of the CBD.²⁵³

e) Flexible Jurisprudential Interface Mechanism

A few voices in the TKGRF debate have put forth the idea that, because of the diversity of TKGRF and the equal diversity of the cultures and social contexts within which TKGRF disputes arise, part of the solution lies in creating a flexible legal mechanism to provide an interface between Western and customary law that can be adapted to specific cultural contexts and factual situations.²⁵⁴ If traditional knowledge is indeed fundamentally different from the other forms of intellectual property presently known to us, its effective legal management may also require a novel approach.²⁵⁵ Participation of native elders, consideration of customary law concepts, and use of traditional dispute settlement mechanisms may need to be integrated systematically with the Western IP judiciary, laws, and enforcement methods to achieve meaningful

²⁴⁹ *Model Provisions for National Laws on the Protection of Expressions of Folklore against Illicit Exploitation and Other Prejudicial Actions*, WIPO & UNESCO (1985) [hereinafter *Model Provisions*], <http://www.wipo.int/tk/en/documents/pdf/1982-folklore-model-provisions.pdf>.

²⁵⁰ Andean Community, Commission of the Cartagena Agreement, *Decision 391—Common Regime on Access to Genetic Resources*, <http://www.sice.oas.org/trade-/JUNAC/decisiones/DEC391e.asp> (last visited Nov. 29, 2004).

²⁵¹ Telephone Interview with U.S. State Department officials (Dec. 17, 2002) (on file with author).

²⁵² *Id.*

²⁵³ *Id.*

²⁵⁴ TAUBMAN PRESENTATION, *supra* note 48.

²⁵⁵ *Id.*

legal protection of TKGRF.²⁵⁶ Whatever the ultimate—or even interim—solutions in this area, it is evident that with the complexity of TKGRF issues, legal thinkers and indigenous stakeholders must engage in creative thinking and experiment with novel approaches.

A main interest of some traditional knowledge holders is effective control of, and equitable participation in, commercialization of their knowledge and cultural material. But, as mentioned earlier, other traditional knowledge holders are more interested in preventing any dissemination whatsoever of their knowledge and cultural expression to the outside world.²⁵⁷ From this perspective, certain knowledge, particularly sacred or ritual knowledge and symbols, should remain secret and should never be subject to any dissemination. A middle view might allow limited dissemination for specific purposes, such as demonstrative use only of a dance or painting in a formalized cultural setting to educate outsiders about the indigenous society, without granting third party rights to replicate or reproduce the material in any fashion whatsoever.²⁵⁸

As has been ably discussed in the TKGRF legal literature to date,²⁵⁹ these are radically different viewpoints that directly affect analysis of the appropriate legal protections. Since a main underlying purpose of many types of intellectual property law is to facilitate, rather than to prevent, dissemination of knowledge, determining which of these perspectives is at issue in any given instance is critical in assessing whether any given body of intellectual property law offers appropriate protection. This characteristic of TKGRF issues seems to necessitate a flexible solution system, in which the particular TKGRF at issue can be assessed on a case-by-case basis, within its particular indigenous and environmental context.

²⁵⁶ *Id.*

²⁵⁷ See generally text accompanying notes 67–76.

²⁵⁸ See *Systematic Analysis*, *supra* note 25, at 34, ¶ 117 et seq.

²⁵⁹ See generally Farley, *supra* note 42; Coombe, *New Dilemmas*, *supra* note 165; Downes, *supra* note 3.

The ayahuasca dispute referred to earlier was an early example of a “sacred-use” situation,²⁶⁰ and COICA cogently expressed the offense felt at the ability of a single person to appropriate, assert proprietary rights in, and derive monetary benefit from the sacred symbol the plant embodies.²⁶¹ This dilemma—how to protect the sacred aspects (or, at least, the holistic essence) of TKGRF via the laws of dominating cultures that tend to view and protect intellectual property as a commodity—is one of the perplexing problems that cuts across all TKGRF sectors and presents one of the thorniest legal issues confronting legislators and scholars. It is a core dilemma that may justify creation of *sui generis* laws. It certainly also justifies Western judges in exploring and seeking guidance from applicable customary law in appropriate circumstances.

II. HOW DID THE TKGRF DEBATE EVOLVE AT WIPO, AND WHAT IS THE U.S. POLICY POSITION IN THAT DEBATE?

To fully understand the TKGRF controversy, it is useful to look at how TKGRF evolved as a discrete topic of discussion at WIPO and the current explorations taking place there. Each Member State articulates its national policy at WIPO, and it is interesting to compare U.S. policy statements at WIPO with the existing U.S. legislation relating to domestic indigenous TKGRF protection.

A. *Evolution of the International TKGRF Debate at WIPO*

It is instructive to look at how the international TKGRF debate has evolved within WIPO for three reasons. First, WIPO is the only international organization examining TKGRF from a technical intellectual property standpoint, although it appropriately attempts to analyze current and potential legal protections within their larger trade-related, economic, and social contexts as well.²⁶²

²⁶⁰ Coombe, *New Dilemmas*, *supra* note 165.

²⁶¹ *Id.* at 89.

²⁶² *Intellectual Property and Genetic Resources—An Overview*, at 3, WIPO, Meeting on Intell. Prop. & Genetic Resources, WIPO/IP/GR/00/2 (Mar. 24, 2000) [hereinafter *WIPO*].

Secondly, it is important to understand the evolution of WIPO analysis in TKGRF because many other international organizations, particularly those under the United Nations umbrella, are currently either temporarily deferring their own work in the TKGRF arena until WIPO reaches membership consensus on a protection plan, or they are working in tandem with WIPO in attempting to develop their own guidelines for TKGRF use and protection.²⁶³ Finally, the manner in which the TKGRF debate has evolved within WIPO loosely parallels the course of the present, slower awakening of U.S. awareness of and interest in TKGRF.²⁶⁴

Formal and systematic exploration of TKGRF at WIPO evolved through two parallel, but initially unrelated, developments. One line of inquiry emerged out of growing member interest in examining genetic resources and intellectual property issues in the biotechnology area.²⁶⁵ The other developed independently through a contemporaneous probe into the theoretical legal intersection of intellectual property law and indigenous peoples' traditional knowledge.²⁶⁶

With respect to the former, WIPO first began regularly addressing issues related to intellectual property and genetic resources under an exploratory program called "Biological Diversity and Biotechnology" in 1998–1999.²⁶⁷ In conjunction with the United Nations Environment Program, WIPO commissioned a joint study on the role of intellectual property rights in benefit-sharing related to the use of biological resources and associated traditional knowledge.²⁶⁸ Intellectual property and genetic resources issues also arose simultaneously in the third

GR Overview], <http://www.wipo.int/tk/en/documents/word/ipgr002.doc> (last visited Nov. 12, 2004).

²⁶³ *Id.*

²⁶⁴ *Id.*

²⁶⁵ *Id.* at 2.

²⁶⁶ Erica-Irene A. Daes, Some Observations and Current Developments on the Protection of the Intellectual Property of Indigenous Peoples, Opening Address at the WIPO Roundtable on Intellectual Property and Indigenous Peoples [hereinafter Daes Opening Address] (July 23–24, 1998), available at <http://www.wipo.int/eng/meetings/1998/indip/daes.htm> (last visited Nov. 12, 2004).

²⁶⁷ *Matters Concerning IP*, *supra* note 25, at 2.

²⁶⁸ *WIPO GR Overview*, *supra* note 262.

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session of the Standing Committee on the Law of Patents.²⁶⁹ At this committee's request, WIPO's Working Group on Biotechnology formulated a questionnaire to gather information on genetic resources from member states, and this group subsequently recommended convening a special meeting on these issues for the larger WIPO membership.²⁷⁰ There, members discussed "access to, and *in situ* preservation of, genetic resources" and the relationship of this material to other intellectual property.²⁷¹ Separately, during meetings relating to the Patent Law Treaty in 2000, another clear focus point arose concerning patent formalities specifically associated with genetic resources.²⁷² This evidence of a recurring theme led member states to decide that WIPO needed to begin examining the genetic resources/traditional knowledge area in a more systematic fashion.²⁷³

At about the same time as the early genetic resources examination was starting in 1998, WIPO also began independently examining the field of "traditional knowledge, innovations, and creativity," as it was then called.²⁷⁴ A roundtable discussion was held in Geneva and attended by WIPO member states, numerous representatives from various indigenous peoples' NGOs, and the Rapporteur of the United Nations Working Group on Indigenous Populations.²⁷⁵ During the remainder of that year and the next, WIPO conducted hundreds of interviews in nine fact-finding missions among 28 countries "to identify and explore the intellectual property needs and expectations of new beneficiaries, including the holders of indigenous knowledge and innovations."²⁷⁶

²⁶⁹ See *Matters Concerning IP*, *supra* note 25, at 2.

²⁷⁰ *Id.*

²⁷¹ *Id.*

²⁷² *Id.* at 3.

²⁷³ *Id.*

²⁷⁴ *Id.*

²⁷⁵ Daes Opening Address, *supra* note 266.

²⁷⁶ Annual Report 2000, WIPO, at 34 [hereinafter WIPO Annual Report 2000], http://www.wipo.int/freepublications/en/general/441/wipo_pub_441_2000.pdf (last visited Nov. 12, 2004).

A comprehensive report of the results was published in 2001.²⁷⁷ Among the needs identified were 1) “capacity-building, awareness-raising, and dialogue” on traditional knowledge and IP issues “among indigenous and local communities, government departments,” and other stakeholders; 2) greater use of existing intellectual property rights by indigenous and local communities; and 3) development of new *sui generis* rights for more effective legal protection of traditional knowledge.²⁷⁸

Efforts at WIPO to address the intersection of intellectual property and folkloric expressions predate the inquiries into intellectual property law’s convergence with genetic resources and traditional knowledge.²⁷⁹ In fact, WIPO began exploring intellectual property protection of folklore as far back as 1978, in cooperation with UNESCO.²⁸⁰ The “Model Provisions for National Laws on the Protection of Expressions of Folklore against Exploitation and Other Prejudicial Actions”²⁸¹ were drafted as a result of this joint effort. The majority consensus at WIPO, after four subsequent WIPO-UNESCO joint regional consultations, was that ongoing work was needed, preferably via a new WIPO committee created specifically to explore folklore and traditional knowledge.²⁸²

In 2001, as a result of these three experiences, WIPO created the Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (the

²⁷⁷ *Intellectual Property Needs and Expectations of Traditional Knowledge Holders*, WIPO Report on Fact-Finding Missions on Intellectual Property and Traditional Knowledge (1998–1999) 25 (Apr. 2001), WIPO Publication No. 768(E)(2001), <http://www.wipo.int/tk/en/tk/ffm/report/final/index.html> (last visited Nov. 12, 2004).

²⁷⁸ Annual Report 2001, WIPO, at 38, http://www.wipo.int/freepublications/en/general/441/wipo_pub_441_2001.pdf (last visited Nov. 12, 2004). Interestingly, the first two identified needs closely mirror the recommendations made in 1999 by the USPTO in conjunction with its preliminary study for creation of the Database of Native American Tribal Insignia. See *infra* Part III.D.

²⁷⁹ Traditional cultural expressions are now conceptualized within WIPO as “a subset of traditional knowledge,” despite the fact that examination into folkloric tradition and intellectual property began well before that of traditional knowledge. *Matters Concerning IP*, *supra* note 25, at 3.

²⁸⁰ WIPO Annual Report 2000, *supra* note 276, at 3 n.289, 33–34.

²⁸¹ *Model Provisions*, *supra* note 249.

²⁸² *Matters Concerning IP*, *supra* note 25, at 3.

“IGC”).²⁸³ This created a forum for systematic exploration of these three growing areas of creativity, whose linkages had become increasingly obvious in recent years but were, until then, considered separately in a variety of disparate venues.²⁸⁴ The IGC also provided a means for examining TKGRF from an interdisciplinary intellectual property context, not limited to any single field of intellectual property law.²⁸⁵

The initial mandate from the WIPO General Assembly required the IGC to meet semi-annually for two years, beginning in the spring of 2001.²⁸⁶ It was directed to study and then make recommendations for action to the General Assembly concerning intellectual property issues arising in the context of 1) access and benefit-sharing pertaining to genetic resources; ii) “protection of traditional knowledge, innovations, and creativity, whether or not associated with” any genetic resources; and iii) “protection of expressions of folklore, including handicrafts.”²⁸⁷

Pursuant to this mandate, the IGC completed its first report in July 2003.²⁸⁸ During the course of its work, the IGC accumulated valuable information about the mandated topics, commissioned several fascinating studies relating to TKGRF, and made much of this material freely available to the public.²⁸⁹ This material is an invaluable addition to the scant systematic material that was available just a few years earlier in these areas of law and policy. The IGC not only served as a central collecting point for heretofore scattered or completely unavailable national information on relevant subjects, but the WIPO Secretariat (“Secretariat”) made a

²⁸³ *Id.* at 5.

²⁸⁴ *Id.* at 3.

²⁸⁵ *Id.*

²⁸⁶ *Id.* at 4.

²⁸⁷ *Id.* at 5.

²⁸⁸ *Program Performance Report for the 2002–2003 Biennium*, at 3, WIPO, Assemblies of the Member States of WIPO, A/40/2 (July 23, 2004), http://www.wipo.int/documents/en/document/govbody/wo_gb_ab/pdf/a_40_2.pdf (last visited on Nov. 12, 2004).

²⁸⁹ Voluminous documentation of all meetings of the IGC and supporting material is available on the Internet. See *Traditional Knowledge, Genetic Resources and Folklore*, <http://www.wipo.int/globalissues/igc/documents/index.html> (last visited Nov. 12, 2004).

substantial contribution of its own to TKGRF scholarship in the course of collecting, organizing, and summarizing the material.

Information published by the Secretariat during this time period pertains to the following diverse topics: a composite study on the protection of traditional knowledge (including specific national experiences with and legislation concerning traditional cultural expressions),²⁹⁰ a practical intellectual property management toolkit for communities wishing to document their own traditional knowledge,²⁹¹ reviews of existing intellectual property protection of traditional knowledge in national legislation around the world,²⁹² a study of the necessary elements of a *sui generis* system to protect traditional knowledge and a consolidated summary of national *sui generis* legislation in the folklore area,²⁹³ an electronic database of contractual practices and clauses presently in use relating to genetic resource access and benefit-sharing,²⁹⁴ a technical study of disclosure requirements relating to

²⁹⁰ *Composite Study on the Protection of Traditional Knowledge*, WIPO, Intergovernmental Comm. on Intell. Prop. & Genetic Resources, Trad. Knowledge & Folklore, WIPO/GRTKF/IC/5/8 (Apr. 28, 2003) [hereinafter *Composite Study*], http://www.wipo.int/documents/en/meetings/2003/igc/pdf/grtkf_ic_5_8.pdf (last visited Nov. 12, 2004); see also *Consolidated Analysis*, *supra* note 72; *Presentation on Experiences*, *supra* note 239.

²⁹¹ *Report on the Toolkit for Managing Intellectual Property When Documenting Traditional Knowledge and Genetic Resources*, WIPO, Intergovernmental Comm. on Intell. Prop. & Genetic Resources, Trad. Knowledge & Folklore, WIPO/GRTKF/IC/5/5 (Apr. 1, 2003), http://www.wipo.int/documents/en/meetings/2003/igc/pdf/grtkf_ic_5_5.pdf (last visited Nov. 12, 2004); *Draft Outline of an Intellectual Property Management Toolkit for Documentation of Traditional Knowledge*, WIPO, Intergovernmental Comm. on Intell. Prop. & Genetic Resources, Trad. Knowledge & Folklore, WIPO/GRTKF/IC/4/5 (Oct. 20, 2002), http://www.wipo.int/documents/en/meetings/2002/igc/pdf/grtkf_ic_4_5.pdf (last visited Nov. 12, 2004).

²⁹² *Consolidated Survey of Intellectual Property Protection of Traditional Knowledge*, WIPO, Intergovernmental Comm. on Intell. Prop. & Genetic Resources, Trad. Knowledge & Folklore, WIPO/GRTKF/IC/5/7 (Apr. 4, 2003), http://www.wipo.int/documents/en/meetings/2003/igc/pdf/grtkf_ic_5_7.pdf (last visited Nov. 12, 2004).

²⁹³ *Elements*, *supra* note 6; *Comparative Summary*, *supra* note 24; see also *Composite Study*, *supra* note 290.

²⁹⁴ *Contractual Practices and Clauses Relating to Intellectual Property, Access to Genetic Resources and Benefit-Sharing*, WIPO, Intergovernmental Comm. on Intell. Prop. & Genetic Resources, Trad. Knowledge & Folklore, WIPO/GRTKF/IC/5/9 (Mar. 31, 2003), http://www.wipo.int/documents/en/meetings/2003/igc/pdf/grtkf_ic_5_9.pdf (last visited Nov. 12, 2004); *Report on Electronic Database of Contractual Practices and Clauses Relating to Intellectual Property, Access to Genetic Resources and Benefit-*

genetic resources and traditional knowledge,²⁹⁵ technical proposals for databases and registries for traditional knowledge and biological/genetic resources,²⁹⁶ policy and legal option studies of traditional knowledge and of traditional cultural expressions,²⁹⁷ a study of the international dimension of TKGRF,²⁹⁸ and a catalogue of periodicals and online databases of traditional knowledge.²⁹⁹ The Secretariat effectively used the expertise of personnel possessing the highly specialized legal knowledge required to gather, cull, digest, and process raw TKGRF data into intelligible and systematic documentation, and it continuously updated and made this documentation available for use by national governments, private industry, legal scholars, and members of the public with each successive meeting of the IGC membership. Overall, the IGC seems to have made admirable progress on its information gathering goals.

As required, the IGC reported to the General Assembly in the early autumn of 2003.³⁰⁰ At that time, it reported having acquired

Sharing, WIPO, Intergovernmental Comm. on Intell. Prop. & Genetic Resources, Trad. Knowledge & Folklore, WIPO/GRTKF/IC/4/10 (Oct. 20, 2002) [hereinafter *Report on Electronic Database*], http://www.wipo.int/documents/en/meetings/2002/igc/pdf/grtkf_ic_4_10.pdf (last visited Nov. 12, 2004).

²⁹⁵ *Draft Technical Study on Disclosure Requirements Related to Genetic Resources and Traditional Knowledge*, WIPO, Intergovernmental Comm. on Intell. Prop. & Genetic Resources, Trad. Knowledge & Folklore, WIPO/GRTKF/IC/5/10 (May 2, 2003), http://www.wipo.int/documents/en/meetings/2003/igc/pdf/grtkf_ic_5_10.pdf (last visited Nov. 12, 2004); *Initial Report on the Technical Study on Disclosure Requirements Related to Genetic Resources and Traditional Knowledge*, WIPO/GRTKF/IC/4/11 (Nov. 20, 2002), http://www.wipo.int/documents/en/meetings/2002/igc/pdf/grtkf_ic_4_11.pdf (last visited Nov. 12, 2004).

²⁹⁶ *Technical Proposals*, *supra* note 192.

²⁹⁷ *Revised Policy*, *supra* note 235; *International Dimension*, *supra* note 11.

²⁹⁸ *International Dimension*, *supra* note 11.

²⁹⁹ *Inventory of Traditional Knowledge-Related Periodicals*, WIPO, Intergovernmental Comm. on Intell. Prop. & Genetic Resources, Trad. Knowledge & Folklore, WIPO/GRTKF/IC/3/5 (Apr. 30, 2002), http://www.wipo.int/documents/en/meetings/2002/igc/pdf/grtkf3_5.pdf (last visited Nov. 12, 2004); *Inventory of Existing Online Databases Containing Traditional Knowledge Documentation Data*, WIPO, Intergovernmental Comm. on Intell. Prop. & Genetic Resources, Trad. Knowledge & Folklore, WIPO/GRTKF/IC/3/6 (May 10, 2002), http://www.wipo.int/documents/en/meetings/2002/igc/pdf/grtkf3_6.pdf (last visited Nov. 12, 2004).

³⁰⁰ The report was made to the Thirtieth (16th Ordinary) Session of the WIPO General Assembly, which met in Geneva, Switzerland on Sept. 22–Oct. 1, 2003. *Matters Concerning the Intergovernmental Committee on Intellectual Property and Genetic*

a “strengthened understanding of the policy basis and legal mechanisms for protection” of TKGRF, identified “specific steps to strengthen defensive protection of traditional knowledge and associated genetic resources . . . including the enhanced practical recognition of [traditional knowledge] as prior art in the examination of patents,” developed “capacity building tools for the practical protection” of TKGRF, and prepared a “draft technical study on patent disclosure requirements relating to TKGRF in response to an invitation from the Conference of Parties of the CBD.”³⁰¹ The member states of the IGC were not, however, able to reach internal agreement on recommendations to the General Assembly concerning a potential future mandate to continue their work on TKGRF.³⁰²

Fortunately, however, this lack of consensus did not prevent the General Assembly from recognizing the need to continue this work and approving an extended mandate.³⁰³ The IGC has now been directed to continue its work on an accelerated basis, focusing in particular on the international dimension of TKGRF and intellectual property.³⁰⁴ “The new mandate excludes no outcome for the IGC’s work, including the possible development of an international instrument or instruments in this field.”³⁰⁵ The international community has, thus, clearly recognized the importance of this work. It intends to ensure that the relation of TKGRF to the field of intellectual property law is fully explored and that appropriate legal protections for TKGRF are developed.

Resources, Traditional Knowledge and Folklore, WIPO, General Assembly, WO/GA/30/5 (Aug. 15, 2003) [hereinafter *Report to the General Assembly*], http://www.wipo.int/documents/en/document/govbody/wo_gb_ga/pdf/wo_ga_30_5.pdf (last visited Nov. 12, 2004).

³⁰¹ See *id.* at 2; see also *Convention on Biological Diversity: Disclosure Requirements Concerning Genetic Resources and Traditional Knowledge*, WIPO, General Assembly, WO/GA/30/7 (Aug. 15, 2003), http://www.wipo.int/documents/en/document-/govbody/wo_gb_ga/pdf/wo_ga_30_7.pdf (last visited Nov. 12, 2004).

³⁰² *Report to the General Assembly*, *supra* note 300, at 3.

³⁰³ See Press Release, WIPO, WIPO Member States Agree to Fast-Track Work on Traditional Knowledge (Sept. 29, 2003), <http://www.wipo.int/pressroom-/en/releases/2003/p362.htm> (last visited Oct. 9, 2004).

³⁰⁴ See *id.*

³⁰⁵ See *id.*

This is truly encouraging. Future work by WIPO, however, would benefit from certain structural changes concerning direct participation in the work by indigenous peoples and other private parties. Currently, work is necessarily constrained to reflect the interests and policy goals of national governments, which in many cases may not reflect the interests of indigenous people. One of the problems the IGC has faced in its work on TKGRF is that WIPO's organizational structure is not conducive to participation by non-state actors.³⁰⁶ This means that valuable input from members of local and indigenous communities, NGOs, private enterprise, and academic institutions and faculty has been somewhat limited. As a specialized UN agency, WIPO carries out its work via a general assembly of national government representatives from its member states.³⁰⁷ The IGC, consisting also of member state officials, meets in its own assembly and, like other WIPO bodies, allows "relevant intergovernmental organizations and accredited international and regional non-governmental organizations . . . to participate in an observer capacity."³⁰⁸ WIPO has an accreditation procedure through which intergovernmental and nongovernmental organizations may apply for observer status, but individuals may not be accredited.³⁰⁹ The IGC has its own "fast-track" accreditation process, whereby an organization, but not individuals, may be allowed to observe the IGC meetings.³¹⁰

Unfortunately, even the IGC "fast-track" accreditation process is both time-consuming and cumbersome. An applicant organization must file a form describing its organizational mission and projects, including a written statement of the specific relevance

³⁰⁶ *Report to the General Assembly*, *supra* note 300, at 3.

³⁰⁷ *See Convention Establishing the World Intellectual Property Organization* (July 14, 1967, amended Sept. 28, 1979) arts. 5–6, <http://www.wipo.int/clea/docs/en/wo/wo029en.htm> (last visited Nov. 12, 2004).

³⁰⁸ *See Matters Concerning IP*, *supra* note 25, at 4.

³⁰⁹ *See generally* WIPO, Member States, *Criteria for Admission as Permanent Observer with WIPO*, at <http://www.wipo.int/about-wipo/en/members/admission/> (last visited Nov. 12, 2004).

³¹⁰ *See* Application Form for Accreditation as Ad Hoc Observer to the WIPO Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (documents available on request from the WIPO Secretariat and on file with author).

of intellectual property to its work, after which the Secretariat staff vets the application.³¹¹ Once the organization's qualifications are initially verified and approved by the Secretariat, member states vote on whether or not to grant the organization accreditation and admit it as an observer.³¹² Since the vote on new applicants is held in Geneva at the opening of each IGC session, an organization awaiting accreditation cannot, theoretically, determine in advance of the opening of the session whether its representatives will be admitted. Thus, long lead times can thus be required for a non-state actor to: 1) learn about the existence and work of the IGC, 2) submit a written application, 3) determine whether the application has been pre-approved by the Secretariat, 4) determine after the start of the session whether or not the accrediting vote has been cast in its favor, and 5) send its representatives to Geneva for the remainder of that session and following sessions. Of course, an organization can gamble that it will succeed in being accredited and can appear on-site at the start of the session (though it will be denied entry if approval is not granted), or it can merely wait to participate until the next session following its approval. Neither of these alternatives seems particularly satisfactory, however, for organizations or indigenous communities that have limited financial resources and desire immediate collaboration with other IGC participants.

The accreditation voting mechanism would theoretically allow member states to block observation by any politically unpopular or otherwise "undesirable" organization. While this does not appear to have been a major problem to date, the IGC's work is clearly becoming more politicized and is only now becoming moderately known outside official government circles. Whether groups such as the Tibetan government-in-exile or activist groups identified with politically sensitive issues will be widely allowed to

³¹¹ *Id.*

³¹² See *Draft Agenda*, WIPO, Intergovernmental Comm. on Intell. Prop. & Genetic Resources, Trad. Knowledge & Folklore, WIPO/GRTKF/IC/6/1 Prov. (Dec. 1, 2003), http://www.wipo.org/documents/en/meetings/2004/igc/pdf/grtkf_ic_6_1prov.pdf (last visited Nov. 12, 2004). This document from a recent session provides a typical example of the first part of any session agenda. After formal opening of the session, election of the chair, and adoption of the prepared agenda, the Members address accreditation of nongovernmental organizations.

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participate remains unknown. Also, since many indigenous communities tend to be politically marginalized or even actively repressed by their national governments, the accreditation procedure could potentially become a highly selective filter of participants, information, and dissent as the debate unfolds. It would be most unfortunate if this were to occur, since it would, ultimately, call into question the legitimacy and viability of proposed TKGRF protections. Unless such protections are based in meaningful participation by, and recognition of, a representative cross-section of indigenous stakeholders and their concerns, rights, values, and jurisprudential perspectives, proposed legal solutions are unlikely to produce the desired results.

Although the occasional indigenous representative is invited by its national delegation to participate at the meetings, and although with each subsequent meeting of the IGC increasing numbers of indigenous NGOs apply for observer accreditation, a more immediate flaw in the IGC's work to date is that relatively few indigenous people have been directly involved in the discussions.³¹³ Since indigenous communities are often among the most socially marginalized and least politically powerful groups in their own countries, they frequently do not have any real voice in official national position statements presented by their governments at WIPO—or even at their own national legislatures—on the matters affecting them most directly.³¹⁴ Also, indigenous groups interested in participating often lack the financial means to do so, since IGC meetings are held in Geneva, Switzerland.³¹⁵

³¹³ See *Report to the General Assembly*, *supra* note 300, at 3.

³¹⁴ A discussion at the 4th IGC in December 2002 illustrates this problem. During one question and answer session, a member of an NGO organization representing the interests of various Berber tribes in North Africa asked a Tunisian government delegate why there are no specific protections for Berber culture in Tunisia. The government delegate replied that there is no reason for Tunisian law to provide such protection, since, he said, Tunisia has no indigenous minorities. Statement of delegate from Tunisia, *Exposé sur la Protection des Expressions Culturelles Traditionnelles en Tunisie*, 4th WIPO IGC, Dec. 10, 2003 (on file with author).

³¹⁵ Telephone Interview with Maxine Hillary, Legislative Assistant, Navajo Nation (Jan. 29, 2003) [hereinafter Hillary Interview] (on file with author).

In fact, this conspicuous absence of indigenous TKGRF owners from discussions involving their interests has been a pervasive problem in most international discussion forums, not just at the IGC. Lack of input from indigenous communities is probably the largest current obstacle to progress in the search for TKGRF protection in any international forum, with the possible exception of the UN Working Group. Thus, in the main, decision-making that may have far-reaching implications is currently being led by actors who, however intelligent and well-intentioned, are unlikely to have an accurate sense of the true characteristics of the material at issue or of the cultural and customary legal context of that material within the relevant indigenous societies.

Without this dual awareness, attempts to fashion TKGRF protection, both against and within industrialized societies, can only result in ineffective and inappropriate solutions. The best way to optimize the search for TKGRF protection is to ensure that a meaningful cross-section of stakeholders from all interest groups participates in equal partnership in all phases of the exploration and solution-seeking process.

Successive U.S. delegations to the IGC have suffered from the same near-absence of indigenous members as have other national delegations. Tribal members and some United States government representatives agree that direct involvement of indigenous people in intellectual property discussions has been extremely limited.³¹⁶ Some representatives of Native American groups have voiced frustration that they do not have a realistic avenue for participating in the discussions at WIPO or in similar discussions at other international and regional forums.³¹⁷ Many tribes in the Southwest were not aware of the WIPO conferences until recently.³¹⁸ Even

³¹⁶ Hillary Interview, *supra* note 315; Hardison Interview, *supra* note 231; Telephone Interview with Eric Wilson, Deputy Director for the Office of American Indian Tribes, U.S. Department of the Interior, Mar. 13, 2003 [hereinafter Wilson Interview 2003] (on file with author); *see also* USPTO, Report on the Official Insignia of Native American Tribes (Sept. 30, 1999) [hereinafter USPTO Report], at 14, 44. That study notes that, in 1994, it sent out letters to more than 500 federally recognized tribes concerning its interest in compiling a list of official tribal insignia, but only received about ten answers. *Id.* The study itself was compiled on the basis of only thirty-six responses. *Id.*

³¹⁷ Hillary Interview, *supra* note 315.

³¹⁸ *Id.*; Hardison Interview, *supra* note 231; Wilson Interview 2003, *supra* note 316.

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for those who wish to participate in the international dialogue, it can be hard to find tribal funds for everyday needs, much less to send representatives to meetings in other parts of the world.³¹⁹

The IGC has recognized this shortcoming in its work, and the recent report to the General Assembly reflects the IGC's concern.³²⁰ WIPO has already begun to take concrete steps to solve this problem, responding in part by holding a series of regional discussions and intellectual property education meetings at various locations around the globe in 2002 and 2003, which generated "a significant contribution" to the IGC's work.³²¹ In December 2002, the IGC requested that the Secretariat prepare a report addressing formalized participation of indigenous and local community representatives.³²² The issue was also included in the formal agenda for the 5th session of the IGC in July 2003,³²³ and the requested report was published at the end of March 2003.³²⁴ This report discusses various alternatives for direct and indirect funding of indigenous and local community representatives to attend IGC meetings, together with various mechanisms for choosing such representatives.³²⁵

Unfortunately, present consensus among the IGC membership is that national government members should determine which indigenous groups receive funding, and present accreditation constraints are to remain in place.³²⁶ Evidently, no real progress has been made on this issue to date.

Other international forums have also been attempting to include more indigenous and NGO groups in their TKGRF discussions. Among those actively seeking indigenous input are

³¹⁹ Hillary Interview, *supra* note 315.

³²⁰ *Report to the General Assembly*, *supra* note 300, at 3.

³²¹ See *Global Intellectual Property Issues*, at http://www.wipo.int/aspac/en/activities/global_ip.htm (last visited Nov. 12, 2004).

³²² See *Report*, *supra* note 68.

³²³ See *id.*

³²⁴ See *Participation of Indigenous and Local Communities*, WIPO, Intergovernmental Comm. on Intell. Prop. & Genetic Resources, Trad. Knowledge & Folklore, WIPO/GRTKF/IC/5/11 (Mar. 28, 2003), http://www.wipo.int/documents/en/meetings/2003/igc/pdf/grtkf_ic_5_11.pdf (last visited Nov. 12, 2004).

³²⁵ *Id.* at 12, 14–15.

³²⁶ See generally *id.*

the FAO, the CBD membership, the United Nations Committee on Trade and Development (“UNCTAD”), and the OAS.³²⁷

The OAS is making significant headway toward meaningful indigenous participation. In February 2003, numerous indigenous representatives attended a working session in Washington, D.C. on the Draft American Declaration on the Rights of Indigenous Peoples (“OAS Draft Declaration”).³²⁸ This document contains a provision specifically devoted to the intellectual property rights of indigenous people.³²⁹ To increase indigenous participation in that meeting, the OAS established a voluntary member donor fund for travel expenses of indigenous representatives.³³⁰ Also, in contrast to WIPO, the OAS Draft Declaration working meetings are open to the public, so there is no need to obtain prior approval to attend and any group or individual may participate in these working sessions. Thanks to widespread participation of indigenous groups at the February 2003 meeting, floor discussion was lively, and differing perceptions about TKGRF and Western forms of intellectual property were clearly evidenced.

Through the TKGRF debate at WIPO and elsewhere, substantive intellectual property law is being simultaneously considered and conceptualized as much on the international level as at the national level. Given the lack of consensus at WIPO, international development and implementation of TKGRF

³²⁷ See, e.g., Press Release, Food and Agriculture Organization of the United Nations, *Indigenous Knowledge—A Key Weapon in Fighting HIV/AIDS* (Nov. 29, 2001), <http://www.fao.org/News/2001/011108-e.htm>; Convention on Biological Diversity, *Access to Genetic Resources and Benefit-Sharing*, at <http://www.biodiv.org/programmes-/socio-eco/benefit/project.aspx?id=8030> (last visited Nov. 12, 2004); Press Release, United Nations Conference on Trade and Development, *New Avenues Needed to Protect Traditional Knowledge, Urge Experts at UNCTAD Meeting*, <http://www.unctad.org/Templates/webflyer.asp?docid=2670&intItemID=2023&lang=1> (last visited Mar. 11, 2000); U.S. Dep’t of State, *Resolution on the Specific Fund to Support the Elaboration of the American Declaration on the Rights of Indigenous Peoples*, CP/RES. 817 (1319/02) [hereinafter *Fund Resolution*], <http://www.state.gov/p/wha/rt/oas/20822.htm> (last visited Nov. 12, 2004).

³²⁸ See generally Proposed American Declaration on the Rights of Indigenous Peoples (approved by the Inter-American Commission on Human Rights on February 26, 1997, at its 1333rd session, 95th Regular Session), OEA/Ser/L/V/II.95 Doc.6 (1997), http://www.oas.org/juridico/english/ga03/agres_1919.htm (last visited Nov. 12, 2004).

³²⁹ See *id.*

³³⁰ See *Fund Resolution*, *supra* note 327.

protection would be more likely to advance through international discussions concerning best practices in TKGRF and other “soft” law sources, such as nonbinding international guidelines, rather than through binding and enforceable international instruments. But passage and implementation of substantive national legislation in TKGRF seems to be receiving much of its impetus and substance from the formal international discussions and interactions in these various forums.

This is remarkable, since, prior to TRIPS in 1995, substantive intellectual property law was strictly a creature of national law.³³¹ With the exception of the establishment of the dispute resolution mechanism, even TRIPS is aimed mainly at harmonizing member laws to standards already developed domestically in industrialized countries. The emerging law of TKGRF, on the other hand, is perhaps the first substantive area of intellectual property law to be developed in its definitions, use, management, and regulation from a uniquely international platform. Substantive and procedural TKGRF law is now being forged internationally, through cooperative conceptualization, collective observation, review, and analysis of national legislative experiments, and continuing joint international efforts to reach consensus.

B. The U.S. Policy Position

The official U.S. policy position advanced at WIPO is essentially this: legal treatment of TKGRF should be determined by each country under its national legislation and in accordance with its own sovereignty and laws, rather than determined by treaty or other international mechanism, and TKGRF should preferably be regulated within traditional regimes of intellectual property and other established bodies of law.³³² This national treatment should, according to the U.S., be supplemented by a contract-based access

³³¹ See TRIPS Agreement, *supra* note 94, art. 64.

³³² Lourie Statements, *supra* note 212. This was the policy position of the U.S. at the time of the author’s first attendance at the 4th IGC in December 2002, and it did not appear to have changed appreciably at the time of the author’s most recent attendance in March 2004.

and benefit-sharing system that includes periodic reporting.³³³ Dismissing the potential need for either *sui generis* laws or international treaty regulation for TKGRF, United States officials at international forums point to existing domestic U.S. laws,³³⁴ policy,³³⁵ and contract practices³³⁶ as sufficient and meaningful, or even model,³³⁷ protections for TKGRF and indigenous owners.³³⁸

In the opinion of U.S. officials, it is premature, and perhaps unnecessary altogether, to establish *sui generis* laws for TKGRF.³³⁹ Protections available under established intellectual property laws should first be fully examined, as well as the potential effects that proposed *sui generis* laws might have on other laws already in place.³⁴⁰ The limited case law in TKGRF should also be very carefully considered, with an eye toward minimizing disruption and conflict among existing laws.³⁴¹ The U.S. believes, correctly, that for contracting parties, potential litigants, and the judiciary, predictability is crucial to effective functioning of the international legal system, and radical departures from laws that have been developed and tested over time are likely to result in unforeseen problems and dislocations.³⁴²

³³³ Linda Lourie, letter to the editor, *LEGAL TIMES*, Apr. 21, 2003 [hereinafter Lourie Letter] (responding to Nancy Kremers, *Stolen Legacy: Indigenous Peoples Push to Protect their Traditional Knowledge, Genetic Resources, and Folklore*, *LEGAL TIMES*, Mar. 24, 2003); E-mail from Ruth Ann Nyblod, Deputy Press Secretary, USPTO (Apr. 9, 2003) (on file with author).

³³⁴ Lourie Statements, *supra* note 212 (referencing the Indian Arts and Crafts Act of 1990 (25 U.S.C. § 305 (2003)), the USPTO Database of Native American Tribal Insignia, and U.S. intellectual property laws); *see also infra* Part III.

³³⁵ Application Procedures and Requirements for Scientific Research and Collecting Permits, Nat'l Parks Service, U.S. Dep't of the Interior (Jan. 2002) [hereinafter National Parks Service Application], available at <http://www.nps.gov/grca/research/ApplicationGuidelines.pdf>; *see* POSEY & DUTFIELD, *supra* note 27, at 71; BIODIVERSITY AND TRADITIONAL KNOWLEDGE, *supra* note 83, at 316.

³³⁶ POSEY & DUTFIELD, *supra* note 27, at 71.

³³⁷ National Parks Service Application, *supra* note 335; *see Report on Electronic Database*, *supra* note 294, at 9 (Model Memorandum of Understanding between the Developmental Therapeutics Program Division of Cancer Treatment and Diagnosis, National Cancer Institute).

³³⁸ Lourie Statements, *supra* note 212.

³³⁹ *Id.*

³⁴⁰ *Id.*

³⁴¹ *Id.*

³⁴² *Id.*

The U.S. also advocates that as much TKGRF as possible should be placed in searchable databases and made accessible to patent examiners.³⁴³ This, U.S. policymakers say, would both lessen the likelihood of issuing patents improperly based on others' prior knowledge and diminish current objections to USPTO novelty determinations, which are based purely on a "printed material" prior art standard.³⁴⁴

While a cautious approach to any new area of law is understandable, the official position of the United States on TKGRF is at odds with many of the concerns voiced in the international community.³⁴⁵ Unquestionably, tact and diplomacy skills vary among individual U.S. officials, and perhaps the current administration's foreign policy style allows its delegates in the various international forums to take greater attitudinal liberties than at some earlier time. Even allowing for this possibility, though, U.S. spokespeople in the TKGRF debate often come across to others as nationalistic, obstructionist, and myopic.³⁴⁶ While this surely is the result of an interplay of many complex factors, most foreign delegates to the IGC seem to believe that U.S. trade protectionism and the USPTO's own interest in maintaining high revenues from its corporate clients are important motivating forces behind current U.S. TKGRF policy.³⁴⁷

Extensive examination of U.S. trade policy and empirical analysis of the composition of paying clients for patents and trademarks are topics outside the scope of this Article. But it is hard to ignore the clear harmony between the U.S. TKGRF legal policy articulated at WIPO and the industrial and trade interests of the U.S. American TKGRF policy at present is curiously consonant with continued U.S. protectionism, with its enormous farm subsidies, with corporate interests in maintaining private contractual control over transgenic plant research and

³⁴³ See Lourie Interview, *supra* note 195; Lourie Letter, *supra* note 333.

³⁴⁴ 35 U.S.C. § 102 (2004).

³⁴⁵ See generally Weerawit Weeraworawit, *Formulating an International Legal Protection for Genetic Resources, Traditional Knowledge and Folklore: Challenges for the Intellectual Property System*, 11 CARDOZO J. INT'L. & COMP. L. 769 (Summer 2003).

³⁴⁶ These opinions are based on numerous background conversations between the author and a variety of Member State representatives at the 4th and 6th IGCs.

³⁴⁷ See *supra* note 346.

commercialization, and with the predominance of large corporate patent and trademark holdings throughout the U.S. pharmaceutical, dietary supplement, and personal care products industries.³⁴⁸ It would not be surprising if the USPTO, in particular, were influenced or biased to some degree in its TKGRF policy position, since the bulk of patent and trademark examination fees come from corporate clients, and those fees directly subsidize the operation of the USPTO, unlike many other national patent offices.³⁴⁹

Despite its preeminent position at global TKGRF talks, the USPTO is only one of a number of U.S. government bodies regularly participating in TKGRF discussions. The Department of State, the Department of the Interior, the Copyright Office, and the American Folklife Center of the Library of Congress, also regularly appear on U.S. delegations abroad to discuss TKGRF issues. USPTO representatives, however, tend to be the *de facto* lead U.S. spokespeople on TKGRF matters, ostensibly because so many of the points currently at issue in TKGRF involve intellectual property law.³⁵⁰ According to fellow U.S. delegates, USPTO officials also often take the lead in organizing interagency preparatory meetings, in an effort to “harmonize” a uniform internal government stance prior to attending international conferences.³⁵¹

Unfortunately, for many reasons, USPTO leadership of the U.S. delegations tends to cast doubt on the validity and impartiality of all U.S. agencies in the TKGRF debate.³⁵² This is due to some of the USPTO’s internal practices and to the obvious conflict of interest between the USPTO’s paying clientele and its duty to the

³⁴⁸ Stevan M. Pepa, *International Trade and Emerging Genetic Regulatory Regimes*, 29 LAW & POL’Y INT’L BUS. 415 (1998).

³⁴⁹ See Letter from Hon. Q. Todd Dickinson, Under Secretary of Commerce for Intell. Prop., to Hon. Howard Coble, Chairman & Hon. Howard Berman, House Subcomm. on Courts & Intell. Prop. (June 9, 2000); see also Statement of Fédération Internationale des Conseils en Propriété Industrielle (June 12, 2000) (submitted to the USPTO in regard to Proposed Fee Legislation, pursuant to FICPI Resolution on Official Surpluses in Intellectual Property Offices).

³⁵⁰ See Coombe, *Recognition*, *supra* note 110.

³⁵¹ See *id.*

³⁵² See *id.*

larger public interest of the American people.³⁵³ As one highly respected legal scholar recently wrote, it is commonly recognized in the world intellectual property community that there are great shortcomings in the practices and procedures of the USPTO that need to be addressed before its stance on traditional knowledge appropriation will be considered seriously.³⁵⁴ According to this scholar, the U.S. intellectual property regime has been brought into widespread disrepute by the USPTO practices that: (1) create internal incentive structures to reward examiners financially for granting patents and penalize them for conscientious prior art examination, (2) narrowly restrict the forms of prior art that can be considered during the search process, and (3) lack an affirmative obligation to respect the public interest.³⁵⁵ Moreover, the United States has not endeared itself to the international community through its dogmatic position against requiring patent application source disclosure; though the articulated conflict with TRIPS is technically correct, the United States refuses to consider amending the TRIPS agreement to require TKGRF-related disclosure.³⁵⁶

With USPTO leadership of many delegations, it is not surprising that the U.S. consistently has advocated using only national legislation and private contracting to regulate TKGRF.³⁵⁷ It is unclear just what the proposed attendant “periodic reporting requirements” might entail. Nor do U.S. TKGRF policy statements support the otherwise adamant international call for greater transparency in patent applications and examining procedures, not just in the U.S., but in patent offices around the world.

In light of U.S. enthusiasm for decentralized TKGRF regulation and the United States’ longtime failure to ratify the CBD, it also seems unlikely that the United States would be willing to adhere to the national clearinghouse structure espoused by the CBD membership for verifying benefit-sharing and prior

³⁵³ *See id.*

³⁵⁴ *Id.* at 281.

³⁵⁵ *Id.*

³⁵⁶ *See generally* Pires de Carvalho, *supra* note 213.

³⁵⁷ *See supra* notes 332–38 and accompanying text.

informed consent issues in TKGRF-related contracts.³⁵⁸ Nor is it clear whether the USPTO, some other government agency, or the contracting parties themselves would have the main responsibility for self-monitoring and reporting, thus meeting “quasi-CBD” responsibilities. The latter option would seem to be particularly ill-advised, because of the clear inequalities in access to information and in bargaining power between the parties in TKGRF situations. Where an indigenous community independently is faced with negotiating its own contract with a multinational corporate entity, the specific details of proposed reporting requirements would be crucial in determining whether the proposed contracts-based model would be likely to substantively improve present practices.

A recent USPTO spokesperson to the WIPO IGC has voiced the belief that the TKGRF controversy is more about human rights and self-determination than about intellectual property or the patent system.³⁵⁹ In her view, countries wanting to fix perceived patent problems in TKGRF protections may be ignoring presently available legal mechanisms that already provide effective legal protection in the patent field, specifically the reexamination procedure available in the USPTO.³⁶⁰ This procedure provides that any person at any time may, upon payment of a fee, file a request for reexamination of any claim of a patent on the basis of prior art consisting of other patents or printed publications having a bearing on the patentability of any claim of the patent at issue.³⁶¹ If the filing presents a substantial, new question of patentability affecting any claim in the patent, re-examination will be ordered.³⁶² In addition, anyone may anonymously provide the USPTO with written evidence of other patents or of written publications that may bear on the patentability of any patent claim, and this information becomes part of the official patent file.³⁶³ Presumably,

³⁵⁸ Bonn Guidelines, Convention on Biological Diversity, Decision VII/19, *Access and Benefit-Sharing as Related to Genetic Resources*, Feb. 2004, <http://www.biodiv.org-/decisions/?m=cop-07>.

³⁵⁹ Lourie Interview, *supra* note 343.

³⁶⁰ *Id.*

³⁶¹ 35 U.S.C. § 302 (2004).

³⁶² 35 U.S.C. § 304 (2004).

³⁶³ 35 U.S.C. § 301 (2004).

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such evidence can be submitted prior to issuance and will be considered by the examiner.

The USPTO believes these available mechanisms make the U.S. patent system “self-correcting” if any errors are made in patent examination and issuance, including in the TKGRF context.³⁶⁴ But while it is true that these procedural mechanisms exist, they place significant burdens on the potential victims of patenting abuses to continuously monitor national patent filing systems for early detection of pirated inventions, to pay possibly substantial fees if large numbers of improper applications have indeed already been filed and patents issued, and to pay high attorney fees for proper submission of prior art citation explanations and reexamination requests. It is ludicrous to imagine that many of the least educated, and most poverty-stricken communities in the world even have access to this information, much less the sophistication and financial resources to undertake continuous surveillance and monitoring. Advocating such an avenue as a realistic approach to protection is merely one more reason why the USPTO currently lacks international credibility in the TKGRF debate.

Another USPTO view often chided by the global community is that improperly granted patents in the TKGRF area to date have occurred mainly due to examiners’ lack of access to foreign information, rather than because of any real defects in the examination system itself. Official USPTO agency wisdom also holds that few indigenous groups could ever hope to make any real money from patents based on TKGRF, because the percentage of patented inventions, particularly in the pharmaceutical area, that are ever successfully commercialized is extremely low.³⁶⁵ If third party assessments of the large numbers of improperly granted U.S. patents in the TKGRF area are correct,³⁶⁶ however, there would presumably also be a concomitant increase in the estimated number of patents that have been successfully commercialized without attribution to, or benefit-sharing with, the traditional knowledge holders.

³⁶⁴ Lourie Letter, *supra* note 333.

³⁶⁵ *Cf.* BIODIVERSITY AND TRADITIONAL KNOWLEDGE, *supra* note 83, at 249.

³⁶⁶ Gupta, *supra* note 227.

One key feature of U.S. official statements about domestic protection of TKGRF is the presumption that, under U.S. law, all persons, whether indigenous or otherwise, already have a universal right to equal access to all of the protections afforded by federal patent, trademark, and copyright laws, as well as to any rights that may be available under applicable state trade secret, trademark, and unfair competition laws.³⁶⁷ It would be both unconstitutional and against international treaty obligations, the USPTO has opined (most recently at the IGC, but also in a study of its own), to grant to indigenous U.S. populations any special intellectual property protections that are not available to other U.S. citizens.³⁶⁸

While this concept may be true in the general sense, race-based discrimination, which would presumably present the gravest constitutional challenge to any legislation along these lines, has been found to be constitutional in many other situations.³⁶⁹ So long as the allegedly discriminatory policy or law survives a judicial strict scrutiny test—that is, so long as the law in question serves a compelling state interest and is narrowly tailored to achieve that interest—it may be likely to survive a constitutional challenge on equal protection grounds.³⁷⁰ Particularized intellectual property protection for indigenous U.S. TKGRF, which constitutes a priceless part of U.S. heritage and much of which is indisputably bound for extinction unless it rapidly receives better protection, could likely meet a constitutional challenge of this type. Under the proper factual conditions and with proper drafting, protective TKGRF laws conceivably could be shown to conform to various other legitimacy factors used by the U.S. Supreme Court in racial discrimination cases, including the righting of past wrongs caused by prior governmental discrimination.³⁷¹

The constitutional aspects of TKGRF legal protection deserve full study before dismissing this approach out of hand as a policy and legal option. Unfortunately, this has apparently not been done to date. U.S. officials' tendency to eliminate the option of

³⁶⁷ Lourie Statements, *supra* note 212.

³⁶⁸ *Id.*; USPTO Report, *supra* note 316 (also discussed in detail in Part III.D, *infra*).

³⁶⁹ *Grutter v. Bollinger*, 539 U.S. 306 (2003); *Gratz v. Bollinger*, 539 U.S. 244 (2003).

³⁷⁰ *Grutter*, 539 U.S. at 326.

³⁷¹ *Grutter*, 539 U.S. at 328.

specialized protection laws is premature and simplistic thinking, and it is inconsistent with such presently existing, ethnically-oriented protective laws as the Indian Arts and Crafts Act (“IACA”)³⁷² and the Native American Graves Protection and Repatriation Act.³⁷³ The unconstitutionality of ethnic-based protections is probably not nearly as settled as present official spokespeople imply. More importantly, this dismissive attitude may preempt creative thinking about a potential workable avenue for protecting TKGRF within the already-established domestic intellectual property law regime.

The U.S. government claims that all United States citizens have equal access to intellectual property law protection. Certainly, indigenous artists face the same difficulties as other artists in terms of their limited access to legal counsel, financial hardship, and unequal bargaining power with potential purchasers of creative material.³⁷⁴ But indigenous communities in the United States suffer from lower education levels and more pronounced poverty than most other United States citizens, as well as greater social and political marginalization.³⁷⁵ The official position completely fails to acknowledge the vast gulf between the financial, cultural, educational, political, and social opportunities available to a middle-class white male Silicon Valley inventor seeking a patent and those realistically available to a poor female Native American rug weaver living on a remote plot of reservation land. These unacknowledged differences and practical inequalities force the conclusion that much of current U.S. official policy on TKGRF is both unworkable and unrealistic.

Another aspect of U.S. official policy that is somewhat misleading and inaccurate is the apparent government belief that many of the TKGRF legal problems faced by indigenous peoples outside the United States do not exist for domestic Native

³⁷² Pub. L. No. 101-644, 104 Stat. 4662 (1990) (codified as amended in scattered sections of 18 U.S.C., 20 U.S.C., 25 U.S.C., 42 U.S.C.).

³⁷³ 25 U.S.C. §§ 3001–13 (2004) (“NAGPRA”).

³⁷⁴ See generally Leanne M. Fecteau, *The Ayahuasca Patent Revocation: Raising Questions about Current U.S. Patent Policy*, 21 B.C. THIRD WORLD L.J. 69 (2001).

³⁷⁵ See generally Richard Guest, *Intellectual Property Rights and Native American Tribes*, 20 AM. INDIAN L. REV. 111 (1995–96).

Americans or Eskimo and Aleut populations. Federal officials point out that Native Americans own their own land and are viewed as sovereign nations within the U.S. legal system.³⁷⁶ This, they say, gives Native Americans the ability to control access to and use of their traditional knowledge and cultural expressions in a way that many foreign indigenous groups cannot.³⁷⁷ While these statements may be true for many indigenous U.S. groups, control over land access alone does not ensure proper legal protection for indigenous TKGRF.³⁷⁸ Control over land has little effect on bargaining power inequalities between indigenous communities and multinational corporations, and on the enormous differential between them with respect to education and access to legal support and financial opportunities.³⁷⁹

Spokespeople for domestic indigenous communities say they experience many of the same difficulties in protecting their TKGRF as do indigenous people outside the United States.³⁸⁰ While the few federal laws passed in the 1990s to protect Native American cultural artifacts,³⁸¹ to encourage Indian arts and crafts marketing,³⁸² and to create a reference tribal insignia database for

³⁷⁶ Lourie Interview, *supra* note 343; Wilson Interview 2002, *supra* note 84.

³⁷⁷ Lourie Interview, *supra* note 343; Wilson Interview 2002, *supra* note 84.

³⁷⁸ See Chetan Gulati, *The "Tragedy of the Commons" in Plant Genetic Resources: The Need for a New International Regime Centered around an International Biotechnology Patent Office*, 4 YALE HUM. RTS. & DEV. L.J. 63 (2001).

³⁷⁹ See *id.*

³⁸⁰ Hillary Interview, *supra* note 315. Ms. Hillary expresses the Navajos' concern about non-tribal copying of Navajo weavings and silver jewelry, and acknowledges that Navajos need to find more effective ways to protect themselves by using the present legal system. But she insists—as do many indigenous representatives—that the far greater problem lies in the fact that the non-indigenous world does not understand that much indigenous cultural expression is inextricably linked to the spiritual and sacred aspects of life and to nature. This is part of the reason the Navajos do not want certain TKGRF available at all to outsiders. Ms. Hillary cites as an example the propensity among non-Navajo people to use terms such as “myth” or “dance” for certain Navajo cultural expressions, but, she explains, these actually have far deeper meaning within Navajo society than the English terms “myth” or “dance” or the activities those terms describe in Western culture. She points out that the Navajo people, in a comparable reverse situation, do not generally presume to refer to the Bible as a “myth.”

³⁸¹ IACA, Pub. L. No. 101-644, 104 Stat. 4662 (1990) (codified as amended in scattered sections of 18 U.S.C., 20 U.S.C., 25 U.S.C., 42 U.S.C.).

³⁸² *Id.*

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trademark examiners³⁸³ are useful, they do not provide widespread legal protection for indigenous U.S. TKGRF.³⁸⁴ Nor do these laws address any of the larger philosophical and legal questions that remain unanswered at the IGC.³⁸⁵ Yet U.S. government officials at WIPO and the OAS have represented these laws to be particularly meaningful intellectual property protections, specifically reflecting a U.S. policy interest in protecting domestic TKGRF.³⁸⁶ The USPTO, however, has formally acknowledged that laws currently protecting indigenous U.S. creations are not widely known domestically—to indigenous people or to anyone else—and considerable educational effort is needed before these laws can be considered effective.³⁸⁷

In contrast to the rest of the world, the U.S. is discussing TKGRF issues only in a scattered and piecemeal fashion, if at all. Just as WIPO's rather rigid organizational structure has influenced international activity on TKGRF, U.S. governmental attitudes and its laissez-faire policy position influence domestic perceptions about the relative importance (or, perhaps more accurately, unimportance) of TKGRF issues. Consequently, the level of general awareness in the U.S. about TKGRF issues is much lower than abroad. Additionally, because many of the member states at WIPO are developing countries that increasingly perceive their TKGRF to be a significant national resource, their interest in the topic is far greater than the United States'. As U.S. public consciousness is raised, however—and especially as awareness of these issues increases among domestic indigenous communities—U.S. thinking will evolve. Widespread acceptance of many ideas

³⁸³ 25 U.S.C. §§ 3001–13 et seq. (2004).

³⁸⁴ See Guest, *supra* note 375.

³⁸⁵ See *id.*

³⁸⁶ *Questionnaire on National Experiences with the Legal Protection of Expressions of Folklore*, WIPO, Intergovernmental Comm. on Intell. Prop. & Genetic Resources, Trad. Knowledge & Folklore, WIPO/GRTKF/IC/2/7 (June 22, 2001), <http://www.wipo.int/tk/en/questionnaires/ic-2-7/index.html> (last visited Nov. 14, 2004); *Questionnaire on National Experiences with the Legal Protection of Expressions of Folklore: Response of the United States of America*, WIPO, <http://www.wipo.int/tk/en/questionnaires/ic-2-7/usa.pdf> (last visited Nov. 14, 2004) [hereinafter *Questionnaire Response*]; see also U.S. OAS Statement, *supra* note 16.

³⁸⁷ USPTO Report, *supra* note 316, at 46.

that are currently anathema to domestic stakeholders, particularly government officials, is then likely to follow.

III. THE ADEQUACY OF EXISTING U.S. LAWS FOR PROTECTING TKGRF

A. *The Indian Arts and Crafts Act of 1990*

The IACA³⁸⁸ is the provision of U.S. domestic law most frequently cited at international forums by U.S. officials as evidence of the great interest U.S. policymakers and legislators have in protecting the TKGRF of Native Americans and other domestic indigenous groups.³⁸⁹ IACA, its technical amendments that were passed a decade later,³⁹⁰ and its associated implementing regulations³⁹¹ are the main sources of law relating to the Indian arts and crafts portion of indigenous U.S. TKGRF.

To effectively evaluate IACA's usefulness in protecting TKGRF, we must consider a number of interrelated factors: 1) the statutory language and administrative framework, 2) the makeup and activities of the government board charged with implementing IACA, 3) actual implementation of the law, 4) the legislative history and intended usage of IACA, 5) the context of IACA within the broader framework of domestic intellectual property and consumer protection laws, and 6) IACA's use by U.S. officials as an illustrative tool of articulated U.S. TKGRF policy. Examination of these factors reveals a gap between avowed official U.S. interest in protecting indigenous TKGRF and the realities of available protection under IACA.

³⁸⁸ Pub. L. No. 101-644, 104 Stat. 4662 (1990) (codified as amended in scattered sections of 18 U.S.C., 20 U.S.C., 25 U.S.C., 42 U.S.C.). Congress passed IACA on a unanimous voice vote in both the House of Representatives and the Senate on November 29, 1990. Whether this indicates unusually broad interest in and unanimous support for the bill, or general apathy toward an unobjectionable bill perceived by many to be innocuous, or any number of other views, can only be a matter of speculation.

³⁸⁹ See, e.g., U.S. OAS Statement, *supra* note 16; Lourie Statements *supra* note 212.

³⁹⁰ Indian Arts and Crafts Enforcement Act of 2000, Pub. L. No. 106-497, 114 Stat. 2219 (amending 25 U.S.C. § 305e).

³⁹¹ See generally 25 C.F.R. § 309.1–.27 (2003).

Under IACA, “[i]t is unlawful to offer or display for sale or sell any good . . . in a manner that falsely suggests it is Indian produced, an Indian product, or the product of a particular Indian or Indian tribe or Indian arts and crafts organization, resident within the United States.”³⁹² IACA is implemented mainly through the Indian Arts and Crafts Board (the “Board”), which has been in existence since the 1930s.³⁹³ In 1990, however, Congress expanded the Board’s mandate considerably, giving it the rather grandiose new responsibility of “implementing the [IACA], promoting the development of U.S. Indian and Alaska Native arts and crafts, improving the economic status of members of federally recognized Tribes, and helping to establish and expand marketing opportunities for arts and crafts produced by U.S. Indians and Alaska Natives.”³⁹⁴

The Board characterizes IACA as a “truth-in-advertising law” designed to prevent the marketing of products misrepresented as produced by Indians.³⁹⁵ Case law interprets IACA as a strict liability statute with the dual purposes of: 1) protecting Indian artists from unfair competition from counterfeiters, and 2) protecting consumers from unknowingly purchasing imitation products.³⁹⁶ Statutory violations carry fairly severe civil³⁹⁷ and criminal³⁹⁸ penalties.

Both the structure and language of IACA and its associated politics have been controversial ever since its passage more than a

³⁹² 18 U.S.C. § 1159(a) (2004).

³⁹³ See 25 U.S.C. § 305a (2004); William J. Hapiuk, Jr., *Of Kitsch and Kachinas: A Critical Analysis of the Indian Arts and Crafts Act of 1990*, 53 STAN. L. REV. 1009, 1018 (2001) (providing an excellent discussion of the historical background and political economy of Native American arts and crafts, including establishment of the Board, its early activity, and events leading to the later passage of IACA).

³⁹⁴ Protection of Products of Indian Art and Craftsmanship, 66 Fed. Reg. 27915 (proposed May 21, 2001) (codified at 25 C.F.R. § 309.1–.21).

³⁹⁵ See U.S. Dep’t of the Interior, Indian Arts & Crafts Bd., *The Indian Arts and Crafts Act of 1990*, at <http://www.doi.gov/iacb/act.html> (last visited Nov. 7, 2004) (summarizing the IACA).

³⁹⁶ See, e.g., *Native Am. Arts, Inc. v. Vill. Originals, Inc.*, 25 F. Supp. 2d 876, 880, 882 (N.D. Ill. 1998).

³⁹⁷ See 25 U.S.C. § 305e (2004).

³⁹⁸ See 18 U.S.C. § 1159 (2004).

decade ago.³⁹⁹ One of the more problematic aspects of IACA is that it arbitrarily limits those people defined as “Indian” to members or certified artisans of a state or federally recognized Indian tribe.⁴⁰⁰ This drastically limits the size and makeup of the group of indigenous artisans that may unqualifiedly represent their artistic creations to be Indian products. An “Indian tribe” is “[a]ny Indian tribe, band, nation, Alaska Native village, or any organized group or community which is recognized as eligible for the special programs and services provided by the United States to Indians because of their status as Indians” or “[a]ny Indian group that has been formally recognized as an Indian tribe by a State legislature or by a State commission or similar State organization legislatively vested with State tribal recognition authority.”⁴⁰¹ People not formally enrolled as tribal members may be certified as non-member Indian artisans of the tribe,⁴⁰² but such people must be of Indian lineage through one or more members of the certifying tribe, and each certification must be documented in writing by the governing body of the certifying tribe.⁴⁰³

Under some factual scenarios, these definitional provisions may conflict with well-settled case law that an Indian tribe has the authority to determine its own membership.⁴⁰⁴ IACA definitions may also conflict with the many definitions of “Indian” used for other federal statutory law purposes.⁴⁰⁵ In addition, there are many legitimate reasons—including political and ideological ones—why an individual of clear Indian descent might fail or refuse to be officially enrolled in the membership records of a tribe or certified as an artisan.⁴⁰⁶ This is likely to affect increasingly large numbers of individuals, as more Native Americans move to urban areas and

³⁹⁹ See Hapiuk, *supra* note 393.

⁴⁰⁰ See 25 C.F.R. § 309.2 (2004); 18 U.S.C. § 1159(c)(1).

⁴⁰¹ See 25 C.F.R. § 309.2(e).

⁴⁰² See *id.* § 309.2(b).

⁴⁰³ See *id.* § 309.25.

⁴⁰⁴ See Hapiuk, *supra* note 393, at 1012 (citing *Santa Clara Pueblo v. Martinez*, 436 U.S. 49, 72 n.32 (1978)).

⁴⁰⁵ See *id.* at 1012 n.12 (citing FELIX S. COHEN, *HANDBOOK OF FEDERAL INDIAN LAW* 1 (Rennard Strickland ed., 1982)). There is no single federal definition of “Indian tribe.” See *id.*

⁴⁰⁶ See *id.* at 1013, 1063.

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a unitary, “pan-tribal” Indian identity emerges.⁴⁰⁷ Under IACA, these people cannot unqualifiedly sell or market their artistic creations as Indian or Native American products, even if both of their parents are full-blooded members of the same tribe.⁴⁰⁸

As mentioned above, the Board, an independent board within the Department of the Interior (and not, as often assumed, part of the Bureau of Indian Affairs),⁴⁰⁹ is the main vehicle for Indian arts and crafts promotion.⁴¹⁰ Since 1990, the Board has been assigned primary government responsibility for market research concerning sales opportunities for Indian arts and crafts products, for engaging in related technical research and assistance, and for coordinating related activities among other U.S. government and private agencies.⁴¹¹ The Board is also required to manage specific related projects and to make recommendations concerning government loans to support production and sale of Indian products.⁴¹² The Board itself cannot borrow or lend money, nor can it deal in Indian goods.⁴¹³

It is particularly relevant to current TKGRF discussions that since 1990, Congress has intended the Board to create, on a cost-free basis, trademarks for qualifying Indian arts and crafts producers.⁴¹⁴ According to at least one legal thinker, this was considered the most promising part of IACA at the time of its passage.⁴¹⁵ On the facial language of the statute, the Board has the power to create trademarks for Indian products, either in the name of the Board itself,⁴¹⁶ or for individual Indians or Indian tribes or

⁴⁰⁷ See *id.* at 1063.

⁴⁰⁸ See 25 C.F.R. § 309.24; see also *supra* notes 402–03 and accompanying text.

⁴⁰⁹ See U.S. OAS Statement, *supra* note 16 (oral clarification made at presentation).

⁴¹⁰ See *supra* note 393 and accompanying text.

⁴¹¹ See 25 U.S.C. § 305a (2004).

⁴¹² See *id.*

⁴¹³ See *id.*

⁴¹⁴ See Hapiuk, *supra* note 393, at 1069 (quoting 25 U.S.C § 305a(g)(3) (1994)).

⁴¹⁵ See *id.* at 1067 (citing *To Expand the Powers of the Indian Arts and Crafts Board: Hearing on H.R. 2006 Before the House Comm. on Interior and Insular Affairs Held in Santa Fe, NM*, 101st Cong. 13 (1989) (statement of Leo Calac, Vice Chairman, IACB)).

⁴¹⁶ Art and craft goods handmade by American Indians and Alaskan natives may be trademarked as “Indian Arts and Crafts Board Genuine Handicrafts Certified Indian Enterprise U.S. Department of the Interior” (certification mark registration number 2479552). See USPTO, *Trademark Electronic Search System*, at

Indian arts and crafts organizations.⁴¹⁷ The Board also has the authority to establish standards and regulations for use of government-owned trademarks in the Indian arts and crafts area, including setting licensing fees for trademark use.⁴¹⁸ IACA gives the Board power to register these government-owned trademarks with the USPTO, free of charge, and to assign them and their associated goodwill to individual Indians or Indian tribes, also free of charge.⁴¹⁹ The Board can pursue or defend court appeals or proceedings with respect to any final determination of the USPTO in relation to these trademarks.⁴²⁰

Unfortunately, the intended free trademark program for qualifying Indians has never been implemented. One of the longstanding problems with the law as drafted is that registration of a mark that is intended at the time of filing not to be used by the Board itself, but instead to be subsequently assigned to an Indian tribe or other third party, legally results in a void mark.⁴²¹ This is because the Lanham Act requires that an applicant for registration of a trademark must itself use that mark in commerce or in good faith intend to so use it.⁴²² Applications for registration of marks that are intended from the start to be owned and used only by Indians or Indian tribes obviously cannot meet this requirement.

Ironically, only the Board's own certification mark meets the statutory requirements. Today, an Indian producer who has independently paid for and registered its own trademark can get permission to use the Board's mark in conjunction with the producer's own mark, thus certifying that the producer's goods meet the Board's standards.⁴²³ But qualifying Indian individuals

<http://www.uspto.gov/main/trademarks.htm> (last visited Nov. 15, 2004) [hereinafter *TESS*] (allowing searches by registrant's name to access trademark registration information).

⁴¹⁷ See 25 U.S.C. § 305a(g)(1).

⁴¹⁸ See 25 U.S.C. § 305a(g)(2).

⁴¹⁹ See *id.* § 305a(g)(3).

⁴²⁰ See *id.* § 305a(g)(4).

⁴²¹ See Hapiuk, *supra* note 393, at 1069 (noting that the Lanham Act requires that the registrant be the user of the mark, and that such mark may not be one the government intends to use).

⁴²² See 15 U.S.C. § 1051 (2004).

⁴²³ See 25 C.F.R. § 308.2(a) (2004); U.S. DEP'T OF THE INTERIOR, INDIAN ARTS AND CRAFTS BOARD, FACT SHEET ("FACT SHEET").

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and entities cannot obtain free trademarks of their own and use them independent of the U.S. government's name, standards-setting and control.

The Board is aware of the trademark problem and thus has not attempted to register any Indian marks for assignment.⁴²⁴ In fact, the chair of the Board explained the nature of this trademark dilemma to the Senate Committee on Indian Affairs prior to passage of the Indian Arts and Crafts Enforcement Act of 2000 and offered draft language to resolve the problem,⁴²⁵ but the suggested changes were not incorporated into that law.⁴²⁶ Today the problem continues to exist.

In the summer of 2002, Senators Inouye and Campbell introduced the "Indian Programs Reauthorization and Technical Amendments Act of 2002" in the U.S. Senate during the 107th Congress.⁴²⁷ The bill addressed many indigenous peoples' issues, ranging from Native Hawaiian health care improvements to provisions concerning oil shale reserves and water feasibility studies for particular tribes.⁴²⁸ Among the diverse items contained in the bill as introduced were remedial amendments to IACA.⁴²⁹ After significant revisions, the bill passed the Senate in November 2002 as the Native American Omnibus Act of 2002, unfortunately without the IACA amendments.⁴³⁰ The IACA corrections have not been reintroduced in the 108th Congress, so the law remains unchanged at this time.

Ironically, then, the only way the trademark provisions of IACA have been implemented is that the Board has registered its

⁴²⁴ Telephone Interview with Ken Van Wey, Program Assistant, Indian Arts and Crafts Board (Apr. 29, 2003) (on file with author).

⁴²⁵ See *Implementation of the Indian Arts and Crafts Act: Hearing before the Senate Comm. on Indian Affairs*, 106th Cong. (2000) (statement of Faith Roessel, Chair, Indian Arts and Crafts Board).

⁴²⁶ See 25 U.S.C § 305e (2004).

⁴²⁷ S. Res. 2711.IS, 107th Cong. (2002) (as introduced in the Senate).

⁴²⁸ *Id.*

⁴²⁹ *Id.* § 301 (amending § 2(g) of the IACA).

⁴³⁰ S. Res. 2711.ES, 107th Cong. (2002) (as passed by the Senate). The revised bill was referred to the House Committee on Natural Resources on November 22, 2002, but it did not come before the full House for a vote before the session ended. See S. Res. 2711.RFH, 107th Cong. (2002) (as referred to House Committee after being received from the Senate).

own certification mark and established *government* standards for Indian products and a procedure for indigenous use of the *government's* mark.⁴³¹ According to the "Fact Sheet" published by the Board on intellectual property matters relating to Indian arts and crafts, "[e]ach eligible Indian, Eskimo, and Aleut crafts marketing enterprise has the privilege of attaching to its [own] registered trademark a certificate declaring that the Indian Arts and Crafts Board recognizes their [sic] products as authentic Native American handicrafts."⁴³²

In this rather paternalistic style, the regulations require that an Indian enterprise wishing to participate in its certification program must 1) be entirely Native American owned and organized, 2) offer for sale only genuine Native American handicraft products, and 3) agree to apply the Board's certificate of genuineness only to products that meet the Board's quality standards.⁴³³ Additionally, it is implicit in the regulations that the Indian artist must first register his or her own trademark in order to pay for and participate in the program.⁴³⁴ This is a considerably narrower and more difficult set of standards to meet than those which Congress attempted to authorize on the face of the IACA statutory language.⁴³⁵ In addition, the Fact Sheet gives readers wishing to participate no definition of the terms "Native American" or "genuine Native American handicraft products," so it is difficult to know from the publication how to meet the requirements of the Fact Sheet.⁴³⁶

The Fact Sheet promises that the Board "is in the process of setting up a trademark program, which will enable the Board to

⁴³¹ See 25 U.S.C. § 305a(g)(1)–(3) (2004) (establishing the Board's power to create and license trademarks conferring "genuine" status); 25 C.F.R. § 308.3 (2004) (defining the conditions for use of the government's mark); FACT SHEET, *supra* note 423.

⁴³² FACT SHEET, *supra* note 423.

⁴³³ See 25 C.F.R. § 308.3.

⁴³⁴ See *id.* § 308.2 ("[T]he Indian Arts and Crafts Board offers each such enterprise the privilege of attaching to its trademark a certificate declaring that it is recognized by the Indian Arts and Crafts Board as an Indian enterprise dealing in genuine Indian-made handicraft products, and that its trademark has the approval of the Board.") (emphasis added).

⁴³⁵ See IACA, Pub. L. No. 101-644, 104 Stat. 4662 (1990) (codified as amended in scattered sections of 18 U.S.C., 20 U.S.C., 25 U.S.C., 42 U.S.C.).

⁴³⁶ See FACT SHEET, *supra* note 423.

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register trademarks for federally recognized tribes and their members.”⁴³⁷ In truth, however, the Board is waiting for new, curative legislation to be passed before deciding on any of the details of this trademark program.⁴³⁸ Of course, even if the trademark program is implemented as originally envisioned, it may not be attractive to some tribes or individuals who, quite legitimately, wish to operate autonomously and without government participation in, or direct knowledge of, their creative endeavors.

In 1999, the USPTO recommended in a Congressionally-mandated study that concerted government education efforts were necessary to inform Native Americans and other members of the U.S. public about the existence of IACA.⁴³⁹ Although that study was written nearly a decade after the original passage of IACA, it did not mention the trademark voidness issue.⁴⁴⁰ Instead, it stated unambiguously that the Board has the power to create trademarks on behalf of Indian tribes without charge;⁴⁴¹ thus, it appears that the USPTO was unaware that in this respect, IACA could not be, and had never been, implemented.

The USPTO also noted in the same study that “enforcement is the key to full enjoyment of [intellectual property] rights,” and it opined that IACA provides an effective enforcement mechanism through the Board’s power to refer IACA investigation and enforcement actions to the FBI and the Attorney General.⁴⁴² Unfortunately, the USPTO did not provide any statistical or anecdotal analyses in the study that illustrate how many investigations or formal legal enforcement proceedings had actually been undertaken pursuant to Board referral during IACA’s first nine years of existence.⁴⁴³

⁴³⁷ *Id.*

⁴³⁸ Written correspondence with Meredith Z. Stanton, Acting Director, Indian Arts and Crafts Board (June 9, 2003) [hereinafter Stanton Correspondence] (on file with author).

⁴³⁹ See USPTO Report, *supra* note 316, at 45.

⁴⁴⁰ See generally *id.*

⁴⁴¹ See *id.* at 27, 39.

⁴⁴² *Id.* at 39.

⁴⁴³ See *id.*

No statistical information concerning IACA investigations and enforcement is readily available to the public today, and the recommended educational effort has apparently not taken place. Additionally, it cannot be easily assessed whether the enforcement referral mechanism is a meaningful feature of IACA or whether IACA is independently enforced (without Board referral) by state and federal agencies, since these activities, at least by federal agencies, are not conducted transparently.⁴⁴⁴ It is clear, however, that reported case law does not reflect widespread litigation under either the civil or criminal enforcement provisions of IACA.⁴⁴⁵

Despite this, at the February 2003 meeting of the OAS, the United States' written statement relating to the intellectual property rights provision of the OAS Draft Declaration proclaimed that the Board's top priority is enforcement and implementation of IACA.⁴⁴⁶ The statement also specifically mentioned that one of the purportedly available "special measures for Native American Tribes"⁴⁴⁷ empowers the Board to register "government trademarks

⁴⁴⁴ In an attempt to determine the validity of policymakers' claims of the value of IACA to protect indigenous TKGRF through vigorous enforcement, I queried the Acting Director of the Board, Ms. Meredith Stanton, in mid-2003 about the number of matters the Board had referred to other agencies for investigation under the statute since 1990. Unfortunately, Ms. Stanton agreed to consider only written questions and also would respond only in writing. The written response to my general query about how many matters had been referred by the Board to other agencies for civil or criminal investigation since 1990 was only that on-going investigations could not be discussed. The written response to a series of questions concerning the number of civil and criminal convictions obtained under IACA since 1990 was that, though the Board is aware that other agencies have filed legal actions, the Board does not know the status of any of them. *See Stanton Correspondence, supra* note 438.

Sources at the Department of Justice were equally unforthcoming and were willing to say only that the Department of Justice does not make available to the public any information about investigations, that it does not keep statistics on convictions or judgments obtained under IACA, and that its officials know of no other agency that does so, either. This combined official reticence about IACA enforcement seems curious, in light of the emphasis put on the value of IACA, and to its enforcement provisions specifically, by U.S. officials in international TKGRF discussions.

⁴⁴⁵ *See, e.g.,* Native Am. Arts, Inc. v. Hartford Cas. Ins. Co., 2004 U.S. Dist. LEXIS 18322 (N.D. Ill. Sept. 9, 2004); Native Am. Arts, Inc. v. Waldron, 2004 U.S. Dist. LEXIS 14289 (N.D. Ill. July 22, 2004); Flodine v. State Farm Ins. Co., 2003 U.S. Dist. LEXIS 4006 (N.D. Ill. Mar. 18, 2003); Native Am. Arts v. Earthdweller, Ltd., 2002 U.S. Dist. LEXIS 9750 (N.D. Ill. May 29, 2002).

⁴⁴⁶ *See* U.S. OAS Statement, *supra* note 16, at 6.

⁴⁴⁷ *See id.* at 5.

of genuineness and quality on behalf of individual Indians and Indian tribes.”⁴⁴⁸ U.S. officials made a similar representation at the 4th WIPO IGC in late 2002.⁴⁴⁹ These representations obviously do not reflect the realities of actual implementation and enforcement of IACA.

B. Alaska’s Silver Hand Program

Whatever IACA’s shortcomings in the federal venue, there is an analogous, state-based program that is gaining popularity among indigenous local artisans and local consumers. Alaska’s unique indigenous handicraft certification program is known as the “Silver Hand Program.”⁴⁵⁰ While state officials view it as a “branding” mechanism or a kind of consumer protection program,⁴⁵¹ the Silver Hand Program actually functions much like a state-owned certification mark.⁴⁵² Not surprisingly, the Alaska State Council on the Arts consulted the Indian Arts and Crafts Board prior to launch of the Alaska program,⁴⁵³ and both parties continue to confer concerning their respective program development.⁴⁵⁴

The Alaska Native handicraft certification scheme was designed in 1961.⁴⁵⁵ The Native certification program was originally aimed at certifying the authenticity of one-of-a-kind items created by individual Alaska Native artisans in cottage industry settings, whereas the parallel program for non-Natives was intended to cover the products of larger (even if still relatively

⁴⁴⁸ *Id.* at 9.

⁴⁴⁹ Lourie Statements, *supra* note 212.

⁴⁵⁰ ALASKA STAT. §§ 45.65.010–.070 (Michie 2003).

⁴⁵¹ Telephone Interview with Saunders McNeill, Native Arts Program Director, Alaska State Council on the Arts (Apr. 24, 2003) [hereinafter McNeill Interview] (on file with author); see also Alaska State Council on the Arts, *Silver Hand Permit Application*, <http://www.eed.state.ak.us/aksca/forms/individuals/sh.pdf> (last visited on Nov. 15, 2004).

⁴⁵² State ownership and control of the mark—the Silver Hand seal—is analogous to Board ownership and administration of its federal certification mark under IACA. One very notable difference, however, is that an Alaska Native artist is not required to obtain his or her own individual trademark before applying for and using the Silver Hand seal.

⁴⁵³ Stanton Correspondence, *supra* note 438; McNeill Interview, *supra* note 451.

⁴⁵⁴ McNeill Interview, *supra* note 451.

⁴⁵⁵ See *FTC Takes Action against Fake Native Artwork*, KENAI PENINSULA ONLINE, Oct. 8, 2002, at http://peninsulaclarion.com/stories/100802/ala_100802alapm0010001.shtml.

small) arts manufacturing concerns.⁴⁵⁶ Under the statutory scheme, a person who makes an authentic Native handicraft within Alaska may, under certain conditions, obtain a permit to affix a state-administered seal attesting to the origin and authenticity of the article.⁴⁵⁷ The seal consists of a silver hand symbol bearing the words “Authentic Native Handicraft from Alaska” and includes a blank line on which the individual artist can write in his or her name and the place of origin of the article.⁴⁵⁸ Tags or labels bearing this seal are issued by the state to Alaska Native permit holders for use solely on their own handicrafts; the permits are issued for two years and must be renewed periodically,⁴⁵⁹ though the permit number is assigned to the holder for life, whether or not he or she continuously uses it.⁴⁶⁰ Silver Hand seals may be used only when an article is made solely by an individual permit holder,⁴⁶¹ precluding works made jointly by an Alaska Native permit holder and any other person who is not also a separate permit holder in his or her own right, whether or not such person is an Alaska Native.

By statute, the Alaska State Council on the Arts administers issuance and control of the seals, supervises their use, issues permits to agents who can distribute the seals to persons creating qualifying handicrafts, and enforces associated laws and rules.⁴⁶² It is also responsible for determining the design of seals, their method of affixation, and their preparation and control.⁴⁶³ Although the statute does not specifically require it, the Alaska State Council on the Arts in fact maintains a central registry of all

⁴⁵⁶ *Id.* The parallel program, “Made in Alaska,” was “designed to promote products made or manufactured in the state and handicrafts produced by both Native and non-Native craftspersons.” ALASKA ADMIN. CODE tit. 3, § 58.040(a) (2004); see also Made in Alaska, *About MIA*, at <http://www.madeinalaska.org/mia/about.htm> (last visited Nov. 7, 2004).

⁴⁵⁷ See ALASKA STAT. § 45.65.010(a) (Michie 2004).

⁴⁵⁸ See ALASKA STAT. § 45.65.030(a) (Michie 2004).

⁴⁵⁹ See ALASKA ADMIN. CODE tit. 3, § 58.020(d) (2004); *Silver Hand Permit Application*, *supra* note 451.

⁴⁶⁰ McNeill Interview, *supra* note 451.

⁴⁶¹ See ALASKA ADMIN. CODE tit. 3, § 58.020(c)(3)(A) (2004).

⁴⁶² See ALASKA STAT. § 45.65.020(b) (Michie 2004); ALASKA ADMIN. CODE tit. 3, §§ 58.005–.035, .060–.900 (2004).

⁴⁶³ See ALASKA STAT. § 45.65.020(b).

permit holders qualified to use the seal on their handicrafts.⁴⁶⁴ Use of the plural form of “seals” in the statutory language may mean that more than one type or class of seal could be created for various Native handicrafts, or possibly even different seals for different tribes or indigenous groups, but presently only one seal exists for all qualifying handicrafts.

Under Alaska’s statute, “‘authentic Native handicraft’ means an article made in the state which is composed wholly, or in some significant respect, of natural materials, and which is produced, decorated or fashioned by an Alaska Native.”⁴⁶⁵ “‘Native’ means [an Alaskan] resident having not less than one-quarter Eskimo, Aleut or Indian blood.”⁴⁶⁶ An artisan must document this fact either through possession of a Certificate of Indian Blood from the United States Department of the Interior, “an official letter from a village or regional corporation” established under the Alaska Native Claims Settlement Act of 1971, or an “official letter from a village council or tribe in which the applicant is a member,” together with a state driver’s license or other photo identification.⁴⁶⁷ According to the Silver Hand permit application, “American Indians whose tribes are indigenous to other states are not eligible” to participate in the Silver Hand program,⁴⁶⁸ although this is not clear from the statute itself. Presumably, this means that an Alaska resident from the Navajo Nation could not use the Silver Hand seal for his or her handicrafts, even if the articles met the other required criteria; he or she could qualify only to participate in the non-Native handicraft certification program, despite Alaska resident status.

Criminal penalties attach to violations of the Alaska statute.⁴⁶⁹ Knowing or willful affixation of a seal to a non-authentic article, or offer of sale or actual sale of a non-authentic article bearing such a seal, is a Class B misdemeanor if the individual affixing or selling

⁴⁶⁴ McNeill Interview, *supra* note 451. The registry is available through the Alaska State Council on the Arts website. See *List of Silver Hand Permit Holders*, <http://www.eed.state.ak.us/aksca/SilverHand2004.xls> (last modified June 29, 2004).

⁴⁶⁵ ALASKA STAT. § 45.65.070(1) (Michie 2004).

⁴⁶⁶ *Id.* § 45.65.070(5).

⁴⁶⁷ *Silver Hand Permit Application*, *supra* note 451.

⁴⁶⁸ *Id.*

⁴⁶⁹ See ALASKA STAT. § 45.65.060 (Michie 2004).

the article knows that the article is not an authentic Native handicraft.⁴⁷⁰ Similarly, an agent who knowingly or willfully issues a seal permit for an article that is not an authentic Native handicraft is guilty of a Class B misdemeanor,⁴⁷¹ as is anyone who “knowingly or willfully alters, changes, or counterfeits” a Silver Hand Program seal.⁴⁷²

The Silver Hand program envisions that the permit holder will use the seal in connection with advertising and on marketing and business materials associated with the handicrafts, so long as the use is not false or misleading and so long as the seal is not incorporated directly into a business logo or label or used in a dominant manner in a product.⁴⁷³ Interestingly, the Alaska State Council on the Arts, using its discretion, has discontinued a part of the Silver Hand Program outlined by the state statute.⁴⁷⁴ The result is that agents can no longer be appointed by the state to issue permits to individual Native artisans.⁴⁷⁵ The Council took this action because agents were failing to register individual artisans properly and because it wanted to ensure appropriate quality control of certified handicrafts.⁴⁷⁶ Since this change was effected in 1998, the Silver Hand Program registry has grown from roughly 350 to more than 1100 permit holders.⁴⁷⁷

The program’s legal requirements and state-based regulatory support are reminiscent of the requirements for establishing and policing a certification mark in the federal trademark system.⁴⁷⁸ Although the Silver Hand seal is not specifically referred to in state statutory or administrative materials as a certification mark or trademark *per se*—and it is apparently not viewed as such by its

⁴⁷⁰ See *id.* § 45.65.060(a)–(b).

⁴⁷¹ See *id.* § 45.65.060(f).

⁴⁷² See *id.* § 45.65.060(c).

⁴⁷³ See *id.*

⁴⁷⁴ See ALASKA STAT. § 45.65.045(b) (Michie 2004); ALASKA ADMIN. CODE tit. 3, § 58.030 (2004).

⁴⁷⁵ McNeill Interview, *supra* note 451.

⁴⁷⁶ *Id.*

⁴⁷⁷ *Id.* As of June 29, 2004, there were 1125 registered Silver Hand permit holders. See *List of Silver Hand Permit Holders*, *supra* note 464.

⁴⁷⁸ See *infra* notes 487–93 and accompanying text.

administrators⁴⁷⁹—it actually appears to function in a strikingly similar manner. The seal enjoys growing popularity among artisans, and it appears to be quite successful and useful, both to them and to consumers.⁴⁸⁰

The Silver Hand program could be a useful model for other indigenous groups and states interested in locally run government certification programs for TKGRF. This type of program seems to function effectively in providing a reliable system under which consumer familiarity and confidence in the uniform quality of indigenous handicrafts and works of art can grow, so long as the certifying entity plays an active role in ensuring that quality control with proper supervision is supported by meticulous registration and records keeping.

One advantage of this kind of state certification program (especially if it includes criminal as well as civil penalties), which lies outside a “pure” state trademark rubric but within the province of consumer-type statutes, is that both state and federal agencies may have concurrent jurisdiction and, thus, greater willingness to jointly participate in enforcement than in a formal trademark scenario. With respect to Alaska’s statute, the State Attorney General’s office, the Federal Trade Commission (“FTC”), the Department of Justice, and the U.S. Customs Service have all, from time to time, been involved in investigating complaints arising in connection with the Silver Hand Program.⁴⁸¹ Also, from an indigenous peoples’ standpoint, state-run programs dispense with the necessity of using scarce tribal financial resources for program operating expenses, trademark registrations, and attorney fees, though state programs also prevent tribal autonomy over the specifics of certification standards.⁴⁸²

⁴⁷⁹ See ALASKA STAT. § 45.65.045(b) (Michie 2004); ALASKA ADMIN. CODE tit. 3, § 58.030 (2004).

⁴⁸⁰ See, e.g., note 477 and accompanying text.

⁴⁸¹ *Id.*; Telephone Interview with Chuck Harwood, Regional Director, Northwest Region, FTC (Apr. 25, 2003) [hereinafter Harwood Interview] (notes from interview on file with author); see also Press Release, FTC, FTC Distributes 300,000 Postcards and Brochures to Educate Shoppers Seeking Authentic Alaska Native Art (July 22, 2003), <http://www.ftc.gov/opa/2003/07/-alaska.htm>; *FTC Takes Action against Fake Native Artwork*, *supra* note 455.

⁴⁸² See Hapiuk, *supra* note 393, at 1065.

C. Federal Trade Commission Act

In conjunction with the Alaska experience, the Federal Trade Commission has become interested in handicraft authenticity issues and has investigated numerous violations of the Federal Trade Commission Act ("FTC Act").⁴⁸³ The FTC Act applies in the TKGRF context when there allegedly has been a material misrepresentation to consumers concerning goods supposedly created by Native Americans, but in fact produced by others.⁴⁸⁴ The FTC has also made a modest effort to educate Alaska's summertime tourists about this problem, distributing brochures and postcard information to cruise companies, travel agencies, airlines, and others, informing them about how to determine the authenticity of indigenous handicrafts.⁴⁸⁵ It has investigated several complaints about related consumer protection violations in the state over the last few years, and it successfully settled one case in 1996, in which Eskimo carvers were producing handicraft items and falsely marketing them for sale in the United States as the creations of Northwest Coastal Indians.⁴⁸⁶

D. USPTO Database of Native American Tribal Insignia

Another feature of U.S. law that is widely cited by U.S. officials as evidence of government support for legal protection of indigenous TKGRF is the Database of Native American Tribal Insignia ("Database"), which is maintained by the USPTO.⁴⁸⁷ Contrary to its name, the Database is not an independent database, separate from other USPTO information, but is just one component of the general trademark database administered by the USPTO.⁴⁸⁸ It may be accessed and searched electronically via the Trademark

⁴⁸³ 15 U.S.C. § 45(a) (1994).

⁴⁸⁴ Harwood Interview, *supra* note 481.

⁴⁸⁵ Press Release, FTC, FTC Heads Education Campaign to Help Shoppers Assure Alaskan Native Art is Authentic (May 14, 2002), <http://www.ftc.gov/opa/2002/05-/akart.htm>.

⁴⁸⁶ See Press Release, FTC, Ivory Jack's and Northwest Tribal Arts Agree to Settle FTC Charges that They Sold Fake Native American Artwork (Apr. 12, 1996), <http://www.ftc.gov/opa/1996/04/ivory-j.htm>.

⁴⁸⁷ See USPTO, *FAQ*, *supra* note 22.

⁴⁸⁸ See *id.* (at response to question 2).

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Electronic Search System, or TESS.⁴⁸⁹ “Official insignia of Native American tribes”—“the insignia that may be registered in the database—”means the flag or coat of arms or other emblem or device of any federally or State recognized Native American tribe, as adopted by tribal resolution and notified to the U.S. Patent and Trademark Office.”⁴⁹⁰

The tribal insignia database is maintained as a reference tool for federal trademark examiners.⁴⁹¹ If, for example, a third party attempts to register a mark that falsely suggests a connection with a Native American tribe that has its official insignia on file, the examiner refers to the collection in the database and can, where appropriate, refuse registration to the third party mark.⁴⁹² While this is somewhat useful, U.S. officials at recent IGC and OAS meetings have gone so far as to champion the Database as a valuable legal tool that demonstrates the U.S. government’s commitment to protecting the intellectual property rights of indigenous peoples.⁴⁹³

This position is more than a little misleading. In reality, the Database appears to be a rather *pro forma* attempt to comply with international treaty terms, rather than to represent any real or concerted effort to protect indigenous TKGRF. It seems to have been created for reasons largely unrelated to government concern for TKGRF. The Database was the result of a Congressionally-mandated USPTO study,⁴⁹⁴ which in turn resulted from the United States’ desire to accede to the Trademark Law Treaty⁴⁹⁵ in the late 1990’s. That treaty is aimed mainly at eliminating the enormous

⁴⁸⁹ See *id.*; see also TESS, *supra* note 416.

⁴⁹⁰ J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 25:67.1, at 25-152–25-153 (4th ed. 2002) (quoting USPTO Report, *supra* note 316, at 24).

⁴⁹¹ See USPTO, FAQ, *supra* note 22 (at response to question 8).

⁴⁹² *Id.*

⁴⁹³ See Lourie Statements, *supra* note 212; see also U.S. OAS Statement, *supra* note 16.

⁴⁹⁴ USPTO Report, *supra* note 316, at 2. The study was mandated by Title III of Public Law 105-330.

⁴⁹⁵ WIPO, Trademark Law Treaty, adopted at Geneva, Switz. Oct. 27. 1994 [hereinafter Trademark Law Treaty], <http://www.wipo.int/treaties/en/ip/tlt> (last visited Nov. 15, 2002).

variation among countries in trademark registration formalities.⁴⁹⁶ When Congress passed the Trademark Law Treaty Implementation Act⁴⁹⁷ in 1998, it required, incidentally, an insignia protection study as part of the overall treaty compliance package.⁴⁹⁸

While the USPTO had, in 1994, contacted all federally registered Native American tribes with the objective of compiling a list of official insignia for use in determining *general* trademark registrability, “to ensure that third parties do not register trademarks that give a false impression of the true origin of the goods or services,” no database had resulted.⁴⁹⁹ Conveniently, however, this initial tribal contact was repackaged five years later in the USPTO Report, under the somewhat dubious heading, “The PTO Takes an Active Role in Protecting Native Americans.”⁵⁰⁰ In reality, the Database was finally created as a direct result of the later treaty obligations, a fact substantiated in a much later official U.S. response to a WIPO questionnaire on TKGRF.⁵⁰¹ This survey response was submitted by the USPTO itself, through the then-Administrator for External Affairs, Robert Stoll, well after completion of the USPTO study.⁵⁰² This sequence of events lends credence to the theory that creation of the Database did not, reflect any pronounced interest by the U.S. government in protecting indigenous intellectual property, contrary to present U.S. policy characterization in international discussion forums.

The 1998 Congressional mandate required that the USPTO study the impact that a tribal insignia database, along with concomitant changes in U.S. trademark law or policy potentially prohibiting marks identical to official tribal insignia, would have on Native American tribes, on the agency itself, and on other

⁴⁹⁶ Marshall A. Leaffer, *The New World of International Trademark Law*, 2 MARQ. INTELL. PROP. L. REV. 1, 20 (1998).

⁴⁹⁷ Trademark Law Treaty Implementation Act, Pub. L. No. 105-330, 112 Stat. 3064 (1998) (enacted Oct. 30, 1998 and codified in scattered sections of 15 U.S.C.).

⁴⁹⁸ *See id.* § 302(a)(2).

⁴⁹⁹ *See* USPTO Report, *supra* note 316, at 14, 45.

⁵⁰⁰ *See id.* at 14.

⁵⁰¹ Questionnaire Response, *supra* note 386, at 1.

⁵⁰² *Id.*

interested parties.⁵⁰³ The USPTO was also directed to study the effects of prohibitions on new uses of such insignia, and changes in law or policy with respect to defenses to claims of insignia infringement.⁵⁰⁴ The administrative feasibility and cost of protecting official tribal insignia were examined, as well as the effect of prohibiting registrations or new uses.⁵⁰⁵ Congress unequivocally directed the Commissioner of the USPTO to solicit public comment and to use “any appropriate additional measures, including field hearings, to obtain as wide a range of views as possible from Native American tribes, trademark owners, and other interested parties.”⁵⁰⁶

In response, the USPTO published notice of the upcoming study in the Federal Register.⁵⁰⁷ The agency scheduled field hearings to consider the study’s issues in Albuquerque, NM; San Francisco, CA; and Arlington, VA.⁵⁰⁸ Those wishing to testify were required to give written notice to the USPTO prior to the first of the series of hearings, along with a written copy of planned testimony.⁵⁰⁹ The agency allocated between five and fifteen minutes per speaker, and prior agency approval was required.⁵¹⁰ Only information that speakers wished to be electronically accessible for public dissemination was to be submitted.⁵¹¹

Under these circumstances, the agency received only thirty-three written responses, and a mere thirty-six witnesses gave oral testimony.⁵¹² Among the respondents were the powerful American Intellectual Property Law Association, DaimlerChrysler, the International Trademark Association, Mohawk Carpet Corporation, the National Coalition on Racism in Sports and

⁵⁰³ See USPTO Report, *supra* note 316, at 7–8; see also Trademark Law Treaty Implementation Act, Pub. L. No. 105-330, § 302, 112 Stat. 3064 (1998).

⁵⁰⁴ See USPTO Report, *supra* note 316, at 7–8.

⁵⁰⁵ See *id.* at 8.

⁵⁰⁶ Trademark Law Treaty Implementation Act § 302(b)(1).

⁵⁰⁷ Request for Comments, 63 Fed. Reg. 71619 (Dec. 29, 1998).

⁵⁰⁸ Notice of Hearings, 64 Fed. Reg. 29841 (June 3, 1999).

⁵⁰⁹ *Id.* at 29842.

⁵¹⁰ *Id.*

⁵¹¹ *Id.*

⁵¹² See USPTO Report, *supra* note 316, at 3. The USPTO’s 1994 inquiry had received only approximately ten responses. See *id.* at 14.

Media, the New Mexico Book Association, two state universities, and two Congressional offices; twenty-five responses came from individuals or from Native American tribal representatives identifiable as such by their names.⁵¹³

This can hardly be said to be a representative cross-section of opinion of the nearly 600 federally recognized Native American tribes.⁵¹⁴ Of course, U.S. government communications are not always user-friendly, and intellectual property issues can be complex, even when the intended audience has the necessary educational and business background. It would not be surprising, though, if the considerable advance notice and written preparation requirements were off-putting obstacles, especially for participants wanting only to testify orally. Financial and travel burdens were likely also to have been insurmountable for many potential participants, particularly since many indigenous U.S. peoples live in remote locations, far from the three scheduled testimony points, including in Alaska and Hawaii.

The USPTO, however, apparently viewed its actions as tantamount to taking all “appropriate additional measures, including field hearings, to obtain as wide a range of views as possible” from North American tribes.⁵¹⁵ Based on this miniscule sampling of indigenous opinion, the USPTO posted written comments and hearing transcripts on its website several months earlier than the Congressionally imposed deadline of September 30, 1999.⁵¹⁶

The USPTO Report recommended that it “should create, maintain, and update” an “accurate and comprehensive database containing the official insignia of all State and federally recognized Native American tribes.”⁵¹⁷ It concluded that existing trademark law already provided legal tools sufficient to prohibit registration

⁵¹³ *Id.* at 4–6.

⁵¹⁴ See Indian Entities Recognized and Eligible to Receive Services from the United States Bureau of Indian Affairs, 68 Fed. Reg. 68180 (Dec. 5, 2003) (giving notice of “the current list of 562 tribal entities recognized and eligible for funding and services from the Bureau of Indian Affairs by virtue of their status as Indian tribes”).

⁵¹⁵ Trademark Law Treaty Implementation Act, Pub. L. No. 105-330, § 302(b)(1), 112 Stat. 3064 (1998).

⁵¹⁶ See USPTO Report, *supra* note 316, at 3.

⁵¹⁷ *Id.* at 47.

of official insignia or simulations in cases where the applicant is not the tribal owner.⁵¹⁸ It deemed new legislation aimed at examination and registration unnecessary, as this could potentially cause unforeseen complications for innocent parties.⁵¹⁹ The agency concluded that both retrospective and prospective changes in existing law would be unfair to members of the public who had in good faith been using terms or designs similar or identical to tribal insignia before the USPTO Report, so long as they did not intend to associate themselves falsely with a tribe and their goods or services were not so associated in the minds of consumers.⁵²⁰

The agency also recommended against amending Lanham Act §2b,⁵²¹ which prohibits registration of a mark that “[c]onsists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.”⁵²² The USPTO concluded that additional protection was not necessary “and might risk violation of U.S. international treaty obligations if it [offered] exclusive trademark protection to a particular indigenous group.”⁵²³

In the fall of 2003, USPTO personnel confirmed that, more than four years after its inception, the entire Database consisted only of five tribal insignia.⁵²⁴ Usage was believed to be low, partly because, as even the USPTO admits, the Database is mainly useful to examiners, and there are no immediate advantages to trademark

⁵¹⁸ See *id.* at 44.

⁵¹⁹ See *id.*

⁵²⁰ See *id.* at 26.

⁵²¹ MCCARTHY, *supra* note 490, § 25:67.1, at 25-151.

⁵²² 15 U.S.C. § 1052(b) (2001); see also MCCARTHY, *supra* note 490, § 25:67.1, at 25-151 n.3; cf. MCCARTHY, *supra* note 490, § 25:67.1, at 25-154 (citing *Mohegan Tribe of Indians of Conn. v. Mohegan Tribe and Nation, Inc.*, 255 Conn. 358, 769 A.2d 34 (Conn. 2001) (holding “that one group of people from the Mohegan Indian tribe could not prevent another group of Mohegans from using the terms ‘Mohegan’ and ‘Mohegan Tribe’ because the designation ‘Mohegan’ was a generic name for all Native American Indians of Mohegan descent”)).

⁵²³ USPTO Report, *supra* note 316, at 45.

⁵²⁴ Telephone Interview with Ari Liefman, Trademark Examining Attorney, Office of the Commissioner for Trademarks (Oct. 10, 2003) [hereinafter Liefman Interview] (on file with author). At the time of the interview, the agency had, however, just completed the positive step of sending out a mass mailing about the Database to all recognized tribes, in an effort to raise awareness. *Id.*

owners that would provide an incentive to participate.⁵²⁵ Tribes that do register their insignia in the Database are not, on this basis alone, afforded any of the benefits of trademark registration.⁵²⁶ Rather, tribal owners must separately register their insignia as trademarks—and they must themselves pay the concomitant administrative and legal fees to do so—before trademark protection is available.⁵²⁷ Low participation may also be due to somewhat cumbersome Database registration requirements.⁵²⁸

All of the foregoing factors tend to show that the Database, despite official representations to the contrary at international meetings, does not offer any broad or meaningful legal protection for indigenous TKGRF, nor does its creation signify any significant governmental policy interest in indigenous TKGRF protection.

IV. HOW COULD U.S. LAW BE EXPANDED TO GIVE GREATER PROTECTION TO INDIGENOUS TKGRF, YET STILL REMAIN WITHIN ESTABLISHED REGIMES OF WESTERN INTELLECTUAL PROPERTY LAW?

Limited, but still meaningful, improvement in U.S. TKGRF protection could be attained within a relatively short time period by amending or improving implementation of current laws that specifically address Native American TKGRF.⁵²⁹ As discussed above, more meaningful implementation of the Indian Arts and Crafts Act, through prompt amendment of its trademark provisions, expansion of state certification mark programs, greater enforcement of the Federal Trade Commission Act within a TKGRF context, and more substantial use of the USPTO's Database of Native American Tribal Insignia, is a necessary step toward greater TKGRF protection in the U.S.⁵³⁰

⁵²⁵ *Id.*; see also USPTO, *FAQ*, *supra* note 22 (at response to question 8).

⁵²⁶ See USPTO, *FAQ*, *supra* note 22 (at response to question 6).

⁵²⁷ See *id.*; see also USPTO, *Basic Facts About Trademarks*, at <http://www.uspto.gov/web/offices/tac/doc/basic> (last modified Nov. 8, 2004).

⁵²⁸ See USPTO, *FAQ*, *supra* note 22 (at response to question 5).

⁵²⁹ See *supra* Part III.

⁵³⁰ See *supra* Part III.A.

A further, important step, which respects current U.S. policy goals, is to expand indigenous use of U.S. intellectual property laws generally through: 1) wider use of certification and collective trademarks by indigenous creators;⁵³¹ 2) increased use by indigenous groups of Lanham Act §2 to prevent offensive or disparaging trademark registrations;⁵³² 3) expansion of the current moral rights regime, particularly on the state law level;⁵³³ and 4) establishment of a domestic system of geographical indications law for TKGRF protection.⁵³⁴ These topics are discussed below and followed by general observations on U.S. law and policy concerning TKGRF.

A. Encourage Wider Indigenous Use of Current Trademark Tools

Present U.S. trademark law contains provisions that could be more effectively implemented to provide indigenous U.S. peoples with better protection of certain TKGRF. In particular, two special types of trademarks, certification marks⁵³⁵ and collective marks,⁵³⁶ could be more frequently and effectively used to protect Native American products and services that embody or are derived from TKGRF. The trademark provisions of IACA should be redrafted as explained above.⁵³⁷ Its implementation should be as originally intended,⁵³⁸ but *with special emphasis on certification and collective marks*. Specialized, free legal expertise concerning certification and collective marks in the TKGRF context should also be made available to Native Americans wishing to take advantage of an amended IACA trademark program. Section 2(a) of the Lanham Act, which prevents registration of offensive or disparaging marks, could be publicized and used more widely by indigenous U.S. populations and others to ensure proper treatment of TKGRF in the trademark field. The resulting body of

⁵³¹ See discussion *infra* Part IV.A.1–2.

⁵³² See discussion *infra* Part IV.A.3.

⁵³³ See discussion *infra* Part IV.B.4.

⁵³⁴ See discussion *infra* Part IV.C.

⁵³⁵ See *generally* Trademark Act of 1946 (Lanham Act), 60 Stat. 427 (codified as amended in scattered sections of 15, 17, and 28 U.S.C.) (2004).

⁵³⁶ See *id.*

⁵³⁷ See *supra* notes 421–29 and accompanying text.

⁵³⁸ See *supra* notes 414–19 and accompanying text.

interpretive law in this area could delineate constitutional boundaries of any new legislation that might give special protection to indigenous TKGRF.

However, a major limitation of all trademark law for protecting TKGRF is that trademarks are merely indicators that provide reliable information about the source of goods and services to consumers, to prevent confusion as to origin.⁵³⁹ Trademarks offer no protection for the actual knowledge itself; they protect only the source designation of products (whether goods or services) created from that knowledge, and they are applicable only in a commerce-oriented context.⁵⁴⁰ But for portions of TKGRF that indigenous groups do wish to commercialize, trademark law could be quite useful in delineating indigenous origin and production methods, as well as in educating the larger public about and creating wider respect for traditional goods and services.

1. Certification Marks and TKGRF

As previously mentioned in the Saami example, one of the concerns among indigenous people is that their knowledge, creations, and methods of creation may be taken by others, without authorization, and used in a manner that does not reflect indigenous origin at all or used to create another work that is not authentic and does not embody proper respect for the indigenous source society.⁵⁴¹ In the context of the U.S., this means that goods or services may be passed off as “Indian” or as somehow originating in Indian culture, when actually they do not. While IACA resolves some of this issue in the arts and crafts area, it does not address TKGRF material that is neither art nor craft.⁵⁴² And though the Federal Trade Commission (FTC) Act may also address part of the problem in the commercial context,⁵⁴³ neither of these federal statutes facilitates development of public awareness of the specific identities, geographic homes, and creative contributions to

⁵³⁹ See generally 15 U.S.C. § 1127 (2004).

⁵⁴⁰ *Id.*

⁵⁴¹ See *supra* notes 68–77 and accompanying text.

⁵⁴² See generally IACA, Pub. L. No. 101-644, 104 Stat. 4662 (1990) (codified as amended in scattered sections of 18 U.S.C., 20 U.S.C., 25 U.S.C., 42 U.S.C.).

⁵⁴³ See generally 15 U.S.C. § 45 (2004).

U.S. society by the wide variety of indigenous groups in the United States. This is a key facet of what indigenous groups are rightfully asking for now: greater recognition of who they are and their specific contributions to our present society.⁵⁴⁴

For many indigenous groups, their geographical origin is an important part of their societal identity. In light of the unique interdependence of many indigenous communities with their local natural environments,⁵⁴⁵ this is not surprising. Only two areas of established intellectual property law, however, afford protection based on geographic origin: 1) geographical indications, which are discussed further below and which have not traditionally existed in U.S. law,⁵⁴⁶ and 2) and certification marks, which exist within the larger body of trademark law.⁵⁴⁷ Neither of these methods of protection has been greatly emphasized in international TKGRF discussions, but both may offer a partial solution for certain kinds of TKGRF protection.

Until the signing of TRIPS, the only method available in the U.S. for registering a property right in a geographic source indicator was by registering a certification mark with the Trademark Office.⁵⁴⁸ The Lanham Act defines a certification mark as:

any word, name, symbol, device or any combination thereof . . . used by a person *other than its owner* . . . to certify regional or other origin, . . . material, mode of manufacture, . . . or other characteristics of such person's good or services or that the work or labor on the goods or services was performed by members of a[n] . . . organization.⁵⁴⁹

⁵⁴⁴ See Press Release, George W. Bush, President of the United States, National American Indian Heritage Month Proclamation (Nov. 19, 2001), <http://www.whitehouse.gov/news/releases/2001/11/20011112-4.html>; see generally *Systematic Analysis*, *supra* note 25.

⁵⁴⁵ See *Presentation on Experiences*, *supra* note 239, at Annex III.

⁵⁴⁶ See discussion *infra* Part IV.C.

⁵⁴⁷ See 15 U.S.C. § 1127 (2004).

⁵⁴⁸ See MCCARTHY, *supra* note 490, at § 19:90.

⁵⁴⁹ 15 U.S.C. § 1127 (2004) (emphasis added).

The purpose of a certification mark thus differs somewhat from that of a “regular” trademark or service mark: a certification mark is owned by one party but used by others to certify that their goods or services conform to specified characteristics (which can include geographic or labor origins) set by the owner.⁵⁵⁰

In the U.S. federal trademark system, there is no government control over the standards that are set for using any particular certification mark, apart from those for certification marks owned by the government itself.⁵⁵¹ Instead, the mark owner sets the relevant standards.⁵⁵² Then the owner convinces consumers, usually via advertising, that his certification system provides useful and reliable information about the quality and origins of associated products.⁵⁵³ This means that a Native American tribe, for example, could organize an entity to register a certification mark for tribal products or services and could require that they actually be produced or performed by tribal members, using only specified components and particular traditional methods. Producers not meeting these standards would not, by definition, have access to use of the mark. Consumers would, over time, come to associate the certification mark only with tribal products of a particular quality and method of production.

There are special criteria for certification mark registration and maintenance in the U.S. A certification mark may not be registered, and it is grounds for cancellation of an otherwise valid mark, if the owner of the mark:

- (A) does not control . . . the use of such mark, or (B) engages in the production or marketing of any goods or services to which the certification mark is applied, or (C) permits the use of the certification mark for purposes other than to certify, or (D) discriminately refuses to certify or to continue to certify the goods or services of any person who

⁵⁵⁰ MCCARTHY, *supra* note 490, at § 19.91.

⁵⁵¹ *See id.*

⁵⁵² *See id.*

⁵⁵³ *See id.*

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maintains the standards or conditions which such mark certifies⁵⁵⁴

A certification mark thus functions as a kind of guarantee of certain characteristics common to the certified goods or services, rather than as a direct indicator of source.⁵⁵⁵ A certifier-owner also cannot produce goods under the certification mark, however, because the party who is setting the standards for certification is presumed to lose his objectivity concerning those standards if he is also a competitor in the same market.⁵⁵⁶

Additionally, the certifier-owner cannot refuse to license the mark to anyone who meets the standards for using the mark, so the owner needs to think carefully about the characteristics of the audience to whom he will be required to license, in addition to the desired qualities of the certified goods themselves, when setting certification standards.⁵⁵⁷ In the TKGRF context, then, it might be especially important to require the creation of goods solely by tribal members or exclusively by using a form of traditional knowledge in the production methods, which could require supervision by shamans or other indigenous authorities. Because the tribe itself could not own a certification mark and also sell the certified products and services, it would probably want to form some other legal entity to own the mark.

It may be possible to develop common law rights in a certification mark without registering it federally, so long as the mark owner defines and requires adherence to certification standards.⁵⁵⁸ The Restatement (Third) of Unfair Competition and at least one court in the Eighth Circuit have stated that such common law rights can be created in certification marks.⁵⁵⁹ For indigenous groups unable to raise the fees associated with registering a federal certification mark, this might provide a viable, if somewhat risky, strategy for establishing a certification mark.

⁵⁵⁴ 15 U.S.C. § 1064(5) (2001).

⁵⁵⁵ See MCCARTHY, *supra* note 490, at § 19:94.

⁵⁵⁶ See *id.*

⁵⁵⁷ See *id.*

⁵⁵⁸ See MCCARTHY, *supra* note 490, at § 19:90.

⁵⁵⁹ See *id.* (citing *Black Hills Jewelry Mfg. Co. v. Gold Rush, Inc.*, 633 F.2d 746 (8th Cir. 1980); RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 18 (1995)).

Of course, such a mark might be judicially determined to have inherent local geographic and market limitations, a problem not faced by a federally registered mark.⁵⁶⁰

Presently, only a few indigenous groups have independently registered their own federal certification marks.⁵⁶¹ The current lack of popularity of certification marks among indigenous U.S. groups may result from various sources. First, lack of information among indigenous people about these specialized types of marks is extremely likely, since detailed knowledge and understanding about trademarks in general is probably very limited among all U.S. citizens who are not trademark attorneys. Second, registering a trademark requires paying a fee,⁵⁶² and usually also attorneys' fees, and this can present a substantial obstacle to many indigenous groups. Third, proper use of certification marks requires considerable effort on the part of the mark owner to set standards and to ensure that producers' goods and services consistently meet them.⁵⁶³ At the very least, this requires some sort of centralized

⁵⁶⁰ See Lourie Statements, *supra* note 212.

⁵⁶¹ Author's search of USPTO registration information (conducted on April 26, 2003, using the *TESS* search engine (*see supra* note 416)), specifically for certification marks containing such terms as "Native American," "Indian," "American Indian," "Eskimo," "Aleut," "Shaman," "Apache," "Arapaho," "Navajo," "Hopi," "Zuni," "Sioux," "Lakota," "Tulalip," "Six Nations," "Athabaskan," "Yupik," "Inuit," "Tribe," "Tribal," and other similar terms revealed four such live marks. Three of these marks belong to the Council of the Cowichan Indian Band in Canada (certification mark registration numbers 2222979, 2219102, and 2221870), and one mark belongs to Mountain Chief Corp. in Montana (certification mark registration number 2392744). The latter mark certifies that goods using the mark are made by Native Americans. Another certification mark (registration number 1384860), owned by the Council of American Indian Artists Charitable Trust, was registered but has been cancelled for over ten years.

The author conducted a similar series of searches in connection with collective marks. These searches obviously are not exhaustive, and special marks not containing the designated keywords in their registration documentation are not identified in these searches. The author offers no conclusions concerning the status of any other type of U.S. trademark that may be held by indigenous groups, since, according to USPTO personnel, there is no way to verify accurately how many standard trademarks and service marks may be owned by indigenous groups. Liefman Interview, *supra* note 524.

⁵⁶² See Basic Facts About Trademarks, *Application Filing Fee*, at <http://www.uspto.gov/web/offices/tac/doc/basic/appcontent.htm#fee> (last modified Nov. 8, 2004). The current registration fee is \$375 for paper filings and \$325 for electronic filings. See FY 2005 Fee Schedule, *Trademark Processing Fees* (Jan. 4, 2005), <http://www.uspto.gov/web/offices/ac/qs/-ope/fee2004oct1.htm>.

⁵⁶³ See 15 U.S.C. § 1064(5) (2004).

record keeping and quality control, which may be costly and hard for indigenous owners (or anyone else) to establish and consistently maintain.

If these obstacles could be overcome, however, certification marks could be far more valuable than standard trademarks for protecting some Native American TKGRF. While standard trademarks identify only the source of goods or services, certification marks can convey much more specific quality, labor, and geographic origin information to consumers, who may in turn become loyal to that mark over time.

2. Collective Marks and TKGRF

Another special type of trademark that could be useful in the TKGRF context is the collective mark. A collective mark is a trademark or service mark used by the members of a cooperative, an association, or other collective group or organization.⁵⁶⁴

There are two different types of collective marks.⁵⁶⁵ The first type is used to identify members of a particular group, all of whom produce specific goods or services; it is intended to show that the relevant goods or services are produced by qualifying members meeting the membership standards of the organization.⁵⁶⁶ In contrast to certification marks, qualification is based on the producer's ability to meet the standards for membership in the group, rather than whether the attributes of his goods and services meet specified standards.⁵⁶⁷ The second type of collective mark can be thought of as a collective membership mark, and members of a group or organization use this kind of mark merely to show their membership in that entity.⁵⁶⁸ This type of collective mark is the only registrable symbol not used by the sellers of anything; it merely reflects membership and does not refer at all to goods or services.⁵⁶⁹

⁵⁶⁴ See *id.* § 1127.

⁵⁶⁵ MCCARTHY, *supra* note 490, § 19:99.

⁵⁶⁶ See *id.*

⁵⁶⁷ See *id.*

⁵⁶⁸ See *id.*

⁵⁶⁹ See *id.* § 19:101.

Both types of collective marks are of interest for indigenous TKGRF protection because, while either could be used to show the creator's membership in an Indian arts and crafts organization or tribe or other ethnic group, neither would require the exacting product standards and quality control of a certification mark.⁵⁷⁰ A collective mark would thus be less difficult and expensive to register and maintain than a certification mark.⁵⁷¹ If appropriately structured, the first type of collective mark could communicate much of the same information about indigenous producers as might a certification mark. And collective marks could provide a potential intermediate vehicle through which to create public awareness of specific tribes and of individuals' membership in those tribes, for later development into certification mark standards. A collective membership mark might also be used to promote useful public awareness of tribal identity, even if the mark were only indirectly linked to TKGRF.

Like certification marks, collective marks originated at common law, when clubs, churches and schools often had "trade names" protected under common law unfair competition principles developed prior to the Lanham Act.⁵⁷² This characteristic may allow some indigenous groups, initially unable (for financial or other reasons) to register formal collective marks, to develop unregistered marks to build local market identity.

At present, a few Native Americans have registered collective marks in the federal system. Among these are the Navajo Code Talkers Association,⁵⁷³ the Cowlitz Indian Tribe,⁵⁷⁴ and the Inter-Tribal Indian Ceremonial Association, Inc.⁵⁷⁵ Unfortunately, collective marks are not widely exploited by indigenous groups; probably, like certification marks, their potential for TKGRF protection is not widely understood.

⁵⁷⁰ See *id.*

⁵⁷¹ See *id.*

⁵⁷² See *id.* § 19:98.

⁵⁷³ See *TESS*, *supra* note 416 (search using registration number 2487105).

⁵⁷⁴ See *TESS*, *supra* note 416 (search using registration number 2326707).

⁵⁷⁵ See *TESS*, *supra* note 416 (search using registration number 1567693). According to its registration application, this collective association "promotes the preservation of the Native American or American Indian culture, traditions, art and related activities." *Id.*

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Collective and certification marks are registrable and enforceable in the same manner as other trademarks.⁵⁷⁶ A useful characteristic of these marks for indigenous groups—whose members may be physically isolated from population centers and each other, and who have limited financial resources—is that a registrant does not need an industrial or commercial establishment, if he maintains proper control over the mark.⁵⁷⁷

Thus, for many reasons, both collective and certification marks might be much more valuable tools than “regular” trademarks for protecting the unique characteristics of indigenous TKGRF. However, any government trademark registration program, under IACA or other legislation, must offer specialized trademark expertise and advice so that applicants may effectively utilize these specialized tools.

An effective marketing and advertising plan needs to accompany proper choice of mark and registration, to ensure optimal development of consumer awareness of the meaning and ownership of the mark.⁵⁷⁸ Since the Board’s congressional mandate under IACA encompasses identifying and developing market opportunities for Indian arts and crafts, perhaps federal funding and assistance with tribal marketing plans could also be given directly to tribes. Of course, financing and expertise for policing marks would also be needed in all cases to ensure successful goodwill development and mark maintenance after registration. If such an integrated approach were used, indigenous certification and collective marks could, over time, effectively create sophisticated consumer markets for traditional products, including public awareness of specific tribal identities, practices, and knowledge and materials components.

⁵⁷⁶ See 15 U.S.C. § 1053 (2004).

⁵⁷⁷ See *id.* § 1054 (2004).

⁵⁷⁸ See Mark Abell & Michael Stirling, *Assessing and Enhancing Trademarks’ Value*, Int’l Bar Ass’n (May 12, 2004), at <http://comml-iba.org/modules.php?name=News&file=article&sid=59>.

3. Lanham Act § 2(a)

Section 2(a) of the Lanham Act⁵⁷⁹ is another provision in the U.S. trademark law regime that could be more widely used to protect indigenous peoples' TKGRF. Though little used until recently, this section enables the USPTO to refuse to register marks that may disparage or falsely suggest a connection with persons, institutions, beliefs, or national symbols, or bring these into "contempt or disrepute."⁵⁸⁰ This provision of U.S. law is analogous to a similar provision in New Zealand's new trademark act, discussed earlier, though the New Zealand provision makes specific reference to the act's special applicability to its indigenous Maori community.⁵⁸¹

Indigenous people have not often used the U.S. provision, but it has the potential to provide unique protection against culturally and religiously offensive uses of indigenous TKGRF by third parties—uses that might in many other contexts be protected by the First Amendment.⁵⁸² Its drawback, of course, is that it applies only to offensive uses in connection with federal trademarks,⁵⁸³ an inherently narrow segment of TKGRF material.

Under Lanham Act § 2(a), the test for false suggestion of a connection requires: 1) that the name point uniquely to the opposer and be unmistakably associated with the person or institution opposing the mark application, and 2) that a connection with the

⁵⁷⁹ See 15 U.S.C. § 1052 (2004).

⁵⁸⁰ *Id.* § 1052(a) ("No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—(a) [c]onsists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.")

⁵⁸¹ See Trade Marks Act, cl. 17, 2002 (N.Z.), available at <http://www2.piperpat.co.nz/tmlaw/s000.html> (last visited Nov. 12, 2004). Among other things, in clause 17, it updates the registrability standard, which previously prohibited marks that were "scandalous" or "contrary to law or morality." See Trade Marks Act, cl. 16(1), 1953 (N.Z.) (repealed 2002), available at <http://www2.piperpat.co.nz/tmlaw/tmact.html>. It will, instead, now prohibit marks that are "likely to offend a significant section of the community, including Maori." Trade Marks Act, cl. 17(1)(b)(ii), 2002 (N.Z.). See also *supra* note 243–45 and accompanying text.

⁵⁸² See U.S. CONST. amend. I.

⁵⁸³ See 15 U.S.C. § 1052(a).

opposer be presumed by a potential purchaser seeing the mark used on the applicant's goods or services.⁵⁸⁴ A few religious and political groups have successfully sued, and marks such as Senussi (the name of a Muslim religious sect) cigarettes⁵⁸⁵ and Madonna wines⁵⁸⁶ have been refused. One interesting decision of the Trademark Trial and Appeals Board ("TTAB"), made during the Cold War, held that a mark depicting a hammer and sickle with a cross through it could not be registered because it tended to disparage a national symbol of the then-Soviet Union.⁵⁸⁷ By contrast, "Buddha Beachware" was held not to be disparaging to the Buddhist religion.⁵⁸⁸

Recently, the United States District Court for the District of Columbia decided a prominent case interpreting disparaging marks.⁵⁸⁹ In *Harjo v. Pro-Football, Inc.*, the TTAB cancelled the REDSKINS trademark of the Washington, D.C. professional football team because it disparaged Native Americans.⁵⁹⁰ The D.C. District Court reversed the TTAB's finding of disparagement based on insufficient evidence and the applicability of the laches defense.⁵⁹¹ Nevertheless, *Harjo* established that "[w]hether . . .

⁵⁸⁴ See MCCARTHY, *supra* note 490, at § 19:76 (citing *United States Navy v. United States Mfg. Co.*, 2 U.S.P.Q.2d 1254 (T.T.A.B. 1987)).

⁵⁸⁵ See *id.* § 19:77 (citing *In re Reemtsma Cigarettenfabriken G.m.b.H.*, 122 U.S.P.Q. 339 (T.T.A.B. 1959)).

⁵⁸⁶ See *id.* § 19:77 (citing *In re Riverbank Canning Co.*, 95 F.2d 327 (C.C.P.A. 1938)).

⁵⁸⁷ See *id.* § 19:76 (citing *In re Anti-Communist World Freedom Congress, Inc.*, 161 U.S.P.Q. 304 (T.T.A.B. 1969)).

⁵⁸⁸ See *id.* § 19:77 (citing *In re Hines*, 32 U.S.P.Q.2d 1376 (T.T.A.B. 1994)).

⁵⁸⁹ *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96 (D.D.C. 2003). For a complete discussion of the *Harjo* decision, see generally Rachel Clark Hughley, *The Impact of Pro-Football Inc. v. Harjo on Trademark Protection of Other Marks*, 14 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 327 (2004).

⁵⁹⁰ 50 U.S.P.Q.2d 1705, 1743 (T.T.A.B. 1999), *rev'd* *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96 (D.D.C. 2003).

⁵⁹¹ *Harjo*, 284 F. Supp. 2d at 145. "The Court's conclusions in this case, as to the sufficiency of the evidence before the TTAB and the applicability of the laches defense, should *not* be interpreted as reflecting, one way or the other, this Court's views as to whether the use of the term 'Washington Redskins' may be disparaging to Native Americans." *Id.* at 98.

trademarks disparage Native Americans is ultimately a fact-bound conclusion that rests with the fact-finder in the first instance.”⁵⁹²

Prior to *Harjo*, the TTAB and the Federal Circuit judged applications according to whether they would be considered disparaging by a “substantial composite” of the general public.⁵⁹³ In cases of doubt, opposing applications were published so that any disparagement determination could be based on public response, rather than on the TTAB’s own judgment as to what constitutes offensiveness.⁵⁹⁴

In *Harjo*, although not at issue on appeal, the D.C. District Court found no error in the TTAB’s approach to the “disparagement” inquiry.⁵⁹⁵ The TTAB determined that the “scandalous” and the “may disparage” language of the statute constitute two distinct bars to registration, each involving an independent analysis.⁵⁹⁶ “Scandalous” looks to the reaction of U.S. society as a whole to the usage, while “may disparage” targets an identifiable group of persons.⁵⁹⁷ Only the perceptions of the specific, identifiable group’s members are relevant in a “may disparage” determination.⁵⁹⁸ Evaluating the “may disparage” language involves a two-step process: 1) determining whether the designation would be understood as referring to persons in an identifiable group, and 2) determining whether the designation is viewed as disparaging (or offensive) by a “substantial composite” of the persons in that identifiable group.⁵⁹⁹ The TTAB thus found that the REDSKINS registration disparaged Native Americans, *as perceived by a substantial composite of Native Americans*,

⁵⁹² *Harjo*, 284 F. Supp. 2d at 117 (“The issue of disparagement, like the issue of likelihood of confusion, requires a fact-based judgment that depends heavily on the particular circumstances of each case.”).

⁵⁹³ See MCCARTHY, *supra* note 490, § 19:77 (citing *In re Malvety Media Group*, 33 F.3d 1367 (Fed. Cir. 1994)).

⁵⁹⁴ See *id.* (citing *In re Hines*, 32 U.S.P.Q.2d 1376 (T.T.A.B. 1994)).

⁵⁹⁵ See *Harjo*, 284 F. Supp. 2d at 124.

⁵⁹⁶ See *Harjo*, 50 U.S.P.Q.2d at 1738; see generally MCCARTHY, *supra* note 490, § 19:77.1.

⁵⁹⁷ See *Harjo*, 284 F. Supp. 2d at 124.

⁵⁹⁸ See *Harjo*, 50 U.S.P.Q.2d at 1739.

⁵⁹⁹ See *id.* at 1739. “Offensive” was viewed by the TTAB as the equivalent of the “disparaging” test. See *id.* at 1734 n.86. According to the TTAB, a “substantial composite” can be less than a majority if it is “an appreciable number.” *Id.* at 1746 n.120.

although the district court found this determination not to be supported by substantial evidence.⁶⁰⁰

Determining disparagement by analyzing the target group, rather than by viewing U.S. society as a whole, provides a more clearly defined standard for indigenous opposers to meet. Where the specific customs, practices, and religious beliefs of the offended group are not widely known to the U.S. population at large, the standard provides courts with identifiable criteria to determine disparagement.⁶⁰¹ This recent interpretation of the law may noticeably increase the usefulness of Lanham Act § 2(a) for protecting indigenous TKGRF.⁶⁰²

Also useful is the fact that standing to sue under this law is extremely broad.⁶⁰³ Individuals can bring suit even though they are not representatives of a disparaged group—mere moral outrage at a potential registration can be sufficient.⁶⁰⁴ This would tend to eliminate problems that might otherwise arise if, for example, a person wishing to sue in a TKGRF-related situation is not a formally enrolled member of the relevant tribe or is a member of a tribe not formally recognized by federal authorities and thus unable to sue under other laws such as IACA.⁶⁰⁵ It also would appear to allow any member of the U.S. public, whether an indigenous person or not, to bring suit.⁶⁰⁶

⁶⁰⁰ See *id.* at 1743.

⁶⁰¹ See *Harjo*, 284 F. Supp. 2d at 124 n.25.

⁶⁰² Although the TTAB's holding was reversed, the disparagement standard established by the TTAB in *Harjo* remains the standard used by TTAB and the Federal Circuit to determine if a mark is disparaging. See, e.g., *In re Mothers and Fathers Italian Ass'n*, 2000 TTAB LEXIS 52, at *6; *Boswell v. Malvety Media Group*, 52 U.S.P.Q.2d 1600 (T.T.A.B. 1999); *Order Sons of Italy in Am. v. Memphis Mafia, Inc.*, 52 U.S.P.Q.2d 1364 (T.T.A.B. 1999). The standard announced in *Harjo* was applied in each of these cases.

⁶⁰³ See MCCARTHY, *supra* note 490, § 19:77.2 (discussing the ease of establishing standing under Lanham Act § 2(a)).

⁶⁰⁴ See *id.* § 19:77.1 (citing *Ritchie v. Simpson*, 170 F.3d 1092 (Fed. Cir. 1999); *Bromberg v. Carmel Self Serv., Inc.*, 198 U.S.P.Q. 176 (T.T.A.B. 1978)).

⁶⁰⁵ Pub. L. No. 101-644, 104 Stat. 4662 (1990) (codified as amended in scattered sections of 18 U.S.C., 20 U.S.C., 25 U.S.C., 42 U.S.C.).

⁶⁰⁶ Cf. MCCARTHY, *supra* note 490, § 19:77.2 (stating that offended individuals in a non-commercial group may have standing to sue, even though such members are not affected in a related business and have not suffered commercial damages) (citing *Bromberg*, 198 U.S.P.Q. 176)).

U.S. trademark law thus has several features that could be exploited more effectively by indigenous communities and on a much broader scale, at least for the TKGRF that tribes wish to commercialize. In combination with redrafting the trademark provisions of IACA,⁶⁰⁷ greater education and government support are also needed to encourage widespread tribal use of amended IACA benefits and the USPTO's existing tribal insignia database. Certification marks, collective marks, and the preventive provisions of Lanham Act §2(a) are tools available in the current intellectual property law that could also be more widely used for greater protection of indigenous TKGRF.

While wider use of trademark varieties and registration features could help Native Americans establish and demarcate markets for their traditional products (and, potentially, services—such as traditional healing practices), trademarks cannot legally sequester the traditional knowledge itself from use by others.⁶⁰⁸ Also, specialized trademarks, like patents, require considerable, expensive legal expertise for proper mark registration and later enforcement, which may be virtually unobtainable by many indigenous groups.⁶⁰⁹

B. Expand State and Federal Moral Rights Protections

U.S. moral rights law, if expanded and developed, might also afford some interesting and creative avenues of protection for indigenous TKGRF. Moral rights are new to the U.S. legal system,⁶¹⁰ but they are well-developed in many civil law copyright systems and are a familiar part of the intellectual property law regime in most of the world.⁶¹¹

1. Background

Consideration of this issue in the TKGRF context requires comparing the underlying philosophies of U.S. intellectual

⁶⁰⁷ See discussion *supra* Part III.A.

⁶⁰⁸ See *supra* notes 539–40 and accompanying text.

⁶⁰⁹ See *supra* note 135 and accompanying text.

⁶¹⁰ See MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 8D.02[A] (2003) (discussing the adoption of moral rights under U.S. intellectual property law).

⁶¹¹ See *id.* § 8D.01[A] (discussing the basis of French copyright law).

property law with its European and international treaty counterparts and examining the protection goals of TKGRF owners.

The general idea behind U.S. patent and copyright law is that an inventor or artist should be granted a period of monopoly control over his or her creation during which he or she may reap any associated economic rewards.⁶¹² Thereafter, the creation falls into the public domain and may be freely used by others for personal enjoyment or further creative uses.⁶¹³ In theory, without such a period of monopoly control, little or no incentive to create exists, because a would-be creator knows he or she will later face ruinous competition from subsequent innovators who can freely exploit the work without incurring the same initial costs of creation. Subsequent innovators bear but only the incremental costs of reproducing and distributing their innovations.⁶¹⁴

This strictly economics-based model of intellectual property has traditionally been the sole measure of “the Progress of Science and useful Arts”⁶¹⁵ in the United States. In the TKGRF context, then, an inherent limitation of the U.S. view is that it values only the economic potential of a creative work and is aimed at maximizing innovation via commercialization.⁶¹⁶ By contrast, TKGRF often is considered to have intrinsic value apart from the marketplace, and, while indigenous owners sometimes may wish to commercialize all or part of their TKGRF, in other cases, they may prefer to prevent its use and dissemination.⁶¹⁷

In contrast to the U.S. model, European intellectual property law has not been shaped solely by economic theory, but by other useful concepts as well. One such concept is moral rights, or *le droit moral*.⁶¹⁸ The idea is that, at the time of creation of a literary

⁶¹² See *id.* § 1.05[D] (discussing the reasoning for limiting the period of copyrights).

⁶¹³ See *id.*

⁶¹⁴ See *id.* § 1.03[A] (discussing the purposes of copyrights as an incentive to creativity).

⁶¹⁵ See U.S. CONST., art. I, § 8, cl. 8.

⁶¹⁶ See NIMMER & NIMMER, *supra* note 610, § 1.03[A] (discussing the purposes of copyright as an incentive to creativity).

⁶¹⁷ See, e.g., *supra* notes 71–76 and accompanying text; cf. NIMMER & NIMMER, *supra* note 610, § 8D.01[A] (discussing the view that certain works deserve value for non-economic reasons and that moral rights are owed to the creator of a work).

⁶¹⁸ See generally NIMMER & NIMMER, *supra* note 610, § 8D.01[A].

or artistic work, some part of the artist's own being or personality is incorporated into the work, and, as a result, certain perpetual rights arise in the artist that can affect future treatment of the work.⁶¹⁹ These so-called "moral" rights are often thought to be non-transferable because they are inherent in, and arise solely from, the unique relationship between the artist and the creation.⁶²⁰ Moral rights, however, generally can be waived by the artist, and

⁶¹⁹ *Id.* Nimmer notes, as many English-speaking legal scholars have, that English terminology for various legal concepts found in *le droit moral* is both off-putting and unfortunate. *Id.* The author agrees with this observation and believes that this translation problem is especially acute for U.S. citizens who, on the one hand, are still widely influenced by their Puritanical heritage, yet, on the other hand, are equally devoted to personal freedoms guaranteed by the First Amendment and the developing law of personal privacy. Might the U.S.'s general lack of understanding of or interest in the European moral rights tradition—and resistance to incorporating moral rights into our jurisprudence—stem in part from the somewhat offensive and overly intimate connotations conveyed by the English-language terms for core concepts in this area of law? The French "droit morale," "personnalité," "traitement dérogatoire," and "droit de divulgation" are often directly translated into English as "moral rights," "personality," "derogatory treatment," and "right to divulge," respectively. See DENIS GIRARD, *THE NEW CASSELL'S FRENCH DICTIONARY* 254, 265, 270–71, 496, 556, 729 (1982). These words, at least in the U.S. cultural context, are enthymemes carrying strong underlying connotations. See NIMMER & NIMMER, *supra* note 610, § 8D.01[A]. It is not at all clear that the English terms accurately convey their French (European) conceptual counterparts, and it seems likely that they imply pejorative or negative connotations that are in fact not present in the original terms. See S. RICKETSON, *THE BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS: 1886–1986* § 8.112 (1987).

Non-native readers may be confused further by the various French terms used by French legal scholars to describe concepts that in U.S. law have only one meaning and a single nomenclature. For example, current U.S. copyright law uses the term "works of authorship." By comparison, French legal writer Henri Desbois uses the term *oeuvres de l'esprit* ("works of the spirit") to describe what are apparently works of authorship when he discusses the dual system of French copyright law. See HENRI DESBOIS, *LE DROIT D'AUTEUR EN FRANCE* (2d ed. 1978). In that system, intellectual and moral rights (*droit intellectuelle et moral*) take legal precedence over their associated economic rights of copyright (*droits d'auteur*). *Id.* By contrast, another French legal scholar, A. Chambellan, uses the term "works of the intellect" to refer, apparently, to these same works in her English-language summary of French copyright law. See *generally* INTELLECTUAL PROPERTY LAWS OF EUROPE (George Metaxas-Maranghidis ed., 1995).

In the TKGRF context, because of the spiritual or sacred element present in much indigenous creative material, these subtle linguistic and conceptual distinctions could become exceedingly important when assessing whether particular types of Western law may be suitable for protecting specific TKGRF.

⁶²⁰ See NIMMER & NIMMER, *supra* note 610, § 8D.01[B] (citing GAVIN, *LE DROIT MORAL DE L'AUTEUR* § 255 (1960)). Many national laws prohibit the transfer of moral rights. See RICKETSON, *supra* note 619, § 8.104.

thus extinguished permanently, when the work is sold or otherwise transferred to a third party.⁶²¹ In contrast to the United States, moral rights protections in the civil law tradition are usually widely available to the creator of any artistic, literary, or musical work.⁶²²

Moral rights originated in France in the 19th century, and they still remain stronger there than in any other country.⁶²³ But moral rights have since been incorporated into the legal regimes of many other European countries, including Germany, where they are known as *das Urheberpersönlichkeitsrecht* (“the author-personality right”),⁶²⁴ and Italy, where they are known as *il diritto d'autore* (“the right of the author.”).⁶²⁵ Moral rights are well-established in the law of many developing countries, particularly those that were colonized by France or Belgium and that have continued Napoleonic Code and other French legal traditions, including, for example, Senegal, the Congos, Benin, the Central African Republic, Cameroon, and Gabon.⁶²⁶ Moral rights have also long been recognized in Mexico and throughout much of Central and Latin America.⁶²⁷ The trend among common law countries now is to recognize these rights, at least to some degree, and the United States, Australia, and Great Britain have all passed protective legislation in this area since 1990.⁶²⁸ The Berne

⁶²¹ See NIMMER & NIMMER, *supra* note 610, § 8D.01[B] (stating that nothing in the Berne Convention requires unwaivability).

⁶²² See RICKETSON, *supra* note 619, § 8.92. For a discussion on U.S. moral rights law, see *infra* Part IV.B.2.

⁶²³ See RICKETSON, *supra* note 619, § 8.93–.94.

⁶²⁴ Colleen P. Battle, Note, *Righting the ‘Tilted Scale:’ Expansion of Artists’ Rights in the United States*, 34 CLEV. ST. L. REV. 441, 446 (1985/86).

⁶²⁵ See RICKETSON, *supra* note 619, at § 8.94–.101; see also Italian Copyright Act, arts. 20–24, available at http://www.certh.gr/cordis/t_en/p/it/p_r51_en.asp-addid=1010.htm (last visited Sept. 23, 2004).

⁶²⁶ See RICKETSON, *supra* note 619, § 8.104 n.510.

⁶²⁷ Cf. *Report on the Review of Existing Intellectual Property Protection of Traditional Knowledge*, at 2–5, WIPO, Intergovernmental Comm. on Intell. Prop. & Genetic Resources, Trad. Knowledge & Folklore (WIPO/GRTKF/IC/4/7) (Nov. 5, 2002) [hereinafter *Existing IP Protection Report*], http://www.wipo.int/documents-en/meetings/2002/igc/pdf/grtkf_ic_4_7.pdf (last visited Nov. 16, 2004).

⁶²⁸ See NIMMER & NIMMER, *supra* note 610, § 8D.06[D].

Convention's international copyright regime has also long required recognition and protection of moral rights.⁶²⁹

Legal and philosophical treatment of works of authorship can vary widely between the United States and Europe, in part because of the moral rights tradition. U.S. copyright law encourages viewing a picture or book, at least from a legal standpoint, quite superficially—merely as tangible property to be commoditized.⁶³⁰ The European moral rights tradition, on the other hand, facilitates the understanding of these same creative works as possessing not only the superficial characteristics of commodities, but also as embodying something more, i.e., an intangible part of the creator himself⁶³¹—analogous, perhaps, to that “something” that differentiates a living organism from a dead object.

This distinction becomes crucial in the TKGRF context. Some forms of TKGRF may be viewed by tribal owners as partially embodying the identity of the tribe itself, a notion analogous to moral rights concepts.⁶³² TKGRF owners may also be particularly concerned with attribution of origin and unauthorized alteration, concerns for which established moral rights law concepts (further discussed below) may provide appropriate protections.⁶³³

In addition, often the legal thinkers and policymakers at WIPO discussions who seem most open to broad TKGRF protections tend to come from civil law countries in which the moral rights tradition has long been accepted; the underlying philosophical similarities in thinking may account in part for this pattern of easier acceptance.⁶³⁴ This could also partially explain why the United

⁶²⁹ Berne Convention for the Protection of Literary and Artistic Works, art. 6bis, Sept. 9, 1886, revised July 24, 1971, 828 U.N.T.S. 221 [hereinafter Berne Convention], available at <http://www.wipo.int/clea/docs/en/wo/wo001en.htm>.

⁶³⁰ See NIMMER & NIMMER, *supra* note 610, § 1.03[A].

⁶³¹ See RICKETSON, *supra* note 619, § 8.93.

⁶³² Cf. *id.* (discussing the moral rights ideology that a work embodies a part of its creator).

⁶³³ See *infra* note 743–44 and accompanying text.

⁶³⁴ In all fairness, however, there are notable exceptions. Australia and New Zealand, both common law countries, have been pioneers in innovative exploration of legal protections for TKGRF, though not in the moral rights area *per se*. See Paul Kuruk, *Protecting Folklore under Modern Intellectual Property Regimes: A Reappraisal of the Tensions between Individual and Communal Rights in Africa and the United States*, 48 AM. U. L. REV. 769, 846 n.549 (1999). Presumably, these countries have been greatly

States' position on TKGRF is so noticeably at odds with that of so many other countries. Those delegates who have long been comfortable with *droit moral* in the copyright context may find it easier than U.S. delegates to intuit and accept analogous concepts for TKGRF protection. Longstanding familiarity with moral rights may indirectly predispose non-United States delegates toward accepting other proposed TKGRF protections, such as source attribution in patent applications or nonderogation and right of withdrawal of sacred material in copyright laws.

Historical U.S. antipathy towards moral rights law may also negatively influence U.S. views regarding TKGRF protection. Apart from not having a moral rights tradition, the United States vociferously resisted incorporating these rights into domestic copyright law for an entire century, and long refused Berne Convention membership for this reason.⁶³⁵

In the late 1970s, however, individual U.S. states, beginning with California, began enacting their own moral rights legislation.⁶³⁶ While most of these laws are noticeably more restrictive than many foreign moral rights laws, this state-based activity was extremely important, because it represented the first formal incursion of moral rights into U.S. jurisprudence.⁶³⁷ Now, a resurgence of state legislative activity could provide an effective route for expanding moral rights in the TKGRF context, and it could facilitate the spread of other TKGRF protective legislation relating to state trade secret, unfair competition, and contract laws.

motivated by their well-defined and vocal indigenous communities, in comparison to Great Britain, another common law country lacking a moral rights tradition, which lacks identifiable indigenous communities. The U.S., without a moral rights tradition but possessing easily identifiable indigenous communities, cannot be considered a similar pioneer.

⁶³⁵ See generally H.R. REP. NO. 101-514 (1990), reprinted in 1990 U.S.C.C.A.N. 6915.

⁶³⁶ See CAL. CIV. CODE §§ 987, 989 (West 1979 & Supp. 1996) (California's current moral rights statutes).

⁶³⁷ Fourteen states now have moral rights legislation. See *infra* note 681, and accompanying text.

2. Development of U.S. Domestic Moral Rights Law

To understand the protections that expanded moral rights could provide indigenous TKGRF holders, it is useful to look at the historical development of moral rights in the United States.

Moral rights law was incorporated into the U.S. system in 1988 for reasons similar to those leading to the creation of the Database for Native American Tribal Insignia, i.e., legislators made this specific concession in exchange for gaining access to broader international treaty benefits.⁶³⁸ By the late 1980s, the U.S. recognized that the advantages of harmonizing U.S. domestic law with prevailing global standards outweighed the minor inconveniences of international copyright treaty compliance, including in moral rights.⁶³⁹ Even then, however, the United States initially took the position that its domestic copyright law, substantially revamped in 1976 but still lacking any federal acknowledgement of moral rights, was sufficient to meet its Berne Convention obligations to protect moral rights.⁶⁴⁰ This argument was supported by the state legislative activity during the prior decade concerning artists' moral rights.⁶⁴¹

Only two years later, however (and perhaps unsurprisingly in light of subsequent widespread international criticism and Congress' own recognition of the inadequacy of domestic moral rights law),⁶⁴² the national legislature enacted the Visual Artists Rights Act of 1990 ("VARA").⁶⁴³ VARA formally created federal moral rights for the first time in U.S. history.

VARA recognizes moral rights only for a narrow range of visual artists, however, and even those rights are limited to strictly circumscribed rights of integrity and attribution.⁶⁴⁴ The federal law establishes conditions under which state moral rights laws are

⁶³⁸ See generally H.R. REP. NO. 101-514, *reprinted in* 1990 U.S.C.C.A.N. 6915.

⁶³⁹ See generally *id.*

⁶⁴⁰ *Id.* at 21, *reprinted in* 1990 U.S.C.C.A.N. 6915, 6917.

⁶⁴¹ *Id.* at 8, *reprinted in* 1990 U.S.C.C.A.N. 6915, 6918.

⁶⁴² *Id.*

⁶⁴³ Pub. L. No. 101-650, 104 Stat. 5128 (1990) (codified as amended at 17 U.S.C. §§ 101, 102, 106A, 107, and 601 (2004)).

⁶⁴⁴ 17 U.S.C. § 106A (2004).

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preempted,⁶⁴⁵ but the extent and nature of that preemption is by no means clear, even today. It is clear, though, that federal recognition of moral rights in the United States is still extremely limited⁶⁴⁶ and would have to be expanded considerably to provide meaningful protection in the TKGRF context. Nearly fifteen years later, VARA has been neither widely used nor extensively tested in the courts, undoubtedly because, not unlike indigenous groups, many artists do not possess the considerable financial resources required to litigate and enforce legal protection of their work.⁶⁴⁷ Nor are artists likely to incorporate effective moral rights protection in private contracts, since many lack the means to hire counsel during negotiation and drafting.⁶⁴⁸

Like VARA, the Berne Convention protects rights of integrity and of attribution.⁶⁴⁹ In the classic French *droit moral*, however, numerous other protections exist, and moral rights consist of a broad bundle of inalienable and perpetual rights belonging to the author of a creative work.⁶⁵⁰ The protected work can be within any of the creative realms normally falling within copyright law, whether literary, pictorial/graphical, or musical.⁶⁵¹ The main rights comprising classic *droit moral* are: 1) the right of attribution,⁶⁵² 2) the right to prevent others from making deforming changes in the

⁶⁴⁵ 17 U.S.C. § 301(f) (2004).

⁶⁴⁶ Sheldon W. Halpern, *Of Moral Right and Moral Righteousness*, 1 MARQ. INTELL. PROP. L. REV. 65, 66 (1997).

⁶⁴⁷ See generally Maralee Buttery, *Blanket Licensing: A Proposal for the Protection and Encouragement of Artistic Endeavor*, 83 COLUM. L. REV. 1245 (1983).

⁶⁴⁸ In light of artists' often limited financial means, an increasing number of states have established volunteer organizations that provide pro bono legal and accounting services for artists. See, e.g., Texas Accountants and Lawyers for the Arts, at <http://www.talarts.org/abouttala.htm> (last visited Nov. 16, 2004); Washington Area Lawyers for the Arts, at <http://www.thewala.org> (last visited Nov. 16, 2004).

⁶⁴⁹ See Berne Convention, *supra* note 629, art. 6bis.

⁶⁵⁰ See NIMMER & NIMMER, *supra* note 610, § 8D.02[D][1].

⁶⁵¹ See *id.* § 8D.02[A].

⁶⁵² *Le droit au respect du nom* ("right to respect of the name") or *droit à la paternité* ("right to paternity"). Nimmer explains that he uses "attribution" in place of "paternity" to avoid linguistic gender bias. NIMMER & NIMMER, *supra* note 610, § 8D.01[A] n.8. This is another example of the importation of American cultural and social mores into foreign legal terminology, whereas the original terminology may not convey such gender bias to a French audience.

work,⁶⁵³ 3) the right to publish the work or to withhold it from publication,⁶⁵⁴ 4) the right to withdraw a published work from distribution if it no longer represents the views of the author,⁶⁵⁵ and 5) the right to resale royalties from the work.⁶⁵⁶

The French right of attribution consists of various components, including the right to be known as the author of the work, the right to prevent attribution to the author of any work that is not his, and the right to prevent others from being named author(s) of his work.⁶⁵⁷ It includes the author's right to publish the work anonymously or pseudonymously, as well as his right to change his mind later and use his own name.⁶⁵⁸ A particularly important aspect of the French right of attribution is the author's right to prevent others from using his work or name in a way that reflects adversely on his professional standing.⁶⁵⁹

By contrast, as mentioned above, the Berne Convention recognizes only two moral rights: attribution and integrity.⁶⁶⁰ An author has the right to claim his authorship, and he has the right to object to any distortion, mutilation, modification of, or derogatory action relating to his work when it is prejudicial to his honor or reputation.⁶⁶¹ Like the French *droit moral*, but in contrast to VARA, the Berne Convention protects the integrity of the work as long as it exists, but it does not prevent outright destruction of the work.⁶⁶² Integrity and attribution constitute the minimum agreed international moral rights standard under the Berne Convention, although national laws can provide for greater protection.⁶⁶³

⁶⁵³ *droit au respect de l'oeuvre*—"right to respect for the work."

⁶⁵⁴ *droit de divulgation*—"right to divulge."

⁶⁵⁵ *droit de retrait*—"right of retraction" or *droit de repentir*—"right to repent."

⁶⁵⁶ *droit de suite*—"right of following" or, more colloquially, "right of follow-up."

⁶⁵⁷ NIMMER & NIMMER, *supra* note 610, § 8D.06[B][1].

⁶⁵⁸ *Id.*

⁶⁵⁹ Neil Netanel, *Alienability Restrictions and the Enhancement of Author Autonomy in United States and Continental Copyright Law*, 12 CARDOZO ARTS & ENT. L.J. 1, 24 n.122 (1994).

⁶⁶⁰ Berne Convention, *supra* note 629, art. 6bis(1).

⁶⁶¹ *Id.*

⁶⁶² See 17 U.S.C. § 106A(a)(3) (2004); Berne Convention, *supra* note 629, art. 6bis(1).

⁶⁶³ Berne Convention, *supra* note 629, art. 19.

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Redress for violation of the treaty's moral rights provisions⁶⁶⁴ is left to national legislation.⁶⁶⁵

Under VARA, an author of a qualifying work of visual art is entitled to rights of attribution and integrity⁶⁶⁶ similar to those provided by the Berne Convention, and he or she may prevent any distortion, mutilation, or modification that would be prejudicial to his or her honor or reputation.⁶⁶⁷ "Right of integrity" under VARA means the right of an artist to prevent the mutilation, distortion or destruction of his creation without his consent.⁶⁶⁸ "Right of attribution" means the right of an artist to have his name properly and publicly associated with his creation,⁶⁶⁹ including the right to *prevent* such attribution if his creation has been so mutilated or distorted by someone else that attribution to him would somehow damage or reflect negatively on his reputation or honor.⁶⁷⁰ If the work is of recognized stature, the artist may be able to recover damages for willful or grossly negligent destruction of the work, subject to certain limitations for destruction of works that are incorporated into buildings.⁶⁷¹

As mentioned above, moral rights in the civil law tradition usually apply to works of authorship of all types normally regulated by copyright law, and this is also true under the Berne Convention.⁶⁷² Under VARA, however, moral rights apply only to authors of specified works of visual art.⁶⁷³ A "work of visual art" is restrictively defined under VARA, and is limited to paintings, drawings, prints, sculpture, and still photographic images produced for exhibition purposes only, any of which may exist as a single copy or in a limited edition of 200 or fewer copies that are signed

⁶⁶⁴ *Id.* art. 6bis(3).

⁶⁶⁵ *Id.* art. 36.

⁶⁶⁶ 17 U.S.C. § 106A(a).

⁶⁶⁷ *Id.* § 106A(a)(3)(A).

⁶⁶⁸ *Id.* § 106A(a).

⁶⁶⁹ *Id.*

⁶⁷⁰ *Id.*

⁶⁷¹ *Id.* § 106A(a)(3)(B).

⁶⁷² Berne Convention, *supra* note 629, art. 2(1).

⁶⁷³ 17 U.S.C. § 106A(b). This limitation appears to conflict with the Berne Convention and, if so, arguably brings the United States out of treaty compliance in this respect.

and consecutively numbered by the author.⁶⁷⁴ The VARA definition specifically excludes works made for hire, unfixed works, and a long list of other creative works, including audiovisual works, motion pictures, electronic publications, applied art, and merchandising or promotional material.⁶⁷⁵

Moral rights under VARA may be waived in writing, but they may not be transferred.⁶⁷⁶ This is also generally thought to be the case under the Berne Convention.⁶⁷⁷ This transfer limitation is consistent with the civil law tradition, as explained earlier: the rights exist only as a function of the artist's "personality" extends into his creation, and that personality cannot be owned by anyone other than the creating artist.⁶⁷⁸

VARA rights endure in most cases only during the life of the artist, but for any work of visual art which was created before June 1, 1991, and for which title has not been transferred away from the artist, moral rights duration under VARA is the same as other U.S. copyright rights (usually measured at present by the life of the author plus seventy years).⁶⁷⁹ Under the Berne Convention, by contrast, moral rights endure for the same length of time as the author's economic rights in the work, subject to national legislation of member states, which may provide that moral rights cease to exist upon the death of the author.⁶⁸⁰

Statutory moral rights protection for artists are provided by a number of states, including California, Connecticut, Illinois, Louisiana, Maine, Massachusetts, Nevada, New Jersey, New Mexico, New York, Pennsylvania, Rhode Island, South Dakota,

⁶⁷⁴ 17 U.S.C. § 101 (2004).

⁶⁷⁵ *Id.*

⁶⁷⁶ *Id.* § 106A(e).

⁶⁷⁷ See Berne Convention, *supra* note 630, art. 6bis(1) ("Independently of the author's economic rights, and even after the transfer of the said rights, the author shall have the right to claim authorship of the work and to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honor or reputation."). But see RICKETSON, *supra* note 619, § 8.104 (Moral rights are inalienable under many national laws; however, there is nothing in the Berne Convention "which prohibits national laws from allowing authors to assign their moral rights either temporarily or permanently.").

⁶⁷⁸ See *supra* note 619 and accompanying text.

⁶⁷⁹ 17 U.S.C. § 106A(d).

⁶⁸⁰ Berne Convention, *supra* note 629, art. 6bis(2).

and Utah.⁶⁸¹ Many of these laws were originally passed prior to enactment of VARA.⁶⁸² Nearly all of the state moral rights laws extend protection only to visual artists or creators of works of fine art, but a few, such as Massachusetts and New Mexico, extend protection to other creative works containing a visual component.⁶⁸³ Several states extend protection to craft items as well as more traditional “fine art.”⁶⁸⁴ A particularly crucial difference between VARA and some state moral rights laws is that the latter provide protection not only to original visual art and limited editions, but also to reproductions.⁶⁸⁵ This expands moral rights coverage well beyond VARA’s limits, especially in states where the definition of fine art may include works in digital media.⁶⁸⁶

Moral rights legislation in most states follows one of two main models, either that of the California Art Preservation Act (“CAPA”)⁶⁸⁷ or that of the New York Artists Authorship Rights Act (“NYAARA”).⁶⁸⁸ While both models have certain elements in common, the CAPA model contains a public interest element⁶⁸⁹ that distinguishes it from the New York model, as well as from VARA and the Berne Convention. In addition to granting moral rights to artists themselves, CAPA also grants independent standing to California arts organizations to pursue injunctions to preserve or restore the integrity of works of fine art, so long as

⁶⁸¹ See CAL. CIV. CODE §§ 987–89 (West 1982 & Supp. 1996); CONN. GEN. STAT. ANN. §§ 42–116t (West 1992 & Supp. 1996); 815 ILL. COMP. STAT. ANN. § 320/0.01 (West 1985); LA. REV. STAT. ANN. §§ 2151–56 (West 2004); ME. REV. STAT. ANN. tit. 27, § 303 (1985 & Supp. 1995); MASS. GEN. LAWS ch. 231, § 85S (West 1989 & Supp. 1996); NEV. REV. STAT. ANN. 597.720–.760 (Michie 1994); N.J. STAT. ANN. § 2A:24A (West 1987 & Supp. 1996); N.M. STAT. ANN. §§ 13-4B-1 to -3 (Michie 2002); N.Y. ARTS & CULT. AFF. LAW § 14.03 (McKinney 1984 & Supp. 1996); PA. CONS. STAT. ANN. tit. 73 § 2101 (West 1993); R.I. GEN. LAWS § 5-62-2 (1995); S.D. CODIFIED LAWS § 1-22-16 (Michie 1992); UTAH CODE ANN. § 9-6-409 (1996).

⁶⁸² See *supra* notes 679–81 and accompanying text.

⁶⁸³ See MASS. GEN. LAWS ch. 231, § 85S; N.M. STAT. ANN. § 13-4B-2.

⁶⁸⁴ See, e.g., N.M. STAT. ANN. § 13-4B-2.

⁶⁸⁵ See, e.g., N.Y. ARTS & CULT. AFF. LAW § 14.03; LA. REV. STAT. ANN. § 51:2153; NEV. REV. STAT. ANN. 597.740.

⁶⁸⁶ See, e.g., MASS. GEN. LAWS ch. 231, § 85S.

⁶⁸⁷ CAL. CIV. CODE § 987 (West 1982 & Supp. 1996).

⁶⁸⁸ N.Y. ARTS & CULT. AFF. LAW § 14.03.

⁶⁸⁹ CAL. CIV. CODE § 989 (West 1982).

such works are of recognized quality and substantial public interest.⁶⁹⁰ “Substantial public interest” is determined by the trier of fact, as is a determination of “recognized quality.”⁶⁹¹ CAPA extends moral rights protection for the life of the author plus fifty years,⁶⁹² and statutory liability attaches to anyone (other than an artist in possession of his own work or a framer, conservator, or restorer not grossly negligent) who intentionally commits or authorizes any physical defacement, mutilation, alteration, or destruction of a work of fine art.⁶⁹³

California’s moral rights law is also quite unusual in that it contains a provision granting artists the right to resale royalties⁶⁹⁴ in the classic French *droit de suite* tradition. By comparison, the Berne Convention recognizes this right in Article 14*ter*, but only to the extent permitted by national legislation.⁶⁹⁵ There is no U.S. federal recognition of this right.⁶⁹⁶ Only one other state, South Dakota, has enacted resale royalties legislation, but its law is very narrowly circumscribed, applying only to resale of state-owned works of art that do not constitute part of a sale of the building in which they are located.⁶⁹⁷

In contrast to CAPA, NYAARA does not contain any formal recognition of a public interest in art, separate from the artist’s own moral rights.⁶⁹⁸ The grant of moral rights under NYAARA extends to “fine art or limited edition multiple[s] of not more than three hundred copies,” as well as to reproductions thereof.⁶⁹⁹ “Fine art” means paintings, sculpture, drawings, works of graphic art, and non-multiple prints.⁷⁰⁰ This statute contrasts with the federal

⁶⁹⁰ See *id.*

⁶⁹¹ *Id.* § 989(d).

⁶⁹² See *id.* § 987(g)(1).

⁶⁹³ See *id.* § 987(c).

⁶⁹⁴ See *id.* § 986(a).

⁶⁹⁵ Berne Convention, *supra* note 629, art. 14*ter*(2).

⁶⁹⁶ Dane S. Ciolino, *Moral Rights and Real Obligations: A Property-Law Framework for the Protection of Authors’ Moral Rights*, 69 TUL. L. REV. 935, 949 (1995) (stating that while courts have refused to recognize moral rights directly, they have used existing legal doctrines to extend moral rights protection indirectly).

⁶⁹⁷ S.D. CODIFIED LAWS § 1-22-16(5) (Michie 1992).

⁶⁹⁸ N.Y. ARTS & CULT. AFF. LAW § 14.03 (McKinney 1994 & Supp. 1996).

⁶⁹⁹ *Id.* § 14.03.1.

⁷⁰⁰ *Id.* § 11.01(9).

system, which does not protect moral rights for reproductions and protects limited editions only to the first 200 copies.⁷⁰¹ NYAARA does not require a protected work to be of recognized quality or stature.⁷⁰² Liability under NYAARA attaches to anyone, other than the artist or someone acting with his consent, who, in New York, knowingly displays in public or publishes “a work of fine art or limited edition . . . or a reproduction thereof in an altered, defaced, mutilated or modified form [representing to be, or] reasonably [likely to] be regarded as being[,] the work of the artist, and damage to the artist’s reputation is reasonably likely to result”⁷⁰³ This means that public display or publication and likelihood of damage to reputation are both elements that must be proven before liability attaches under NYAARA.⁷⁰⁴ The statute does not specify the duration of moral rights, but it refers to assertion of the rights by the artist himself,⁷⁰⁵ so presumably NYAARA is similar to VARA in that rights exist only during the artist’s lifetime.⁷⁰⁶

The moral rights laws of certain other states differ in important ways from VARA, the two main state models, and the French and international moral rights regimes. One such law is the Massachusetts Art Preservation Act (“MAPA”).⁷⁰⁷ This law contains a legislative finding that physical alteration or destruction of fine art is detrimental to the artist’s reputation and that there is a public interest in preserving the integrity of cultural and artistic creations.⁷⁰⁸ MAPA, on which New Mexico’s law was later

⁷⁰¹ 17 U.S.C. § 101 (2004).

⁷⁰² See N.Y. ARTS & CULT. AFF. LAW §§ 11.01(9), 14.03(1). New York has one of the largest Native American populations in the United States. See 2000 Census, *American Indian and Alaskan Native Tribes in the United States*, <http://www.census.gov/population/cen2000/phc-t18/tab047.pdf> (last visited Jan. 4, 2005); 2000 Census, *American Indian and Alaskan Native Tribes in New York State*, <http://www.census.gov/population/cen2000/phc-t18/tab001.pdf> (last visited Jan. 4, 2005).

⁷⁰³ See *id.* §§ 14.03.1, 14.03.3(e).

⁷⁰⁴ See *id.*

⁷⁰⁵ See *id.* § 14.03.1.

⁷⁰⁶ 17 U.S.C. § 106A(d)(1) (2004).

⁷⁰⁷ MASS. GEN. LAWS ANN. ch. 231, § 85S (West 1989 & Supp. 1996).

⁷⁰⁸ *Id.*

modeled,⁷⁰⁹ contains the broadest definition of protected works of fine art in any of the state laws and is much broader than VARA's definition. "Fine art" under MAPA means "any original work of visual or graphic art [in] any media[, including] but not limited to, any painting, print, drawing, sculpture, craft object, photograph, audio or video tape, film, hologram, or any combination thereof, [so long as it is] of recognized quality."⁷¹⁰ Under MAPA, not only the artist, but any union or artists' organization authorized by him in writing has standing to bring suit to protect these rights on his behalf.⁷¹¹ Moral rights in Massachusetts endure for the life of the artist plus fifty years.⁷¹²

Louisiana's moral rights law also contains unique protections not found in other domestic or foreign moral rights laws. It specifically extends moral rights protection to all statutorily defined works of fine art, regardless of their date of creation.⁷¹³ Liability attaches not only in cases of display or publication within Louisiana of altered works of fine art, but also to "acts in violation of this [law] by a person who is subject to the jurisdiction of [Louisiana]."⁷¹⁴ Thus, a public display of a mutilated work in another state by a Louisiana resident might be actionable within Louisiana. A Louisiana corporation displaying distorted work on the Internet via a server located outside the state might also be subject to liability in Louisiana.

3. Federal Preemption of State Moral Rights Laws

To determine whether expanded domestic moral rights laws might better protect indigenous TKGRF, it is necessary to examine whether VARA preempts state moral rights laws and, if so, to what

⁷⁰⁹ N.M. STAT. ANN. §§ 13-4B-1 to -3 (Michie 2002). New Mexico's law is nearly identical in much of its wording to MAPA, but it applies only to "fine art in public view." *Id.* § 13-4B-3(A). "Public view" means "on the exterior of a public building or in an interior area of a public building." *Id.* § 13-4B-2(E). The status of New Mexico's moral rights protections is critical from a TKGRF standpoint because so many Native Americans live in that state.

⁷¹⁰ MASS. GEN. LAWS ANN. ch. 231, § 85S(b).

⁷¹¹ *Id.* § 85S(g).

⁷¹² *Id.*

⁷¹³ LA. REV. STAT. ANN. § 51:2155(G) (West 2004).

⁷¹⁴ *Id.* § 51-2155(E).

extent. If VARA totally preempted earlier state moral rights laws, then attempts to expand them further would obviously be a useless strategy for protecting TKGRF. If, on the other hand, VARA has not preempted or has only partially preempted state moral rights laws, state legislatures would have the potential to improve indigenous TKGRF protection. State law expansion would obviate the need to confront powerful entertainment lobbies opposed to federal moral rights or to win over federal policymakers who may be unsympathetic to greater TKGRF protection.

The Copyright Act of 1976 ("1976 Act") provides for general federal preemption of state copyright laws.⁷¹⁵ This general preemption scheme provides that, on or after January 1, 1978, the 1976 Act governs all legal and equitable rights equivalent to any of the exclusive rights within the general scope and subject matter of copyright in works of authorship fixed in a tangible medium ("§ 106 rights"), regardless of creation date and regardless of whether such works are published.⁷¹⁶ Certain exceptions to the general preemption scheme exist: most importantly, it does not apply to subject matter outside the scope of the 1976 Act or to state or common law rights not equivalent to § 106 rights.⁷¹⁷ For example, state law causes of action for misappropriation, trade secret, trademark and trade dress violations, unfair competition, and rights of publicity or privacy are not subject to general preemption.⁷¹⁸

In 1990, with the passage of VARA, Congress added a new preemption provision pertaining solely to works of visual art.⁷¹⁹ It provides that, as of June 1, 1991, "all legal or equitable rights that are equivalent [to those] conferred by § 106A [of the 1976 Act] with respect to works of visual art . . . are governed exclusively by [the relevant provisions of the 1976 Act (as amended by

⁷¹⁵ 17 U.S.C. § 301 (2004).

⁷¹⁶ *Id.* § 301(a). This type of preemption is referred to in this paper as "general preemption," that is, federal preemption of state copyright law on grounds *other than* VARA/moral rights grounds. Preemption on VARA/moral rights grounds under § 301(f) is discussed *infra*, notes 719–41 and accompanying text, and referred to in this paper as "VARA-type preemption."

⁷¹⁷ 17 U.S.C. § 301(b).

⁷¹⁸ H.R. REP. NO. 101-514, at 21 (1990), *reprinted* in 1990 U.S.C.C.A.N. 6915, 6931.

⁷¹⁹ 17 U.S.C. § 301(f).

VARA)]”⁷²⁰ The statute also specifies that common law and state statutes are not preempted by federal copyright law to the extent that: 1) they cover causes of action commencing before June 1, 1991; 2) they confer “rights that are not equivalent to any of the rights conferred by section 106A with respect to works of visual art”; or 3) they concern violations of rights extending beyond the life of the author.⁷²¹ Put another way, it appears from reading the moral rights preemption provision in § 301(f)—or “VARA-type preemption”—that Congress intended state moral rights statutes to apply where: (1) title in a protected work was transferred from the artist to another party before the effective date of VARA, (2) state law grants rights different from those provided by VARA, (3) state law protects copyrightable works not covered by the VARA definition of works of visual art, and (4) state law allows legal actions for events occurring after the artist’s death.⁷²²

General preemption under § 301(a) and (b) applies to § 106 rights, whereas VARA-type preemption under § 301(f) applies to § 106A rights (moral rights).⁷²³ It is important to make the distinction between general preemption and VARA-type preemption, because voluminous case law exists to explain general preemption,⁷²⁴ whereas there is next to none dealing directly with VARA-type preemption. Just as § 106 rights fundamentally differ from moral rights under § 106A, the applicable preemption rules also differ.

Unfortunately, confusion on this issue is not uncommon among courts and commentators alike, with the result that the question of U.S. moral rights law preemption has become needlessly

⁷²⁰ *Id.* § 301(f)(1).

⁷²¹ *Id.* § 301(f)(2).

⁷²² Patrick Flynn, Annotation, *Validity, Construction, and Application of Visual Artists Rights Act*, 138 A.L.R. FED. 239, 248 (1997). *See generally* H.R. REP. NO. 94-1476 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659; H.R. REP. NO. 101-514 (1990), at 21, *reprinted in* 1990 U.S.C.C.A.N. 6915, 6931.

⁷²³ *See supra* notes 719–22 and accompanying text.

⁷²⁴ *See, e.g.,* *Foley v. Luster*, 249 F.3d 1281 (11th Cir. 2001); *Fischer v. Viacom Int’l Inc.*, 115 F. Supp. 2d 535 (D.Md. 2000); *Avco Corp. v. Precision Air Parts, Inc.*, 676 F.2d 494 (11th Cir. 1982).

blurred.⁷²⁵ Courts and legal scholars have extensively examined the legislative history in trying to determine the scope and application of VARA-type preemption, but little of binding precedential value has actually been decided.⁷²⁶

A discussion of VARA-type preemption under § 301(f) can be found in House Report No. 101-514 (1990).⁷²⁷ It specifies that federal preemption will occur for works of visual art when a state grants legal or equitable rights equivalent to those embodied in §106A.⁷²⁸ But federal law does not preempt state causes of action relating to works not covered by VARA, including, specifically, audiovisual works, photographs produced for non-exhibition purposes, and works in which the copyright has been transferred before the effective date of VARA.⁷²⁹ Also, state artists' rights laws that grant rights not equivalent to those under VARA are not preempted even when relating to works covered by VARA.⁷³⁰ The Report gives some specific examples of situations where VARA-type preemption is not intended to occur, such as a cause of action for misattribution of a reproduction of a work of visual art or violation of a state-granted right to a resale royalty.⁷³¹ It also clearly states that "the Copyright Act prior to [VARA] does not preempt state law misappropriation, unfair competition, breach of contract, and deceptive trade practices claims, and they will not be preempted [after passage of VARA]."⁷³² Interestingly, though, the Report also says that state laws granting rights of attribution or integrity for works falling within the VARA definition of works of visual art *will* be preempted by federal law, even if the State ground is *broader* than that afforded under VARA.⁷³³

⁷²⁵ Joseph Zuber, *The Visual Artists Rights Act of 1990—What it Does and What it Preempts*, 23 PAC. L.J. 445, 508 (1992).

⁷²⁶ See generally *Wojnarowicz v. Am. Family Ass'n*, 745 F. Supp. 130 (S.D.N.Y. 1990); WILLIAM F. PATRY, *COPYRIGHT LAW AND PRACTICE* (1994); Zuber, *supra* note 725.

⁷²⁷ H.R. REP. NO. 101-514, at 21, *reprinted in* 1990 U.S.C.C.A.N. 6915, 6931.

⁷²⁸ *Id.*

⁷²⁹ *Id.*

⁷³⁰ *Id.*

⁷³¹ *Id.*

⁷³² *Id.*

⁷³³ *Id.* (emphasis added).

While some courts and legal scholars in the years since passage of VARA have speculated that the federal law may substantially preempt state moral rights laws, Congress's determination that state moral rights laws constituted an important basis by which U.S. domestic law met Berne Convention requirements⁷³⁴ seems to contradict the argument that the legislative branch intended VARA to fully preempt, and thus severely limit or even destroy, the only other existing area of domestic moral rights law.⁷³⁵ Nor does this seem logical when protection given to artists under VARA is in some ways narrower than that available under precursor state laws at the time of Berne Convention accession.⁷³⁶ Yet this seems to be precisely what the few courts that have tangentially considered the issue have assumed,⁷³⁷ as well as some legal scholars.⁷³⁸

In contrast, interpreting the VARA preemption provisions and the legislative history together to mean that Congress intended federal law to preempt state moral rights laws *only to the limited extent those state laws directly conflict with VARA*, allows for Congress to have acted consistently with its public position in 1988 and also to have legislated in a proactive and forward-thinking way in 1990.⁷³⁹ This interpretation would cohere with the pre-VARA Congressional testimony of Ralph Oman, then Register of Copyrights.⁷⁴⁰ Concerning the potential preemptive effect of VARA on state moral rights laws, he said: "If a state decides to grant greater protection [than VARA], it would not be preempted

⁷³⁴ See *id.*

⁷³⁵ This assertion is the authors, however it is also made by Greg Vetter. See Greg R. Vetter, *The Collaborative Integrity of Open-Source Software*, 2004 UTAH L. REV. 563, 658 (2004).

⁷³⁶ JOHN MERRYMAN & ALBERT ELSÉN, *LAW, ETHICS AND THE VISUAL ARTS* 257–80 (4th ed. 1998).

⁷³⁷ See, e.g., *Wojnarowicz v. Am. Family Ass'n*, 745 F. Supp. 130, 136 n.2 (S.D.N.Y. 1990); *Lubner v. City of Los Angeles*, 53 Cal. Rptr. 2d 24 (Ct. App. 2d 1996).

⁷³⁸ See, e.g., Zuber, *supra* note 725, 492–502; NEIL BOORSTYN, *BOORSTYN ON COPYRIGHT* § 1.07[1] (2d ed. 2000).

⁷³⁹ See Jane C. Ginsberg, *Second Frankfurt-Columbia Symposium on Comparative Law, Harmonization of Laws in Federal Systems: A Comparative Perspective*, 2 COLUM. J. EUR. L. 463, 472 (1996).

⁷⁴⁰ *Copyright Remedy Clarification Act and Copyright Office Report on Copyright Liability of States: Hearings on H.R. 1131 Before the Subcomm. on Courts, Intell. Prop., & the Admin. of Justice of the House Comm. on the Judiciary*, 101st Cong. (1989) (testimony of Ralph Oman, Register of Copyrights).

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by this act. H.R. 131690 provides only a minimum threshold of protection and permits States to enact more expansive protection.”⁷⁴¹ Of course, this is only the opinion of one individual who, while influential, was not a legislator. It seems unlikely, however, that Congress would have intentionally acted in a manner diametrically opposed to the views of an expert of Mr. Oman’s stature, particularly in a field as arcane (at that time) as copyright and moral rights law.

4. Expansion of Moral Rights Laws for TKGRF Protection

From the TKGRF perspective, it would be helpful for states to pass moral rights legislation providing broad coverage to creative works of all types. Extending state law moral rights protections to as much TKGRF material as possible, particularly such items as indigenous-made jewelry, weavings, pottery, kachina and Eskimo dolls, Native dance and dress paraphernalia, etc., would be a valuable addition to present legal protection for TKGRF. Enactment of broad state laws allowing creator rights to resale royalties would also be an obvious way to increase indigenous creators’ returns from sharing and use of their TKGRF with third parties.

Since state laws that allow moral rights protection for terms extending beyond the life of the artist may survive a federal preemption challenge, state laws should be drafted to extend protection terms beyond the life of the artist for specific types of TKGRF. Legislating in favor of an independent public interest element, similar to that in CAPA,⁷⁴² might also present an avenue for avoiding preemption and for providing creative protection of qualifying indigenous works for an indefinite term, either on a case-by-case basis or as identifiable bodies of work. Enjoining

⁷⁴¹ *Id.* HR 131690 was the draft version of VARA under consideration at the time of this testimony.

⁷⁴² Brian T. McCartney, *Creepings and Glimmers of the Moral Rights of Artists in American Copyright Law*, 6 UCLA ENT. L. REV. 35 (1998) (“CAPA was enacted with two goals in mind. First, ‘to uphold the artist’s reputation, since fine art is ‘an expression of the artist’s personality,’ thereby triggering the artist’s interest in protecting the work; and [second] to promote the ‘public interest in preserving the integrity of cultural and artistic creations.’”).

further use of tribal designs or motifs by nonmembers of a tribe without tribal permission, for example, might be one interpretation of “preserving or restoring the integrity” of existing tribal works.

Native Americans could, if funding and legal counsel obstacles could be overcome, explore the use of existing moral rights laws to protect their qualifying works of art. The right of integrity, in particular, might be creatively used to prevent non-indigenous people from describing derivative or copied works as “Indian”-inspired⁷⁴³ or from using motifs or designs of one or more identifiable tribes, unless the use of such foundational material is accurately portrayed, properly attributed, and does not damage the underlying indigenous artist’s reputation.⁷⁴⁴ Attempts to use the right of attribution to prevent distorting, later uses of collectively owned tribal work, however, would be difficult, since U.S. law may view collectively owned material as part of the public domain.⁷⁴⁵ But disseminated works based on tribal art that is normally not shared outside tribal members might be successfully argued to be mutilations or distortions damaging to the tribal artist’s reputation, depending on the factual circumstances of publication and customary legal limitations on access to the material within the tribe. Particularly in California, the public interest element of moral rights law might also be effectively used to maintain the integrity of well-known tribal art.

In conjunction with expanded moral rights legislation, courts should examine relevant customary law to determine analogous practices within indigenous societies concerning ownership, attribution, and integrity of artistic and other creative works. While United States courts in the past generally have not taken judicial notice of or inquired into Native American customary law,

⁷⁴³ For information on the conditions under which arts and crafts may be promoted or labeled as “Indian,” see IACA, Pub. L. No. 101-644, 104 Stat. 4662 (1990) (codified as amended in scattered sections of 18 U.S.C., 20 U.S.C., 25 U.S.C., 42 U.S.C.). As discussed elsewhere in this paper, however, IACA approaches the issue from a consumer protection or “truth-in-advertising” standpoint, rather than from a moral rights position. See generally Part III.A.

⁷⁴⁴ David B. Jordan, *Square Pegs and Round Holes: Domestic Intellectual Property Law and Native American Economic and Cultural Policy: Can it Fit?*, 25 AM. INDIAN L. REV. 93, 106 (2001).

⁷⁴⁵ *Id.*

Bulun Bulun⁷⁴⁶ and related cases should be recognized as relevant examples of emerging trends in common law; counsel for indigenous litigants should argue vigorously in favor of similar judicial inquiry and notice by U.S. courts.

If more states were to enact broader moral rights legislation, both policymakers and the creating public would also become better educated about the nature of moral rights. At present, due in part to lobbying pressure by big entertainment entities, VARA and the moral rights provisions of the Berne Convention have been so tightly circumscribed in the United States that they are rarely used or litigated, and the U.S. public is nearly as unfamiliar with moral rights now as it was in the early 1980s.⁷⁴⁷ Consequently, there is little surprise that international talk of requiring source attribution and prior informed consent in patent applications or withdrawal of indigenous consent to use TKGRF—equitable concepts in a sense very akin to the creator's moral rights of attribution, integrity, and divulgation, though unarticulated as such—is a mental and intuitive stretch for U.S. lawyers, yet readily acceptable to many of their international colleagues. Instead, in part because the United States lacks a longstanding foundation in this area of intellectual property law, United States policymakers sometimes fail to comprehend the unique void that moral rights and moral rights-like protections might fill, and they fail to grasp its potential value for protecting some otherwise problematic types of TKGRF material. With expanded use, more lawyers and legislators would develop an understanding of moral rights, and dismissive attitudes toward this law as unimportant or irrelevant to U.S. creators, or dangerous to U.S. free speech and enterprise, might then dissipate.

Widespread perception outside the United States of the benignity of the *droit de derogation*⁷⁴⁸ makes its inclusion in planned protections for TKGRF much more palatable to the international community than it is to U.S. lawyers and legislators.

⁷⁴⁶ Bulun Bulun v. R&T Textiles Pty. Ltd., 157 A.L.R. 193 (1998), available at <http://www.austlii.edu.au/cgi-bin/disp.pl/au/cases/cth/federal%5fct/1998/1082.html?query=%5e+bulun> (last updated Sept. 8, 1998) (involving the copyright entitlements of an aboriginal people over the artwork of one of its members).

⁷⁴⁷ See generally NIMMER, *supra* note 610.

⁷⁴⁸ See Kuruk, *supra* note 634, at 830–31.

This moral rights tradition, followed in many countries, allows a creator the ability to prevent others from acting in “derogation” of his work.⁷⁴⁹ It is often explained as a right to prevent others from criticizing or taking derogatory action toward the work. This is rightly a matter of serious concern and reservation for U.S. policymakers, for whom free speech values are paramount. This right could present serious First Amendment problems in some scenarios. Other, well-established intellectual property law, however, such as the Lanham Act §2, presents a similar challenge and has long successfully coexisted, in a carefully circumscribed way, with First Amendment freedoms. Use of the *droit de derogation* as a potentially useful protection mechanism should not be prematurely dismissed merely because it abuts First Amendment protections.

Policymakers on both sides of the Atlantic, as well as in the developing world, are victims of a mutual unfamiliarity with the boundaries inherent in the First Amendment tradition on the one hand, and the moral rights tradition on the other.⁷⁵⁰ All parties to the TKGRF debate may lack a mutual appreciation of the deep degree to which these traditions are entrenched in the respective national legal and social psyches of the peoples involved. Greater familiarity on both sides with the other’s legal traditions, including customary law traditions, might facilitate finding adequate international solutions to protect TKGRF much more rapidly and more cohesively than at present.

U.S. legal scholars have a greater obligation to invest their time and effort into developing this awareness than do their foreign counterparts, if only because U.S. lawyers may be likely to know less about foreign legal traditions than their overseas colleagues do about U.S. law. But arguably, the United States also stands to benefit most from including moral rights into its legal traditions. If the moral rights tradition were ever fully brought into U.S. jurisprudence, a uniquely U.S. strain of this law would undoubtedly develop and become an important contribution to legal thought. Domestic courts and legislators would undoubtedly

⁷⁴⁹ *Id.*

⁷⁵⁰ See generally Kuruk, *supra* note 634, at 825–27.

harness their well-known U.S. ingenuity to find creative ways to craft moral rights concepts in such a way that they could successfully coexist with the free speech, fair use, and other vital legal traditions that are unique to the U.S.

In this way, the United States could create a model for an U.S.-based intellectual property law that is more consonant with international norms, yet embodies some of the deepest principles upon which an open and free society is built. This “blended” intellectual property model might be more amenable than our present regime to adoption and adaptation by other countries that are presently in search of useful drafting models for TKGRF and other intellectual property legislation. This usage would in turn facilitate the spread of some of the U.S.’s cherished legal principles among other nations.

For the immediate term, however, while expansion of domestic U.S. moral rights laws should ideally occur on both the federal and state levels, it would probably be easier to make headway among state legislatures. Indigenous populations and their supporters likely would have greater success lobbying for legislative changes within their own state governments, given financial constraints and the considerable time needed to educate legislators about the meaning and importance of moral rights laws.

One of the main questions likely to be raised by state legislators in this process is whether VARA preempts state moral rights legislation. Because it is likely that federal law would not preempt large tracts of state moral rights law,⁷⁵¹ even as presently written, state legislators might be persuaded to legislate in this area as an avenue for TKGRF protection. This could be a useful step toward successfully helping to protect indigenous TKGRF within established regimes of intellectual property law.

C. Establish a Domestic Geographical Indications Regime for TKGRF

In addition to changes in trademark and moral rights protections, the United States should also establish a prospective

⁷⁵¹ See *supra* note 645 and accompanying text.

domestic geographical indications regime for TKGRF.⁷⁵² Besides offering a valuable addition to present intellectual property law protections for TKGRF, this would have the useful side effect of bringing the United States more clearly into compliance with its present TRIPS obligations.⁷⁵³ Creating a new domestic channel for TKGRF protection—in an area of law well-established in many countries—might also relieve growing pressure for *sui generis* laws that might entail greater legal uncertainty.

Geographical indications law, like moral rights law, is well-established in traditional European intellectual property law,⁷⁵⁴ but has not, until TRIPS, existed in U.S. jurisprudence.⁷⁵⁵ Since the signing of TRIPS in 1995, geographical indications law has gained broad global acceptance and legal legitimacy.⁷⁵⁶ TRIPS encourages expansion of geographical indications law for use as a trade-enhancing mechanism.⁷⁵⁷ TRIPS not only contains specific directives concerning the use and application of geographic indicators, it also mandates that all member states negotiate with each other to further develop this area of intellectual property protection.⁷⁵⁸

According to the TRIPS definition, geographical indications are “indications which identify a good as originating in the territory of a Member [country], or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.”⁷⁵⁹ Thus, under TRIPS, a geographic indication is a source indicator that is based both on geographic origin and on an additional identifying characteristic linked to that particular geographic

⁷⁵² A geographical indications regime is a framework for the protection and enforcement of goods originating from a particular territory, region or locality. *See generally* TRIPS Agreement, *supra* note 94, pt. II, § 3.

⁷⁵³ *See* Leigh Ann Lindquist, *Champagne or Champagne? An Examination of U.S. Failure to Comply with the Geographical Provisions of the TRIPS Agreement*, 27 GA. J. INT’L & COMP. L. 309, 330–32 (1999).

⁷⁵⁴ *Id.* at 312.

⁷⁵⁵ *Id.* at 314.

⁷⁵⁶ *Id.* at 315.

⁷⁵⁷ TRIPS Agreement, *supra* note 94, pt. II, § 3.

⁷⁵⁸ *Id.* pt. II, § 3, art. 24.1.

⁷⁵⁹ *Id.* pt. II, § 3, art. 22.1.

origin.⁷⁶⁰ This is important when considering geographical indications as a method of TKGRF protection because, like that of most indigenous peoples, the Native American's flora, fauna, and other TKGRF characteristics are often inextricably tied to a specific geographic location.

Geographical indications are not trademarks; though both are source indicators, the protection these two types of intellectual property offer is fundamentally different.⁷⁶¹ As discussed earlier in this paper, while certain special forms of trademarks can be adapted to function in a way that can be similar to geographical indications, trademarks exist mainly for the benefit of consumers—to prevent consumer confusion as to the source—and do not inherently require any qualifying link to a specific geographic origin.⁷⁶² Hence, though they may in some circumstances appear similar, trademarks are not *per se* co-extensive with geographical indications.

While a U.S. certification mark in a TKGRF-related situation might closely approximate coverage given by a geographical indication,⁷⁶³ the mark would be limited to recognition and enforceability only in the United States, since there is no international system of trademark registration.⁷⁶⁴ But an international system of geographical indications might one day become accessible for TKGRF, and creating a new international geographical indications system of notice, registration, recognition, and mutual national enforcement is currently being discussed at the WTO.⁷⁶⁵ Since TKGRF owners can often be spread over several

⁷⁶⁰ Lindquist, *supra* note 753, at 312.

⁷⁶¹ *Id.* at 311–12.

⁷⁶² *Id.*

⁷⁶³ This would occur, for example, if the mark's underlying standards were carefully drafted to tie product certification with geographic location, indigenous producer group, and traditional production method.

⁷⁶⁴ See generally WIPO, Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (adopted June 27, 1989) [hereinafter Madrid Protocol], http://www.wipo.int/madrid/en/legal_texts/pdf/madrid_protocol.pdf.

⁷⁶⁵ WTO, News, *Intellectual Property Council Debates Call to Expand Geographical Indications Protections*, Mar. 28, 2000, at http://www.wto.org/english/news_e-news00_e/trips_e.htm [hereinafter *Call for GI Expansion*]. The Madrid Protocol offers an international registration application system similar to that for patents under the PCT, but trademark applications filed under the Madrid Protocol still operate within a

national borders, this might be more useful for TKGRF protection than national trademark systems.

Prior to TRIPS, two main types of common source indications were used to show geographical significance: 1) appellations of origin and 2) indications of source.⁷⁶⁶ Like moral rights, these types of intellectual property protection were first legally recognized in France, beginning in the early 19th century.⁷⁶⁷ Gradually, both became formally recognized elsewhere in Europe, and eventually they were protected by an international treaty, beginning in 1883 with the Paris Convention⁷⁶⁸ and continuing in subsequent treaties into the 20th century.⁷⁶⁹ These culminated most recently in the geographical indications provisions of TRIPS.⁷⁷⁰

While indications of source merely state where a product is made, appellations of origin signify the geographical region in which the product originates and the features of the product that are directly attributable to natural and human factors specific to that region.⁷⁷¹ These features can include, for example, particular climate and soil characteristics of a specific locality or a traditional, region-specific method of manufacture.⁷⁷² Examples would be Roquefort cheese, Portuguese port, and French Champagne.

somewhat harmonized system of national registrations and national substantive laws. *See generally id.*

⁷⁶⁶ Lindquist, *supra* note 753, at 312.

⁷⁶⁷ *Id.*

⁷⁶⁸ Paris Convention for the Protection of Industrial Property, art. 10, Mar. 20, 1883, revised July 14, 1967, 828 U.N.T.S. 305 [hereinafter Paris Convention], available at <http://www.wipo.int/clea/docs/en/wo/wo020en.htm>.

⁷⁶⁹ Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods, arts. 1(1), 4, Apr. 14, 1891, revised Oct. 31, 1958, 828 U.N.T.S. 389, available at <http://www.wipo.int/clea/docs/en/wo/wo032en.htm>; Lisbon Agreement for the Protection of Appellations of Origin and their International Registrations, Oct. 31, 1958, revised July 14, 1967, available at <http://www.wipo.int/clea/docs/en/wo/wo012en.htm>.

⁷⁷⁰ TRIPS Agreement, *supra* note 94.

⁷⁷¹ Lindquist, *supra* note 753, at 312.

⁷⁷² Stacy D. Goldberg, *Who Will Raise the White Flag? The Battle between the United States and the European Union over the Protection of Geographical Indications*, 22 U. PA. J. INT'L ECON. L. 107, 108 (2001).

Because of this required link between product characteristics and identifiable geography, geographical indications could provide legal coverage for some aspects of TKGRF not readily protected by other types of intellectual property law. Moreover, the collective ownership and limited term protection problems in copyright and patent law do not exist with geographical indications law, so this type of law would meet some of the criteria of TKGRF owners.

Unfortunately, however, geographical indications law has traditionally only been used in connection with food and beverages, and this has also been the case under TRIPS until very recently.⁷⁷³ TRIPS applies to “goods” only,⁷⁷⁴ but its geographical indications provisions do not specify that they may be used solely for comestibles, even though slightly elevated protection is provided specifically for wines and spirits.⁷⁷⁵ Many developing countries feel that this higher level of protection for wines and spirits should apply to all agricultural goods.⁷⁷⁶ Even if this change were implemented, TKGRF nevertheless includes a wide spectrum of material that is neither agricultural in nature nor “goods.”

Mexico has pioneered the expansion of the traditional notion of geographical indications law for TKGRF protection.⁷⁷⁷ It recently gave appellation of origin protection, under the name “Olinalá,” to certain types of traditionally lacquered articles made of a particular local wood and originating in the municipality of the same name.⁷⁷⁸ Mexican legislators also considered using geographical indications law to protect other unique ironwood carvings, dolls, and other artifacts traditionally created by indigenous Seri tribespeople.⁷⁷⁹ In both situations, before the new protective

⁷⁷³ TRIPS Agreement, *supra* note 94, pt. II, § 3, art. 22.60.

⁷⁷⁴ *Id.* art. 22.1.

⁷⁷⁵ *Id.* art. 23.

⁷⁷⁶ See *Call for GI Expansion*, *supra* note 765.

⁷⁷⁷ See *Existing IP Protection Report*, *supra* note 627, annex II, p. 2.

⁷⁷⁸ *Id.* annex II, p. 4.

⁷⁷⁹ *Id.* at 2. Trademark protection, rather than geographical indications, was the legal protection vehicle ultimately chosen for the Seri creations, since protection was required for a number of different types of products made by a variety of traditional manufacturing methods. *Id.*

legislation was passed, indigenous producers found themselves facing increasingly stiffer competition from copies made by mestizo craftspeople using cheaper mass production methods.⁷⁸⁰ The Mexico case is an example of creative thinking aimed at new ways to protect TKGRF and the possibilities offered by geographical indications law, and the United States should carefully consider the same avenue of protection.

Many indigenous stakeholders have identified other problematic areas of TKGRF for which geographical indications law might be a useful protective tool. For example, because some indigenous national dress is made according to traditional methods and from distinctive local materials, such dress often incorporates detailed and specific information about the geographic origin of both the dress and its wearer. Geographical indications law might provide a protective avenue for this kind of creative material. Distinctive indigenous textiles and handicrafts incorporating peculiarly local vegetable dyes, wool, or fibers obtainable only from local plants or animals might be especially susceptible to this type of protection.

One major obstacle standing in the way of harmonized global development of geographical indications, whether for TKGRF protection or for any other use, is the underlying philosophical difference between the United States and the European Union in this area of law.⁷⁸¹ Unlike the European Union, the United States disregards locality per se as a valid protective property right under intellectual property law.⁷⁸² Any indigenous group wishing to expand geographical indications use for TKGRF protection can expect to face obstacles from the United States, due to its general opposition in the WTO to any expansion of geographical indications law.⁷⁸³ While U.S. officials often explain that this

⁷⁸⁰ *Id.*

⁷⁸¹ See generally Lindquist, *supra* note 753, at 312–14 (noting the different approaches between European and U.S. vintners); see also Goldberg, *supra* note 772, at 107.

⁷⁸² Goldberg, *supra* note 772, at 109.

⁷⁸³ Interestingly, the position of the U.S. Trade Representative on geographical indications at the WTO is inconsistent with at least one current project of the U.S. government. See *infra* text accompanying note 793.

difference of opinion rests on legal grounds,⁷⁸⁴ the main reasons may instead be economic and political.⁷⁸⁵

U.S. trademark law does not allow registration of geographic terms as trademarks, because they are primarily descriptive and thus not sufficiently distinctive.⁷⁸⁶ By contrast, Europe has long allowed protection of certain products based solely on geographical indications.⁷⁸⁷ The inherent difficulty with the U.S. legal position is twofold: 1) geographical indications by their very nature are fundamentally different from trademarks,⁷⁸⁸ and 2) viable geographical indications convey very particularized information about origin, which might be viewed as somewhat analogous to the “distinctiveness” requirement of U.S. trademark law.⁷⁸⁹

Continued U.S. government opposition to geographical indications is particularly important to the U.S. wine industry.⁷⁹⁰ The government’s resistance to expansion of this area of law may be the most difficult obstacle for TKGRF advocates to overcome. European immigrants brought with them much of the original grape stock used to produce U.S. wines today.⁷⁹¹ Naturally, once they had established vineyards in their new country, they labeled their products with the same familiar regional names they had used in Europe.⁷⁹² Developing and marketing U.S.-produced wines and spirits, and educating U.S. consumers to buy them, have been a very costly investment for domestic vintners to date, and U.S. growers are determined to protect this investment for as long as possible.⁷⁹³ Provisions on geographical indications were ultimately included in TRIPS, despite staunch U.S. opposition to them, but the current treaty language is the result of a hard-fought

⁷⁸⁴ Goldberg, *supra* note 772, at 138.

⁷⁸⁵ Lindquist, *supra* note 753, at 343; Goldberg, *supra* note 772, at 149.

⁷⁸⁶ 15 U.S.C. § 1052(e) (2004).

⁷⁸⁷ Lindquist, *supra* note 753, at 312.

⁷⁸⁸ *See id.* at 312–13.

⁷⁸⁹ *Id.*

⁷⁹⁰ Lindquist, *supra* note 753, at 313.

⁷⁹¹ *Id.*

⁷⁹² *Id.*

⁷⁹³ *See generally id.*; Goldberg, *supra* note 772.

battle—one that continues today.⁷⁹⁴ Geographical indications remained highly contested at the recent WTO ministerial summit in Cancún, Mexico, and the dispute will probably remain unsettled well into the future.⁷⁹⁵

Despite continuing U.S. opposition, geographical indications have received an unprecedented level of global attention post-TRIPS.⁷⁹⁶ As geographical indications law becomes more widely familiar, it is likely to be increasingly used in many countries as a vehicle for emerging TKGRF protection.⁷⁹⁷ Other than the ramifications for U.S. trade protectionism in wine and spirits, there appears to be no reason why a well thought out, strictly prospective, geographical indications law system for TKGRF could not also be implemented in the United States. Implementing such a system for TKGRF would probably have the added benefit of helping to alleviate current international doubts about the U.S.'s

⁷⁹⁴ *Id.*

⁷⁹⁵ See generally WTO, *The Fifth WTO Ministerial Conference*, at http://www.wto.int/english/thewto_e/minist_e/min03_e/min03_e.htm (last visited Nov. 17, 2004). Special interest groups in the U.S. have successfully entrenched their opposition at home even after TRIPS was signed. As author Leigh Ann Lindquist notes, Congress has now codified certain regulations of the Bureau of Alcohol, Tobacco and Firearms relating to wine and spirit labeling. This has had the effect of memorializing in national law the semi-generic, and thus relatively unprotected, nature of some wine names in the U.S. market. This Congressional response to successful lobbying by the wine industry has made it considerably more difficult, both for the E.U. to have these same names recognized as protected geographical indications, and for the U.S. Trade Representative to utilize them in any meaningful way in the further negotiations on geographical indications that are required of all members under TRIPS Article 24. Lindquist, *supra* note 753, at 324–29.

⁷⁹⁶ See WTO, *TRIPS Material on the WTO Website*, at http://www.wto.org/english/tratop_e/trips_e/trips_e.htm (last visited Nov. 17, 2004).

⁷⁹⁷ U.S. opposition may eventually crumble, as more U.S. agencies become familiar with the usefulness of this intellectual property law vehicle. For instance, in response to a question I posed at a Washington, D.C. public discussion forum in the spring of 2003, one high-ranking official from the United States Agency for International Development confirmed the existence of ongoing U.S. assistance in Guatemala to develop, via geographical indications law, improved marketing and protection of Guatemalan coffee. The official admitted that this assistance seems inconsistent with the U.S. Trade Representative's position on geographical indications at the WTO, but was enthusiastic about the apparent success of the Guatemalan program. See USAID, *Global Coffee Crisis*, *USAID's Response to the Global Coffee Crisis*, at http://www.usaid.gov/locations/latin_america_caribbean/coffee.html (last updated Feb. 9, 2004).

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good faith adherence to TRIPS.⁷⁹⁸ Additionally, it would provide another vehicle for expanded TKGRF legal protection within already-established intellectual property law regimes, consistent with present U.S. policy objectives.

V. TRADITIONAL KNOWLEDGE, THE INTERNET, AND BEYOND: THE
BROADER RELEVANCE OF THE TKGRF DEBATE TO U.S.
INTELLECTUAL PROPERTY DEVELOPMENT

Presently, many U.S. intellectual property practitioners do not see broad relevance in the current TKGRF discussion, despite the fact that it is receiving great attention and interest in many other countries. However, understanding gained through study of traditional knowledge systems may have applications far beyond resolving the immediate intellectual property problems identified thus far in the TKGRF controversy. And while relatively few public conflicts have arisen in the U.S. to date, with growing awareness of TKGRF legal issues among Native Americans, it is only a matter of time until this occurs.

Equity and fairness require that the creative works, knowledge, and genetic resources in the custodianship of indigenous societies be protected to a degree at least equal to that given to more familiar forms of intellectual property in industrialized societies. Understanding how customary law manages TKGRF material within traditional societies may give us novel ideas on how to manage all intellectual property, including TKGRF, more effectively in Western society. But careful examination of the components of traditional knowledge and customary legal management also offers us an avenue for understanding some of the voids and limitations of Western intellectual property law, not just with respect to TKGRF, but with respect to creative material and dissemination methods not yet conceived. TKGRF study may reveal those areas of intellectual property law that hold the most promise for adaptation and application to future discoveries, innovations, or creations totally unrelated to present-day TKGRF.

⁷⁹⁸ See Lindquist, *supra* note 753, at 337–38 (discussing this facet of the geographical indications controversy).

The study of customary law and TKGRF—and how to interface these with Western intellectual property law—encourages the exploration of legal concepts in an original way. The vast majority of lawyers, judges, and legal thinkers today are schooled almost exclusively in, or at least heavily influenced by, legal systems that originated in Roman law and that have many common characteristics.⁷⁹⁹ Most national legal systems, including that of the U.S., have generally dismissed customary law as irrelevant to modern society and jurisprudence.⁸⁰⁰ This dismissal has most often occurred summarily, without any examination of customary law precepts.⁸⁰¹ Many Western thinkers have commonly held the assumption that customary law has nothing to do with “their” societies, so they do not need to know about it or consider what it may have to offer.⁸⁰²

A few courts and national legislatures are beginning to suspect that this is an erroneous view.⁸⁰³ Collaborative study of legal systems not founded on Western principles of law may offer all cultures new ways of thinking and fruitful jurisprudential cross-fertilization.

This cannot happen however, succeed without far greater participation by indigenous people in national and international TKGRF dialogues. Leaders from indigenous societies, traditional knowledge practitioners, and indigenous custodians of customary law must all participate much more in these discussions. Only members of indigenous societies can help Western scholars to sense something of the true character, context, and appropriate usage of TKGRF material. Absent this collaboration, fashioning effective legal protections may be impossible. Protective mechanisms based solely on Western legal concepts are likely to prove increasingly flawed when tested over time.

⁷⁹⁹ See Saarland Univ., Inst. of Law and Informatics, *Questions and Answers on Roman Law*, at <http://www.jura.uni-sb.de/Rechtsgeschichte/Ius.Romanum/RoemRFAQ-e.html> (last visited Nov. 17, 2004).

⁸⁰⁰ See Steven R. Ratner, *International Law: the Trials of Global Norms*, FOREIGN POL’Y, Spring 1998, <http://www.globalpolicy.org/globaliz/law/intllaw/2003/0624ratner.htm>.

⁸⁰¹ See *id.*

⁸⁰² See *id.*

⁸⁰³ See, e.g., *supra* note 746 and accompanying text.

Synergistic brainstorming among Western and indigenous legal thinkers could be a fertile new source of legal ideas and structures that could help solve other novel IP problems. In some Information Age contexts, flexible definitions of “intellectual property” may prove to be more useful than the traditional categories we have developed up to now. This kind of conceptual growth could, in turn, lead to better problem-solving in other intellectual property areas, including biotechnology.

As just one example of this, the Internet community, particularly in the open source movement, resembles many indigenous societies, in that it originates from a foundational structure based on principles of collective ownership and free sharing of benefits among community members. One overarching goal is to optimize the community structural framework for the good of everyone.⁸⁰⁴ The Internet has retained these characteristics in many respects, but it has now morphed into a more complex organism.⁸⁰⁵ It consists increasingly of discrete layers: information controllers and information users, all of whom possess, or wish to possess, varying access and usage rights to the communal content.⁸⁰⁶

Both of these structural stages are analogous in some respects to traditional indigenous societies. Most traditional communities exhibit similar characteristics and have developed effective ways to control—yet share fully for the greater community—access to and use of community knowledge and genetic resources, as well as members’ individual contributions to associated tangible and intangible creative works.⁸⁰⁷ Perhaps customary law and practice could give us a better idea of how to regulate the Internet for the good of the many, rather than, as is increasingly the case, the corporate few.

Similarly, many indigenous societies have developed strictly defined and carefully observed systems for use and development of the genetic resources and the natural environment in which they

⁸⁰⁴ *See id.*

⁸⁰⁵ *See generally* Raymond T. Nimmer, *Internet: Law at a Lightning Pace*, Pike & Fischer Internet Law & Regulation, <http://internetlaw.pf.com> (last updated Sept. 2004).

⁸⁰⁶ *Id.*

⁸⁰⁷ *See supra* Part I.B.3.e.

live.⁸⁰⁸ These systems must be effective, since indigenous people, unlike majority populations, tend to live in a sustainable fashion in the natural world (at least until indigenous communities are intruded upon by outside influences).⁸⁰⁹ There is much to learn from these communities, not just about the nature and use of TKGRF itself, but about effective methods of legal management and the jurisprudence associated with stewardship of this material and of the natural environment.

The world is rapidly transforming across many sectors—agriculture, industry, health, medical, and entertainment. The potentially rich avenues that TKGRF and indigenous people may offer concerning how to legislate and adjudicate symbiotically across biological, informational, and intellectual property systems must not be ignored.

Because the Western world has done little to protect indigenous knowledge, while contributing much toward its decimation,⁸¹⁰ the ability to return to the “reference book” of indigenous TKGRF, and to the biodiversity it sustains and complements, is becoming increasingly difficult. This material must be protected and nurtured, not just scientifically, but jurisprudentially, or the cultures and natural habitat from which it has evolved will rapidly and permanently disappear.⁸¹¹ With this disappearance, a crucial part of the heritage of man and his roadmap—not just for his evolution, but for his ultimate survival—will be lost forever.

CONCLUSION

This paper has examined a variety of legal steps that could be taken to bring the United States new credibility and a position of

⁸⁰⁸ See, e.g., AUGUSTA MOLNAR ET AL., WHO CONSERVES THE WORLD’S FORESTS? COMMUNITY-DRIVEN STRATEGIES TO PROTECT FORESTS AND RESPECT RIGHTS 3–10 (2004) (describing community-driven conservation efforts of indigenous societies), <http://www.forest-trends.org/whoweare/new/move/Who%20Conserves%2011-4-04.pdf> (last visited Nov. 17, 2004).

⁸⁰⁹ See, e.g., *id.*

⁸¹⁰ See Farley, *supra* note 42, at 11–12.

⁸¹¹ *Id.*

respect in the TKGRF controversy, both at home and abroad. The suggested steps are consistent with the stated U.S. policy goal of protecting indigenous TKGRF within established intellectual property law regimes.⁸¹² The proposed steps could also give rise to new opportunities to export U.S. legal doctrine relating to innovation and creativity, including freedom of speech and fair use. In addition, the U.S. would reap the benefits of wider global acknowledgment of the validity of intellectual property laws, including TRIPS.

The first step that must be taken towards meaningful TKGRF protection in the United States is widespread education about the availability of present intellectual property laws for this purpose. The recommendations for education contained in the USPTO Report⁸¹³ should be implemented for all U.S. citizens, including Native Americans, without further delay. Few U.S. citizens are familiar with the most basic concepts of patent, trademark, and copyright law, and education would help bring the public greater awareness of the proper and improper uses of all of these, including indigenous TKGRF. Indigenous education about specialized trademarks, IACA, state-based certification programs, and the USPTO database of Native American tribal insignia would facilitate immediate, increased TKGRF protection.

But legislative changes are also needed for truly meaningful protection of TKGRF to exist in the U.S. Useful TKGRF protective activity can occur first in state legislatures. Grassroots U.S. consciousness can be raised on TKGRF issues without having to confront powerful national lobbying interests that have thus far influenced federal policymakers away from instituting meaningful TKGRF protection.⁸¹⁴ State legislatures should begin now to amend unfair competition and contract laws to require equitable minimum standards for TKGRF-related projects. Legislators should enact appropriate safeguards, requiring all contracts to ensure prior informed consent of indigenous stakeholders, equal access to neutral legal counsel, and benefit-sharing appropriate to

⁸¹² See generally *supra* Part II.B.

⁸¹³ See discussion *supra* Part III.D.

⁸¹⁴ Jennifer Amriott, *Investigating the Convention on Biological Diversity's Protections for Traditional Knowledge*, 11 MO. ENVTL. L. & POL'Y REV. 3, 7 (2003).

the communities involved. States could become a present-day incubator for future federal TKGRF legislation, just as they shaped the moral rights landscape during the 1970s and 1980s for the federal legislation of 1990.⁸¹⁵

States lacking moral rights laws should promptly adopt them for all authors of creative works, indigenous and non-indigenous. To decrease likelihood of federal preemption, these laws should protect the broadest possible spectrum of creative material, be enforceable beyond the life of the artist (preferably along CAPA public interest lines),⁸¹⁶ and provide for author rights to resale royalties.

More state legislatures should create publicly funded certification systems, perhaps along the lines of the Alaska Silver Hand Program,⁸¹⁷ to facilitate handicraft and other indigenous product protection. As an alternative to state-administered programs, local funding could be made available for privately-run programs for infrastructure, marketing, and advertising efforts, or to otherwise support tribal holders who want to obtain certification and collective marks but lack the means to register and maintain them.

Federal legislative changes are also needed for systematic, long-term TKGRF protection. While the U.S. presently holds a leadership role in current international TKGRF discussions, this appears to be due to the U.S. preponderance in patenting, rather than because of widespread international respect or perceived legitimacy of the U.S. in the leadership position. There is distaste for the U.S., in part because of the seeming arrogance of U.S. representatives, but also because of the narrow commercial scope of U.S. intellectual property law and perceived interests.⁸¹⁸ Many delegates to the IGC talks privately state that U.S. interests in intellectual property, including TKGRF, are limited to corporate

⁸¹⁵ See discussion *supra* Part IV.B.2.

⁸¹⁶ See *supra* notes 690–93 and accompanying text.

⁸¹⁷ See discussion *supra* Part III.B.

⁸¹⁸ See Shubha Ghosh, *Globalization, Patents, and Traditional Knowledge*, 17 COLUM. J. ASIAN L. 73, 110 (2003) (“U.S. copyright law differs in many of its features from the copyright systems of European countries by de-emphasizing moral rights and emphasizing exploitation of the commercial value of the created work.”).

moneymaking and global political influence, untempered by any deeper cultural, humanitarian, or historical concerns.⁸¹⁹ Without domestic legislative changes, growing American isolation in international forums will probably force the U.S. to an embarrassing retreat, but not before much time, effort, and goodwill have been exhausted.

Congress should promptly ratify the CBD; until this occurs, U.S. officials should be allowed to attend Working Group meetings only as *nonparticipating* observers. The defective trademark provisions in IACA⁸²⁰ should be repaired immediately, allowing prompt implementation of originally intended indigenous protections, and the Board should make specialized legal expertise available to indigenous clients to advise them about the advantages of registering certification and collective trademarks for TKGRF. Until IACA is repaired and the trademark program implemented, U.S. government officials should desist from making misleading references in international forums to trademark opportunities available to indigenous people under IACA.⁸²¹ Congress could probably take both of these legislative steps rapidly, if its interest in protecting TKGRF is indeed authentic.

Other, more ambitious, federal efforts must also be implemented before meaningful TKGRF protection can exist in the United States. Present domestic law does not require any equitable benefit-sharing or prior informed consent in the TKGRF context, source disclosure in patent applications, or conformity with the CBD. This leaves the U.S. vulnerable to criticism that the U.S. pays lip service to the importance of TKGRF but in actuality provides meaningful protection only to the lucrative corporate interests that pad USPTO coffers.

⁸¹⁹ *Cf. id.* (“For example, granting an intellectual property right to commercially exploit traditional knowledge may facilitate economic expansion and growth by permitting the expansion of capital. But such protection may come at the cost of social and cultural development if economic expansion disturbs traditional social structures like the family or village network. Similarly, intellectual property protection based on traditional social and cultural systems, such as reliance on the memory of tribal elders or village medicine men, may be at the cost of economic development.”).

⁸²⁰ See *supra* notes 414–30 and accompanying text.

⁸²¹ See discussion *supra* Part III.A.

Together with protecting TKGRF within existing IP laws, the additional linchpins of stated U.S. policy are “national treatment,” “private contractual solutions,” and “periodic reporting requirements.”⁸²² Therefore, Congress should begin drafting legislation to enact enforceable national guidelines for private TKGRF contracting, and it should establish an oversight mechanism for periodic national reporting. As U.S. officials presently advocate, leaving implementation details to national legislatures is appropriate: it respects the sovereignty of nations, and allows for adaptation to national legal traditions and consistency with the historical national development of intellectual property law.⁸²³ But national safeguards for TKGRF contracting must exist in every country, not just a few, and those safeguards must adhere generally to emerging international standards of fair, non-exploitative, and honest treatment of indigenous TKGRF custodians.⁸²⁴ The United States should take a leadership role in protecting TKGRF by legislating its fair treatment at home.

Minimum legislative standards must require that all TKGRF contracts contain appropriate safeguards ensuring prior informed consent of contracting parties, equal access to neutral legal counsel, and benefit-sharing appropriate to the communities involved. Instituting a geographical indications law for TKGRF and a broader moral rights law would also noticeably expand domestic indigenous TKGRF protection under familiar intellectual property law principles.⁸²⁵

Finally, in the case of TKGRF-related inventions, formal recognition by courts and government agencies of an equitable link between patent enforceability and proper source attribution and benefit-sharing is crucial. Other than national minimum contracting guidelines,⁸²⁶ a link to enforceability, rather than to patentability, would expand TKGRF protection more effectively than any other measure. This step could be taken immediately by

⁸²² See *supra* notes 332–38 and accompanying text.

⁸²³ Lourie Statements, *supra* note 212.

⁸²⁴ *Id.*

⁸²⁵ See Lindquist, *supra* note 753, at 310; NIMMER & NIMMER, *supra* note 610.

⁸²⁶ See discussion *supra* Part I.B.3.b.

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U.S. courts, obviating any need to amend TRIPS, which would surely take years before consensus could be reached.

Taking these steps—or even laying significant and concrete groundwork to take them—would thrust the U.S. into the spotlight as a model for effectively protecting TKGRF within established intellectual property and contract law regimes. This approach minimizes both experimentation in untested new areas of law and potential disruption to prior intellectual property rights holders.⁸²⁷ Implementing this scheme in the United States would likely influence other countries to adopt similar legislation, relieving pressure to rapidly draft an international TKGRF treaty.

Rather than pursuing its present obstructionist path, the U.S. should also participate in an open-minded and good faith manner with international efforts to explore larger TKGRF questions.⁸²⁸ The United States should help examine and honestly assess current Western intellectual property institutions and laws, including its own patent system, to analyze shortcomings and make improvements. Though USPTO officials should continue as active participants in TKGRF policy formulation, they should no longer be the main spokespeople for U.S. delegations to international forums. No agency can objectively assess itself, especially under the scrutiny of an international audience. The USPTO, due to its funding sources and clientele, is especially vulnerable to allegations of bias.⁸²⁹

De facto USPTO leadership of U.S. delegations has had an unnecessarily corrosive effect on U.S. credibility in the TKGRF arena,⁸³⁰ and it should immediately be discontinued. Since TKGRF issues affect the entire spectrum of intellectual property law, the USPTO in fact has no greater subject matter expertise in TKGRF than counsel from the Copyright Office, the Bureau of Indian Affairs, or other federal agencies formulating TKGRF policy and procedure. Instead, independent intellectual property

⁸²⁷ See Nuño Pires de Carvalho, *supra* note 213, at 372.

⁸²⁸ TAUBMAN PRESENTATION, *supra* note 48.

⁸²⁹ Coombe, *supra* note 110, at 281.

⁸³⁰ *Id.*

counsel, perhaps from within the Office of the Solicitor General, or elsewhere, should coordinate U.S. policymaking in TKGRF.

The United States, with its long tradition of ideological, religious, and racial diversity, should also take the lead in including indigenous representatives in all TKGRF discussions. U.S. officials should ensure that as many indigenous representatives—especially elders—participate in the search to preserve and protect indigenous TKGRF. The U.S. has many indigenous people who could contribute invaluable insights,⁸³¹ and it possesses an exceedingly well-educated and diverse population of indigenous and nonindigenous legal thinkers, all of whom could provide leadership in international efforts. U.S. participants should also cultivate a new attitude of humility in their role as leaders in this important international work effort.

These adjustments in domestic law and policy would germinate a new fluidity of thinking among U.S. lawyers, judges, and scholars, not just in the TKGRF arena, but in many other areas of law as well. Experience gained now through creating effective legal interfaces among extraordinarily diverse peoples, systems of jurisprudence, and dispute resolution mechanisms may be singularly useful in the future. More creative and expansive legal thinking is a necessary prerequisite to visionary problem-solving in many blossoming legal interface situations, particularly in cyberspace and biotechnology.

Ultimately, these skills could also facilitate peaceful interaction with other new civilizations that will undoubtedly possess unfamiliar systems of law. Such systems are likely to be noticeably divergent from ours, especially in their governance of inventions and technology, information, and creative works. Finding successful, new ways to deal with legal diversity in the TKGRF context is an invaluable opportunity to prepare to meet similar challenges, in new contexts, in the future.

⁸³¹ See generally L. Scott Gould, *Mixing Bodies and Beliefs: The Predicament of Tribes*, 101 COLUM. L. REV. 702, 750–52 (2001) (discussing the growing population of indigenous people in the United States).